

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: Carlos Neto Mendes

Group Art Unit: 3721

RECEIVED

JAN 25 2005

OFFICE OF PETITIONS

Applicant: Carlos Neto Mendes

Serial No.: 09/641,790

Atty. Dkt.: M-95-3195-U.20-CIP (old)  
10646-007-U20 (new)

Internal Code: U.20

Filed: 08/18/2000

Title: IMPROVEMENTS IN A MODULAR FRUIT JUICE EXTRACTION SYSTEM  
AND CONFIGURATION FOR A SELF-CLEANING FILTER FOR THE  
EXTRACTION OF FRUIT JUICE

PROVISION OF ADDITIONAL MATERIAL RECEIVED FOLLOWING THE FILING  
OF, AND PERTAINING TO, THE PETITION UNDER 37 CFR 1.137(b) FOR  
REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNINTENTIONALLY

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner for Patents:

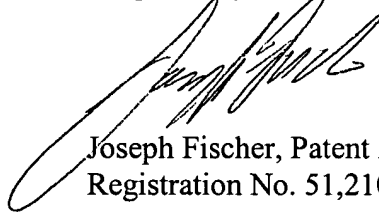
On November 30, 2004, Applicant filed a Petition to Revive the above-referenced patent application. In the Additional Paper that accompanied that Petition, on page 10, Applicant indicated that Applicant would "supplement this Petition with relevant information if such is obtained through the second FOIA Request." Pursuant to the second FOIA request (designated FOIA Request No. 05-001), Applicant recently received 43 pages of documents, namely, the Initial Decision of Proceeding No. D02-14 involving Mr. George A. Bode. Applicant herewith provides a copy of those 43 pages.

Applicant respectfully requests that the information in the enclosed copy of the Initial Decision is considered during consideration of the Petition to Revive for the

above-referenced patent application. Applicant notes that the redaction was done by the USPTO, and not by Applicant. While many parts of the enclosed document provide additional character evidence supportive of Mr. Bode's behavior alleged in the Additional Paper, Applicant further particularly draws to the attention of those considering the Petition to Revive: page 15, bottom line, through page 16; page 19 (top paragraph); page 20 (second paragraph) page 27, second paragraph through page 28, second paragraph; and page 28, third paragraph, through page 36, first paragraph.

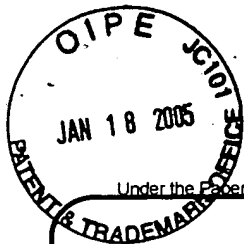
DATED this 11<sup>th</sup> day of January, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Joseph Fischer', is written over the printed name and registration number.

Joseph Fischer, Patent Attorney  
Registration No. 51,210

Beusse Brownlee Wolter Mora & Maire, P.A.  
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PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/641,790
	Filing Date	08/18/2000
	First Named Inventor	Carlos Neto Mendes
	Art Unit	3721
	Examiner Name	S.F. Gerrity
Total Number of Pages in This Submission	Attorney Docket Number	10646-007-U20

**RECEIVED**  
**JAN 25 2005**  
**OFFICE OF PETITIONS**

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply (w/Attachment)	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	1. Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	2. Provision of Additional Material Received Following The Filing Of, And Pertaining To, The Petition Under 37 CFR 1.137(b) For Revival Of An Application For Patent Abandoned Unintentionally
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Beusse Brownlee Walter Mora & Maire, P.A.	
Signature		
Printed name	Joseph Fischer	
Date	January 11, 2005	Reg. No. 51,210

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	Grayce A. Lichtenberger	Date January 11, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



## **I. PROCEDURAL HISTORY**

On June 5, 2002, Harry I. Moatz ("Complainant"), Director of the Office of Enrollment and Discipline, United States Patent and Trademark Office, Department of Commerce ("PTO"), issued a Complaint against Respondent George A. Bode ("Respondent" or "Mr. Bode") pursuant to 37 C.F.R. § 10.134. The Complaint charged Respondent with seven counts of professional misconduct sufficient to warrant suspension or exclusion from practice, by reason of violating the Regulations governing the Representation of Others Before the Patent and Trademark Office, 37 C.F.R. Part 10.<sup>2</sup>

On or about June 21, 2002,<sup>3</sup> Respondent, acting *pro se*, submitted an Answer to the Complaint, denying the violations and requesting a hearing.<sup>4</sup> In accordance with the Order Scheduling Prehearing Procedures and Hearing dated July 29, 2002, Complainant submitted his Prehearing Exchange on August 16, 2002 and Respondent submitted his Prehearing Exchange on or about August 23, 2002.<sup>5</sup>

On August 14, 2002, Complainant submitted a Motion to Amend the Complaint to add eight new factual assertions to support the allegations made against Respondent in Count 3. Noting that no opposition to the Motion had been timely received from Respondent, an Order

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<sup>2</sup> The Complainant also requests that Respondent be required to pay all or a portion of the costs and expenses, not to exceed \$1,500, of the disciplinary proceeding that led to the suspension. See, Complaint ¶ 70 and footnote 49, *infra*.

<sup>3</sup> June 21, 2002 is the mailing date reflected on the certificate of service accompanying the Answer. However, neither Complainant nor this Tribunal received the copy of the Answer purportedly mailed on that date. Rather, Complainant received his copy of Respondent's Answer by facsimile on July 17, 2002, and forwarded a copy of the same to this Tribunal by facsimile the following day. Although the Answer was not filed timely, no steps towards defaulting Respondent were taken.

<sup>4</sup> In his Answer, Respondent also listed certain "Affirmative Defenses." However, upon review it is clear that those "defenses" are merely further denials of the allegations in the Complaint and not truly affirmative defenses.

<sup>5</sup> August 23, 2002 is the date reflected on the certificate of service accompanying the Respondent's Prehearing Exchange. However, this Tribunal first received the Respondent's Prehearing Exchange by facsimile on September 5, 2002, in response to a request made when the copy of the exchange allegedly mailed to it by Respondent on August 23<sup>rd</sup>, was not timely received. A mailed copy of the exchange was received by the undersigned on September 9, 2002.

Granting Leave to File Amended Complaint was issued on September 9, 2002.<sup>6</sup> Respondent submitted an Answer to the First Amended Complaint on or about September 16, 2002.<sup>7</sup>

On September 12, 2002, Complainant submitted a Second Motion to Amend the Complaint and a Motion to Amend the Director's Prehearing Statement. The Second Motion to Amend the Complaint sought to add 13 additional counts to the Complaint based upon newly discovered evidence. Respondent served an opposition to the Second Motion to Amend and an Amended Prehearing Exchange Statement on September 18, 2002.<sup>8</sup> By Order dated October 2, 2002, Complainant's motions to amend the Complaint and prehearing exchange were granted and, in light of the amendments, the hearing date postponed to provide Respondent with an adequate opportunity to respond to the additional allegations of violations. Respondent was ordered to file his Answer to the Second Amended Complaint on or before October 12, 2002, and any amended prehearing exchange statement on or before November 15, 2002.

Upon failing to receive from Respondent his Answer to the Second Amended Complaint by the established deadline of October 12, 2002, on October 21, 2002 an Order to Show Cause was issued to Respondent. A copy of Respondent's Answer was received by mail by the

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<sup>6</sup> In the Order of September 9, 2002 permitting amendment of the Complaint, it was noted that the previously issued Prehearing Order had established a 15 day response time for motions and that a response to the Motion to Amend filed on August 14, 2002 had not been received from Respondent within the designated period. Subsequently, on September 12, 2002, the undersigned received by mail Respondent's Opposition to the Motion to Amend which was allegedly mailed on September 5, 2002. The Opposition offered no excuses for its late filing and proffered no arguments warranting reconsideration of the Order granting leave to amend. Furthermore, because of the delay in receiving filings in a timely manner from Respondent, and the impending hearing date then set of October 8, 2002, included in the Order granting leave to amend was the requirement that all further pleadings filed in this matter be served on the undersigned, simultaneously, by facsimile as well as first class mail.

<sup>7</sup> A copy of the Answer was received by the undersigned from Respondent by facsimile on September 23, 2002. The copy of the Answer sent by mail was received on October 1, 2002. The envelope containing the Answer was metered with a date of September 23, 2002, although the certificate of mailing was dated September 16, 2002.

<sup>8</sup> Despite the prior Order, Respondent did not serve a copy of the Opposition on the undersigned by facsimile. Rather, Complainant forwarded the copy of Respondent's Opposition, which Complainant had received the day before by facsimile, to the undersigned on September 26, 2002. The undersigned also received by mail a copy of Respondent's Amended Prehearing Statement on September 26, 2002.

undersigned the next day, on October 22, 2002.<sup>9</sup> On October 25, 2002, by facsimile, Respondent filed his Answer to the Order to Show Cause. Based upon receipt of these pleadings, on October 29, 2002, the undersigned issued an Order essentially dismissing the Order to Show Cause.<sup>10</sup>

On December 20, 2002, Complainant submitted a second motion to amend his prehearing statement. No response to this Motion was ever received from the Respondent. On January 6, 2003, the Motion was granted.

A hearing was held in this matter before the undersigned on January 14th and 15th, 2003, in Washington, D.C.<sup>11</sup> The Complainant testified at the hearing and also presented the testimony of five additional witnesses: [REDACTED] and Frank Ippolito. Respondent testified on his own behalf at the hearing. Complainant premarked for identification a volume of exhibits, each page of which was individually numbered as an exhibit from 1-712. Tr. 13-14. In addition, Complainant marked for identification, separately, exhibits numbered 713-723. Complainant's exhibits number 1-723, with the exception of those numbered 394, 413-414, 438, 717-722, were offered and admitted into evidence (hereinafter cited as "C's Ex. \_\_"). Respondent marked for identification at the hearing three exhibits, none of which were offered or admitted into evidence.

The transcript of the hearing was received by the undersigned on February 6, 2003. The parties were given the opportunity to file post-hearing briefs. Tr. 8, 675-81. Complainant filed his post-hearing brief on April 1, 2003. Respondent did not file a post-hearing brief by the due date for his brief of May 1, 2003. Thus, record closed with the filing of Complainant's brief on April 1, 2003.

## **II. STANDARDS FOR IMPOSITION OF SANCTIONS**

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<sup>9</sup> The Answer was received by the undersigned in a United States Postal Service "Priority Mail" envelope bearing Respondent's postage meter-mark indicating it was mailed from Lakeland, Florida and was accompanied by a certificate of mailing, both dated October 4, 2002. Testimony of a Postal Service representative at the hearing reflected that priority mail, costing more, is intended to provide faster delivery than regular first class mail and has an intended guaranteed delivery time of 1-3 days depending on delivery location. See, Transcript of Hearing held on January 15, 2003, page 558.

<sup>10</sup> In that Order, the undersigned noted the unusual and lengthy delays involved in receiving pleadings mailed by Respondent, using as an example the 18 day delay in receiving the Amended Answer allegedly sent by "Priority Mail," to sustain the requirement, over Respondent's objection thereto, of service by facsimile as well as mail.

<sup>11</sup> Citation to the transcript of the hearing will be in the following form: "Tr."

## **A. Disciplinary Rules**

The Regulations governing the representation of others before the Patent and Trademark Office provide at 37 C.F.R. § 10.130(a), in pertinent part, that "[t]he Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, . . . any individual [or] attorney . . . shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule."<sup>12</sup>

Complainant has alleged that Mr. Bode violated the PTO's Disciplinary Rule 10.23 which provides in relevant part that:

(b) A practitioner shall not:

\* \* \*

(4) Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

(5) Engage in conduct that is prejudicial to the administration of justice.

(6) Engage in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office.

(c) Conduct which constitutes a violation of paragraph[] . . . (b) of this section includes . . .

\* \* \*

(8) Failing to inform a client . . . of correspondence received from the Office . . . when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.

\* \* \*

(9) Knowingly misusing a "Certificate of Mailing or Transmission" under § 1.8 of this chapter.

\* \* \*

(16) Willfully refusing to reveal or report knowledge or evidence to the

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<sup>12</sup> 37 C.F.R. §10.20(b) indicates those sections of the Code considered "Disciplinary Rules," which are defined as being "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subject to disciplinary action."



Director contrary to § 10.24 or paragraph (b) of § 10.131.<sup>13</sup>

37 C.F.R. § 10.23.

Further, Complainant has alleged that Respondent violated Disciplinary Rules 10.77(c) and 10.84(a)(2) which provide that -

A practitioner shall not:

(c) Neglect a legal matter entrusted to the practitioner.

37 C.F.R. §10.77(c).

(a) A practitioner shall not intentionally:

\* \* \*

(2) Fail to carry out a contract of employment entered into with a client for professional services . . .

37 C.F.R. §10.84(a)(2).

#### B. Standard of Proof

The function of a standard of proof is to "instruct the factfinder concerning the degree of confidence our society thinks he should have in the correctness of factual conclusions for a particular type of adjudication." *Addington v. Texas*, 441 U.S. 418, 423 (1979), quoting *In re Winship*, 397 U.S. 358 (1970) (Harlan, J., concurring).

Regarding the standard of proof in these proceedings, the Regulations governing the representation of others before the Patent and Trademark Office, provide at 10 C.F.R. § 10.149, that -

In a disciplinary proceeding, the Director shall have the burden of proving his or her case by clear and convincing evidence and a respondent shall have the burden of proving any affirmative defense by clear and convincing evidence.

See also, *Jaskiewicz v. Mossinhoff*, 822 F.2d 1053 (Fed. Cir. 1987).

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<sup>13</sup> Section 10.24 requires a practitioner to disclose unprivileged knowledge of violations of Disciplinary Rules to the Director and section 10.131(b) provides that a practitioner shall cooperate in connection with investigations by the Director of possible Disciplinary Rule violations. 37 C.F.R. §§ 10.24 & 10.131(b).

This "intermediate standard of clear and convincing evidence" lies "between a preponderance of the evidence and proof beyond a reasonable doubt." *Addington*, 441 U.S. at 425.

The clear and convincing standard of proof has been variously defined ... as evidence which produces in the mind of the trier of fact a firm belief or conviction as to the truth of the allegations sought to be established, evidence so clear, direct and weighty and convincing as to enable [the factfinder] to come to a clear conviction, without hesitancy, of the truth of the precise facts in issue.

*Cruzan v. Missouri Dep't of Health*, 497 U.S. 261, 285 n.11 (1990) (alteration in original) (internal quotation omitted).

### **III. FINDINGS OF FACT AND CONCLUSIONS OF LAW**

Respondent, George A. Bode, is an attorney licensed to practice law in Louisiana, Florida, New Jersey and Colorado. C's Exs. 341, 342, 398-99. During his legal career, Mr. Bode specialized in the practice of patent, trademark and copyright law and, since at least 1980, has been registered as an attorney practitioner before the PTO, having been assigned Registration No. 30,028. *Id.* At times relevant hereto, Mr. Bode maintained his main office for the practice of law in New Orleans, Louisiana, with additional offices in Pensacola and Lakeland, Florida. *Id.*, Tr. 29, 376-77.

The allegations of violation against Mr. Bode fall into various categories. He is alleged to have: (A) misused three Certificates of Mailing (counts 1-3); (B) failed to respond to two Requirements for Information (counts 4 and 5); (C) improperly claimed priority on a patent application (count 6); and (D) failed to keep clients informed regarding PTO correspondence concerning the status of their applications (counts 3, 8-10, and 17-20).<sup>14</sup> Each of the alleged violations will be discussed in turn below.

#### **A. Misuse of Certificates of Mailing**

Counts 1, 2 and 3 of the Amended Complaint all arise out of allegations involving Respondent's alleged misuse of certificates of mailing in connection with matters pending before

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<sup>14</sup> At the initiation of the hearing, Complainant withdrew Counts 11-16 of the Second Amended Complaint. Tr. 9-10. In his Post-hearing Brief, Complainant withdrew the claim of violation set forth in Count 7 as well as the claim that Respondent violated 37 C.F.R. § 10.84(a)(2) in Counts 1-3 of the Second Amended Complaint. See, Complainant's Brief at 34, n.1.

the PTO.<sup>15</sup> With regard to certificates of mailing, PTO Rule 1.8(a) provides in pertinent part that:

... correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

37 C.F.R. § 1.8(a).

Thus, this Rule provides that the PTO will deem the date a practitioner places on his certificate of mailing, as *the filing date*, for most documents filed with it, regardless of the when the PTO actually receives the document in its offices for placement in the official government file. Tr. 364-65.

In *Small v. Weiffenbach*, 1989 Commr. Pat. LEXIS 3, 10 U.S.P.Q.2D (BNA) 1898 (1989), it was noted that –

The [certificate of mailing] practice permits attorneys appearing before the PTO in patent and trademark cases to file papers in a timely fashion anywhere in the United States by merely depositing the paper in a U.S. Postal Service mail box. The need to retain “local” counsel to hand-deliver papers to the PTO has ceased and has eliminated a considerable expense for applicants and others having business before the PTO who reside far from PTO’s facilities in Arlington,

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<sup>15</sup> Count 3 also includes an allegation regarding Respondent’s failure to keep a client informed regarding correspondence received from the PTO. That allegation will be addressed in section (D) below.

Virginia. The practice also provides an important tool for practitioners to avoid possible mail delays. It is apparent, however, that there are those who have taken advantage of 37 CFR 1.8 . . . .[noting three cases of backdating].

Complainant alleges that Respondent is also one of those who have taken advantage of 37 C.F.R. § 1.8 by not truthfully dating his certificates of mailing, asserting that Respondent submitted to the PTO three certificates which bore dates which were substantially earlier than the actual dates the filings were deposited with the U.S. Postal Service. Complainant asserts such misdating constitutes a violation of Disciplinary Rules 37 C.F.R. § 10.23(b)(4) (engaging in conduct involving dishonest, fraud, deceit, or misrepresentation) citing *In re Richards*, 755 N.E. 2d 601 (Ind. 2001) and *Oklahoma Bar Ass'n v. Colston*, 777 P.2d 920 (Okla. 1989)); 37 C.F.R. § 10.23(b)(6) (engaging in conduct that adversely reflects upon fitness to practice) citing *Florida Bar v. Adler*, 505 So.2d 1334 (Fla. 1987); 37 C.F.R. § 10.23(c)(9) (knowingly misusing certificates of mailing); and 37 C.F.R. § 10.77(c)(neglecting a matter entrusted) citing *Klein v. Peterson*, 866 F.2d 412 (Fed. Cir. 1989). See, Complainant's Brief at 38-39.

The first allegation in this regard is made in Count 1 and involves Patent Application No. [REDACTED] filed on behalf of inventor [REDACTED] on [REDACTED] 3, 1999.<sup>16</sup> C's Exs. 208-265, 716. In regard thereto, on June 14, 2000, the PTO issued an Office Action setting a response deadline to the issues raised therein of three months, that is, until [REDACTED] 14, 2000.<sup>17</sup> C's Exs. 234-241, 716; Tr. 383-84. Having received no response to the Office Action by that deadline, on [REDACTED] 11, 2001, the PTO issued a notice of abandonment of the application. C's Exs. 247, 716. Subsequently, on [REDACTED] 22, 2001, the PTO received from Respondent a Response to the [REDACTED] 14, 2000 Office Action as well as a Revocation and Substitution-Power of Attorney. C's Exs. 249-257, 716; Tr. 615-16. That Response was accompanied by a certificate of mailing,<sup>18</sup> signed by

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<sup>16</sup> The patent application was filed on [REDACTED]'s behalf by another patent practitioner, [REDACTED] C's Exs. 213, 716; Tr. 615. On [REDACTED] 28, 2000 [REDACTED] faxed to the PTO a Notice of Withdrawal as attorney of record. C's Exs. 242-43, 245, 716. The PTO's Notice of its acceptance of the Notice of Withdrawal was issued [REDACTED] 12, 2000. C's Exs. 246, 716.

<sup>17</sup> The Office Action was sent to [REDACTED], Esquire. It noted that patent claims 1-8 were being rejected because the Examiner objected to the drawings. C's Exs. 234-355, 716; Tr. 615. The Office Action provided the name and telephone and fax numbers of the examiner and his supervisor to contact with regard the communication. C's Exs. 239, 716. Mr. Bode testified at the hearing that [REDACTED] brought the outstanding Office action to him when [REDACTED] hired him to handle the case. Tr. 616.

<sup>18</sup> The certificate of mailing reads as follows:

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to:

(continued...)

Respondent, certifying that he deposited it with the U.S. Postal Service as first class mail in an envelope, addressed to the PTO's mailing address in Washington, D.C. on [REDACTED] 1, 2000, that is 192 days before receipt.<sup>19</sup> C's Exs. 257, 716; Tr. 363-64, 385-86.

Similarly, Count 2 involves Patent Application No. [REDACTED] d on behalf of inventor [REDACTED] on [REDACTED], 1999.<sup>20</sup> C's Exs. 143-160, 715. In regard thereto, on October 4, 2000, the PTO issued an Office Action setting a response deadline to the issues raised therein of

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<sup>18</sup>(...continued)

Commissioner of Patents and Trademarks  
Washington, D.C. 20231-9988

on [REDACTED] 11, 2000

/s/

George A. Bode, Re. No. 30,028  
Applicant's Registered Representative

[REDACTED] 2000 [handwritten]  
Date of Signature

With the exception of the typewritten date and handwritten signature and date thereof, all of the certificates of mailing at issue herein are essentially exactly the same. Further, above all of them, Respondent has signed the document identifying for himself his Louisiana office address, and for the PTO its official mailing address in Washington, D.C. C's Exs. 257, 43, 167 and 716.

<sup>19</sup> In response to the filings by Respondent on [REDACTED] 22, 2001, the PTO issued notices on [REDACTED] 17, 2001 accepting Mr. Bode's Power of Attorney on the applicants behalf and revoking the applicant's power of attorney to act on his own behalf. C's Exs. 260-262, 716. However, the application file contains a document indicating that no extensions of time are permitted in regard to filing corrected or formal drawings (C's Ex. 263) and it appears from the file that the PTO did not further act upon Respondent's untimely filings, deeming the application nevertheless abandoned. C's Exs. 208, 265, 716. Mr. Bode testified that after the final rejection, "[REDACTED] lost interest in this. I contacted him and never heard from him again. In fact, my records show that he had moved and I tried to contact him and apparently the case was abandoned because he lost interest in the application." Tr. 617.

<sup>20</sup> This application was also filed on the applicant's behalf by practitioner Peter Loffler. C's Exs. 139, 157, 159, 715. [REDACTED] filed a Notice of Withdrawal with the PTO by fax on December 20, 2000, which the PTO approved on January 14, 2001. C's Exs. 193-94, 715. [REDACTED] Bode submitted a Revocation and Substitution-Power of Attorney substituting himself for [REDACTED] on December 29, 2000, the same date he allegedly mailed a response to the Office action to the PTO which was not received until March 16, 2003. C's Exs. 168-70

three months that is, until January 4, 2001.<sup>21</sup> C's Exs. 190-92, 715; Tr. 381-82. Subsequently, on March 16, 2001, the PTO received a response to the October 4, 2000 Office Action. C's Exs. 162-167, 715. That filing was accompanied by a certificate of mailing signed by Respondent and dated December 29, 2000, *that is 77 days before receipt*.<sup>22</sup> C's Exs. 167, 715; Tr. 382-83.

The last count in this regard, Count 3, involves Patent Application No. [REDACTED] filed on [REDACTED] 1998 by Respondent on behalf of inventor [REDACTED] C's Exs. 1-62, 395; Tr. 41, 583. In response to that application, on December 9, 1999, the PTO issued an Office Action setting a response deadline to the issues raised therein of three months, that is until March 9, 2000.<sup>23</sup> C's Exs. 51-56, 375-76. Subsequently, on April 10, 2000, the PTO received a response to the October 4, 2000 Office Action. C's Exs. 37-43. That filing was accompanied by a certificate of mailing signed by Respondent dated March 2, 2000, *that is 38 days before receipt*. C's Ex. 43; Tr. 378-79.<sup>24</sup>

In support of his assertion that these certificates of mailing were not accurately dated by Respondent, at the hearing Complainant introduced the testimony of Frank Ippolito, a consumer research analyst with the United States Postal Service's Consumer Affairs Department. Tr. 495-97. Mr. Ippolito testified that the Postal Service has generally committed to various levels of first class mail delivery service depending on the distance the mail is sent. Local first class mail is to be delivered either overnight or within one day; two day service is provided for mail sent within 200-300 miles of its origin; and three day service is provided for mail sent beyond that distance. Tr. 501-02, 505-506. All times relevant hereto, Mr. Ippolito said that first class mail sent from Respondent's offices in New Orleans, Louisiana, Lakeland, Florida or Pensacola, Florida, to the

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<sup>21</sup> The Office Action indicated that all the application's pending claims were being rejected upon the Draftsperson's Patent Drawing Review as being obvious from a prior patent previously issued. C's Exs. 190-1, 191, 715.

<sup>22</sup> Subsequently, on March 26, 2001, the PTO received from Respondent a Transmittal Letter dated March 20, 2001, accompanied by a Revocation and Substitution-Power of Attorney dated December 29, 2000. There does not appear to be a certificate of mailing on this document. C's Exs. 168-171, 715. The PTO accepted the March 16<sup>th</sup> filings and in response issued a Notice of Allowability in regard to some of the patent claims. C's Exs. 199, 715. Respondent subsequently submitted additional documents on the applicant's behalf (C's Ex. 204) and the patent was approved for issuance as Patent No. [REDACTED] C's Exs. 136, 715.

<sup>23</sup> The Office Action indicated that some of the claims were being rejected and the balance were being objected to by the PTO.

<sup>24</sup> Although the filing was received late, the PTO acted upon it, and on April 19, 2000, issued a Notice of Allowance and Issue Fee Due. C's Exs. 48-50. However, it subsequently issued a Notice of Abandonment in regard to the application based upon the failure to pay the issue fee due. C's Exs. 48, 57, 58. *See, discussion infra, section (D)(1).*

PTO in Washington D.C., was within the three day standard of delivery. Tr. 502, 506-07.

Further, Mr. Ippolito testified that the Postal Service uses its "External First Class Mail Management System" to test the efficiency of its mail delivery. Tr. 498, 500, 507. Such testing involves tracking and confirming delivery periods for sample test mail pieces sent from various locations. Tr. 507-08. The results of such testing for mail destined for the Washington, D.C. area, as reported for the third quarter of the Postal Service's fiscal year 2000 (2/26/00-5/19/00) and first through third quarters of FY 2001 (9/9/00-5/19/01), reflected that mail within the three day mail delivery zone was, in fact, delivered within 3 days over 83.5% of the time, and within 5 days of mailing over 96.8% of the time.<sup>25</sup> Tr. 514-15, 518-24, 528-29; C's Ex. 723.

Additionally, Mr. Ippolito testified that *all* mail for the Washington, D.C. area is processed through the Postal Service's Brentwood facility, except during those periods after October 2001 (*i.e.*, after the time period relevant here), when that facility was closed due to anthrax contamination. Tr. 509-12. Mr. Ippolito said he was not aware of any significant processing delays in Brentwood prior to October 2001. Tr. 514. He also testified that prior to October 2001, the PTO maintained a post office box at the Brentwood facility for receipt of the mail addressed to it and that each business day, PTO personnel would come to Brentwood and pick up the mail for the PTO's Offices in Virginia. Tr. 513.

Complainant, Mr. Harry Moatz, testified at hearing that the PTO receives about a million pieces of mail a year. Tr. 358. Most of the mail sent through the Postal Service addressed to the patent office (as compared to the trademark office), is picked up from the Brentwood Post Office facility by PTO personnel and brought to the PTO's Office of Initial Patent Examination (OIPE). In OIPE, the mail is broken down into piles which are stamped with the date it is received by that facility. Subsequently, OIPE staff open each envelope and stamp the correspondence within it with the date it was received by the PTO as shown on the date of the pile, and sort it for distribution. Tr. 357-363, 399, 409-10. While he did not believe that the Patent Office maintains statistics regarding average hiatuses between the Certificate of Mailing date and the receipt date, he suggested that "hiatuses" of three or more weeks "would seem to be unusual." Tr. 374, 407-08. He noted the Certificates of Mailing filed by Mr. Bode in the [REDACTED] Fray and Hanssen matters at issue here all had hiatus periods of 30 days or more. Tr. 374-75.

In contradiction to the implications suggested by this evidence, Mr. Bode testified that he personally prepares, prints and mails all his correspondence with the PTO and that, while he had no explanation for the attenuation in delivery times for the three specific mailings at issue, he was certain that the dates shown on the certificates of mailing reflected the actual dates that those filings were deposited by him with the Postal Service. *See*, Tr. 618-19, 655, 657-58.

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<sup>25</sup> Mr. Ippolito testified that mail to the PTO's 20231 zip code was not included in the sampling process because that zip code applies to mail addressed to governmental offices which have their own mailrooms, and such mailrooms can cause delay in receipt of mail to its final destination, which the Post Office does not want factored into its test results. Tr. 527, 551-52.

Nevertheless, after careful consideration of the record as a whole, I find by clear and convincing evidence, that Respondent's certificates were not accurately dated.

First, as to Count 3 at least, there is direct evidence of backdating.<sup>26</sup> At the hearing, [REDACTED] testified that "[w]e got the first application back and resubmitted it in *April of 2000*." Tr. 77 (*italics added*); *see also* Tr. 35, 61. The PTO, in fact, received the response on April 10, 2000, although it bore a certificate of mailing dated March 2, 2000. Mr. Bode did not challenge [REDACTED] recollection in this regard on cross-examination and introduced at the hearing no documentary evidence challenging his recollection, such as a bill for services for February or March 2000 reflecting that the response was prepared before its mailing date.

Second, the record reflects that other, less time sensitive filings, made by Respondent by first class mail in regard to the patent applications at issue in these particular counts were routinely received by the PTO in a timely manner. For example, it appears from the record that Respondent filed the [REDACTED] application with the PTO by sending it by mail on December 23, 1998. *See*, Exs. 27-27 (R's Transmittal Letter). The record evidences that the PTO received the application on December 28, 1998, five days later. *Id.* In addition, using a Certificate of Mailing dated July 24, 2001, Respondent filed a Transmittal Letter to the Official Draftsman in the [REDACTED] application, which the PTO received on July 27, 2001, three days later. C's Exs. 204-05. The PTO also received from Respondent in the [REDACTED] case a Transmittal letter accompanied by a Revocation and Substitution - Power of Attorney on March 26, 2001, within six days of its mailing on March 20, 2001. *See*, C's Exs. 168-171.

Third, the record also shows that correspondence sent by Respondent in connection with other applications was timely received by the PTO. *See*, C's Exs. 483-84 [REDACTED] Patent Application No. [REDACTED] mailed [REDACTED] 1, 1999 and received by the PTO [REDACTED] 4, 1999 (three days later)); C's Exs. 307-09 (Request for Division Application in regard to [REDACTED] application no. [REDACTED] mailed [REDACTED] 1, 2000 and received by the PTO on [REDACTED] 7, 2000 (six days later)); C's Exs. 505-510 (Response to Examiner's Action in [REDACTED] application mailed [REDACTED] 11, 2000 and received by the PTO on [REDACTED] 22, 2000 (eleven days later)); C's Ex. 534 (Petition of Assignee regarding patent application of [REDACTED] No. [REDACTED] mailed [REDACTED] 15, 2000 and received by PTO [REDACTED] 22, 2000 (seven days later)); C's Exs. 610-12

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<sup>26</sup> Unfortunately, the record does not contain the envelopes in which the three mailings at issue were sent by Respondent to the PTO nor any testimony regarding what if anything relevant to the date of mailing was reflected on such envelopes. Such envelopes, if they bore postage dates and/or over-cancellation marks affixed by the Postal Service could provide evidence as to dates of mailings. However, Mr. Ippolito testified that postage affixed using a postage meter, such as that used by Respondent in connection with filing his pleadings in this case, are not over cancelled. Tr. 559-562; *Cf.* C's Ex. 189 (envelope from attorney [REDACTED] to PTO bearing over-cancellation mark). Moreover, there were questions raised at the hearing as to whether the date affixed along with the postage on such metered mail could be turned backwards; however, no witness testified with certain knowledge in this regard. Tr. 570-71.



(Response to Examining Attorney action in [REDACTED] trademark application no. [REDACTED] mailed [REDACTED] 30, 2000 and received by the PTO on [REDACTED] 3, 2000 (four days)). *See also*, C's Exs. 341, 342 (Data Sheet signed by Respondent on December 5, 1991 and received by the PTO on December 11, 1991 (six days later) and data sheet signed on January 6, 1981 and received by the PTO on January 12, 1981 (six days later)).

In addition, filings made by other patent practitioners from Respondent's geographical area appear to have been received by the PTO in a timely manner. *See e.g.*, [REDACTED] application mailed by [REDACTED] Esq. apparently from Tallahassee, Florida on or about [REDACTED] 26, 1999 and received by the PTO on [REDACTED] 3, 1999 (C's Ex. 211); Request for Filing of Receipt Correction in the [REDACTED] application accompanied by [REDACTED]'s Certificate of Mailing from Tallahassee, Florida dated [REDACTED] 3, 2000 and received by the PTO on [REDACTED] 7, 2000 (C's Ex. 187).

Moreover, the record contains evidence that certified mail "green cards" signed for at Respondent's address in Louisiana were returned to the PTO by mail in timely manner. *See*, C's Ex. 359 signed for on September 1, 2001, received by PTO September 5, 2001; C's Ex. 383 signed for on December 8, 2001 and received by the PTO on December 11, 2001; C's Ex. 387 signed on March 4, 2002 and received by the PTO on March 12, 2002.

Finally, based upon common experience, as supported by Mr. Ippolito testimony, I recognize that it is possible for an article of mail sent within the three day delivery zone to take 10 days or more to be delivered to Washington, D.C. Moreover, I accept that it is "possible, highly improbable, but possible" for an article of mail to be lost.<sup>27</sup> Tr. 532, 546. However, in this instance, there is simply no persuasive explanation which can be divined from the record as to why all three of the filings at issue here, all allegedly sent within a 10 month period, were *all* received by the PTO so long (38-192 days) after the dates shown on the certificates of mailing, when so many other mailings by Respondent and by others are delivered in a timely manner. Moreover, in each case of delay, the legal effect of having the certificate of mailing date substantially earlier than the actual receipt date was potentially very legally significant - in that the applicant would avoid the adverse consequences of having its application deemed abandoned based upon a failure to timely respond to the PTO's Office actions. It simply defies credibility and common experience that *all* three of these mailings would fall within the very small percentage of mail that is not delivered by the Post Office in a timely manner, but rather is received, *out of the blue*, long after they were

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<sup>27</sup> Mr. Ippolito testified that there is a process for people to file complaints about delays in mail delivery, and if the postal service even received a single complaint from an area it would investigate, numerous complaints would result in high management level response. Tr. 554-555. While Mr. Bode asserted during the hearing that he often does not receive filings from the PTO, there is no allegation nor evidence that Mr. Bode ever filed a complaint about his mail service with the Postal Service.

sent.<sup>28</sup>

Thus, while there is no direct evidence as to backdating in regard to Count 1 and 2, there is significant circumstantial evidence. In *Klein v. Peterson*, 866 F.2d 412 (Fed. Cir 1989), cited by Complainant in his Brief, the Court held that to prove a misdating violation the PTO need not prove intent to mislead with direct evidence; "rather, circumstantial evidence may permit an inference of intent." *Id.* at 415. *Klein* involved an attorney from New York and Connecticut who was charged with submitting to the PTO eleven backdated certificates of mailing. Relying upon circumstantial evidence regarding exceptionally long mail delays (8 to 50 days) experienced by the Respondent and not others in his firm or other area firms, entries or lack thereof in the firm's mail log, and dates on checks and client correspondence, the Court found that the PTO had proved by clear and convincing evidence that the Respondent had misdated the certificates.<sup>29</sup> *Id.*

Therefore, upon consideration of all the evidence in the record, I find by clear and

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<sup>28</sup> It is interesting, however, that although all the filings at issue here were made very close to a filing deadline of great import, Mr. Bode chose to neither file them by facsimile as provided by the PTO rules or send them by, for example, express mail to assure their timely arrival, as he filed other papers with the PTO. See, C's Ex. 714 (indicating Mr. Bode send the [REDACTED] application to the PTO by express mail and it arrived that same day). Further, although Respondent was aware of the short time frame for filing his clients' responses in each of these cases, in none of the them is there any allegation or evidence in the record that he made any effort to confirm the PTO's timely receipt of the filings by telephone or otherwise or retain independent documentary evidence which, if non-receipt occurred, he could use to prove to the PTO his timely mailing. Moreover, there is also no evidence even as to the [REDACTED] case where the response was received over six months late and in the interim a notice of abandonment mailed to Respondent, that Mr. Bode ever made even the slightest effort to challenge the PTO's determination that a timely filing had not been made.

<sup>29</sup> Unlike *Klein*, neither Complainant nor Respondent offered into evidence in this case, mail logs, checks, or client correspondence regarding the three certificates of mailing at issue here, although there is some evidence in the record suggesting that, like the practitioner in *Klein*, Respondent routinely sent copies of his filings with the PTO, fairly contemporaneously to his clients. See, C's Ex. 395 (letter from Mr. Bode to [REDACTED] dated December 23, 1998 stating "Please find enclosed a copy of your above-referenced utility patent application which was mailed today for filing in the U.S. Patent Office."); C's Ex. 395 (Mr. Bode reporting to client by letter dated December 8, 1998 on trademark applications filed November 16, 1998); C's Ex. 432 (letter from Respondent to [REDACTED] enclosing copy of Response to Patent Office Examiner's action that was "prepared and mailed today for filing."); C's Ex. 433 (correspondence with client enclosing utility patent mailed that day for filing); C's Ex. 443 (enclosing divisional application mailed "today" for filing). There is, in fact, no documentary or other evidence in the record at all corroborating Mr. Bode's testimony that the three mailings at issue were made on or before the dates reflected on the certificates.

convincing evidence that the certificates of mailing at issue in Counts 1, 2 and 3 do not accurately reflect the date those filings were mailed and therefore find that in regard thereto Respondent violated Disciplinary Rules 10.23(b) by engaging in conduct involving misrepresentation, 10.23(b)(6) by engaging in conduct that adversely reflects upon his fitness to practice, and 10.23(c)(9) by knowingly misusing certificates of mailing.

As to Complainant's assertion that the misdated documents reflect Respondent's neglect of matters entrusted to him in violation of 37 C.F.R. § 10.77(c), the evidence of record does show that in regard to each case, Respondent did not act promptly to protect his clients' interests upon being retained. For example, in regard to Count 1, Respondent was retained by his client [REDACTED] in regard to his then pending application on [REDACTED] 5, 2000, that being the date Mr. [REDACTED] signed the Revocation and Substitution-Power of Attorney. C's Exs. 249-250. At that point, what was needed to pursue the application and the interests of the client was for a response to the previously issued Office Action to be promptly filed, i.e. by the [REDACTED] 14, 2000 deadline. C's Ex. 251. Nevertheless, the response was not filed by Respondent until approximately [REDACTED] 22, 2001 (albeit with a certificate dated September 11, 2000). *Id.* In the interim, [REDACTED]'s application was deemed abandoned by the PTO (C's Ex. 247), a determination that Mr. Bode apparently never challenged; he suggested at the hearing that he did not do so because he lost contact with the client. Tr. 615-17.

Similarly, in regard to Count 2, the record shows that Respondent was retained by his client [REDACTED] on December 29, 2000. C's Exs. 169-70. By virtue of the Office Action issued October 4, 2000, Respondent had only until January 4, 2001 to file a response. Respondent did not do so, however, in that the PTO did not receive his response until March 16, 2001. C's Exs. 162-167. C's Exs. 167: Tr. 382-83. As to Count 3, Respondent was retained by [REDACTED] on December 18, 1998 to file the initial patent application. C's Ex. 30. Respondent was aware that he had only until March 9, 2000 to file a response to the office action issued by the PTO on December 9, 1999. C's Exs. 51-56. Nevertheless, Respondent did not submit his response until approximately April 10, 2000, a month after the filing deadline expired. C's Exs. 37-43.

Therefore, the record supports the finding that Respondent neglected matters entrusted to him in violation of 37 C.F.R. § 10.77(c).

#### **B. Failure to Respond to Requirements for Information**

Counts 4 and 5 of the Second Amended Complaint arise out of "Requirements for Information" (RFIs) sent by the PTO's Office of Enrollment and Discipline (OED) to Respondent pursuant to Rule 10.131. That Rule provides in pertinent part that:

(a) The Director is authorized to investigate possible violations of Disciplinary Rules by practitioners. . . .

(b) . . . A practitioner shall cooperate with the Director in connection with any investigation under paragraph (a) of this section and with officials of the Office in connection with any disciplinary proceeding instituted under § 10.132(b).

37 C.F.R. § 10.131.

A RFI is essentially a discovery device used by OED to gather information in connection with an investigation of possible violations of PTO Disciplinary Rules. It consists of a series of written interrogatories, requiring a written response, directed to a PTO practitioner inquiring into the circumstances surrounding one or more possible violations. Tr. 463-64.

Complainant alleges that Respondent failed to respond to RFIs issued to him by OED and that such failures constitute violations of 37 C.F.R. § 10.23(b)(5)(engaging in conduct prejudicial to the administration of justice), citing *Nebraska State Bar Ass'n v. Rothery*, 619 N.W.2d 590 (Neb. 2000); § 10.23(b)(6)(engaging in conduct adversely reflecting upon fitness to practice before the PTO) citing *Nebraska State Bar Ass'n v. Kirshen*, 441 N.W.2d 161 (Neb. 1989); and § 10.23(c)(16)(willfully refusing to reveal or report knowledge or evidence to the Director), citing *Weiffenbach v. Turner*, 20 USPQ2d 1103 (Comm'r Pat. 1991)

The evidence of record establishes that on April 18, 2001, OED sent a First RFI to Respondent at his office address in New Orleans, by certified mail, return receipt requested.<sup>30</sup> C's Exs. 343-47; Tr. 470. The April 18<sup>th</sup> RFI sought Respondent's input regarding the circumstances surrounding his certificate of mailing in the [REDACTED] application which is the subject of Count 1 discussed above. C's Ex. 343. The RFI requested that Respondent reply to it within thirty days.<sup>31</sup> C's Ex. 343; Tr. 471. OED subsequently received through the mail a "green card" evidencing delivery of the First RFI to Respondent's office address on May 12, 2001, although it was signed for on Respondent's behalf by Mr. Bode's neighbor. C's Ex. 353; Tr. 471-72, 492, 619. On June

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<sup>30</sup> Mr. Bode's office address of 2314 Broadway, New Orleans, Louisiana 70125, is the official mailing address which Respondent provided for himself to the PTO on the December 5, 1991 Data Sheet for the Register of Patent Attorneys and Agents. C's Ex. 341, *see also*, Tr. 376-77. It is also the address which Mr. Bode identified for himself on various filing he made with the PTO. *See*, C's Ex. 4 ([REDACTED] application filed December 28, 1998), C's Ex. 72 ([REDACTED] application filed [REDACTED] 20, 1999); C's Ex. 249 (Revocation and Substitution - Power of Attorney dated [REDACTED] 1, 2000). Further, it is the address used by Respondent in connection with pleadings filed in this matter. *See e.g.*, Respondent's Answer and Answer of Amended Complaint. It appears to be adjacent with the home address of [REDACTED] which Mr. Bode provided for himself to the PTO in 1980. C's Ex. 342.

<sup>31</sup> The RFI contained a reminder of a practitioner's duty to cooperate in any investigation under 37 C.F.R. §§ 10.131(b) and 10.23(c)(16) and that failing to respond could be construed as a failure to cooperate, subjecting Respondent to disciplinary action. C's Ex. 343.

7, 2001, OED sent Respondent, by certified mail, a "First Notice: Lack of Response," noting that it had not received any response to the April 18<sup>th</sup> RFI and requesting a response within 30 days. C's Ex. 355; Tr. 473-74. The green card for that certified mailing was again returned to OED bearing the signature of someone else who had accepted the mailing on Respondent's behalf on or about June 15, 2001. C's Ex. 356; Tr. 474-75, 493. Two and a half months later, on August 21, 2001, still having received no response to the RFI, OED sent a "Second Notice: Lack of Response" to Respondent concerning the April 18<sup>th</sup> RFI. C's Ex. 358; Tr. 475. The green card on that certified mail was returned to OED on September 5, 2001 bearing a signature dated September 1, 2001 that cannot clearly be identified as Respondent's. C's Ex. 359; Tr. 468-69, 475-76. On September 25, 2001, OED sent to Respondent by certified mail a "Third Notice: Lack of Response" regarding the April 18<sup>th</sup> RFI. C's Ex. 361; Tr. 476. It appears that the OED never received the green card back in response to that certified mailing. Tr. 477.

On October 23, 2001, OED sent by certified mail another, different, First RFI to Respondent at his address in New Orleans, Louisiana. C's Exs. 363-371; Tr. 477-78. The October 23<sup>rd</sup> RFI sought information regarding a number of matters, including the Respondent's certificate of mailing in the [REDACTED] application (which is the subject of Count 3 above) and Respondent's filing of the [REDACTED] continuation in part application (which is the subject of Count 6 discussed below). *Id.* This RFI also requested a response within 30 days. C's Ex. 364; Tr. 477. OED never received a green card back evidencing Respondent's receipt of this certified mailing nor a response to the RFI. Tr. 478. As a result, on November 28, 2001, OED sent Respondent a "First Notice: Lack of Response" regarding the October 23<sup>rd</sup> RFI. C's Ex. 382; Tr. 478, 480, 487. The green card evidencing receipt of that mailing was returned to OED on December 11, 2001, bearing the signature of someone other than Respondent who signed for the mailing on December 8, 2001 and identified him or herself Respondent's "agent." C's Ex. 383; Tr. 480, 487-88. Again, no response to the RFI was received. Tr. 488. As a result, on December 28, 2001, OED sent Respondent a "Second Notice: Lack of Response" regarding the October 23<sup>rd</sup> RFI. C's Ex. 385; Tr. 488. The green card for that mailing was returned to OED on March 12, 2002 with an unreadable signature for Respondent dated March 4, 2002. C's Ex. 387; Tr. 489. No response to the RFI having been received, a Third Notice was sent to Respondent by the OED by certified mail on February 1, 2002. C's Ex. 388; Tr. 489. No green card was apparently received by OED in regard to the Third Notice. Tr. 490.

Thus, the record contains no documentary evidence clearly confirming Mr. Bode's personal receipt of either of the RFIs or the follow-up notices relating thereto at any point.<sup>32</sup> However,

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<sup>32</sup> At the hearing, Mr. Ippolito of the Postal Service testified that certified mail is handled differently at the delivery point from regular mail. Tr. 531. At the delivery point, the mail carrier is obliged to deliver certified mail to the named recipient and fill in the blank spaces on the "green card" (Form 3811) with the date of delivery and have the recipient sign it. Tr. 537-59. Further, he opined that no one other than the named addressee is supposed to sign for it, unless there is proof of agency. Tr. 544, 547, 550-51. If the addressee of the certified mail article is not at the  
(continued...)

Mr. Anderson, the OED investigator who drafted the RFIs, testified at the hearing that, on November 26, 2001, he personally spoke to Mr. Bode regarding the second RFI issued to him by OED on October 23, 2001. Tr. 461-62, 466, 482-83. Specifically, Mr. Anderson stated that he had telephoned Mr. Bode on that day to advise him that OED had opened a new post office box due to the delay in receipt of mail caused by the closure of the Brentwood Post Office facility as a result of anthrax contamination. Tr. 481-83. Initially unable to reach Mr. Bode in person, he left a voice mail message instructing Respondent to send his response to the RFI to OED's new post office address. Tr. 484. Mr. Anderson testified that, later that same day, Mr. Bode personally returned the telephone call. During that conversation, Mr. Anderson advised Mr. Bode that the OED had not yet received his response to the October 23, 2003 RFI. In response, Mr. Bode did not deny receipt of the RFI and, in fact, claimed to have already mailed to the PTO his response to it. Further, Mr. Bode represented to Mr. Anderson that while he did not have a copy of his response with him at the location where he was at the time of the call, he would have his secretary forward him a copy of the response which he would then forward onto the OED. Tr. 485-86. However, Mr. Anderson testified at the hearing that, to date, the PTO has never received a response to either of the two RFIs or any of the six lack of response notices from Mr. Bode. Tr. 473-478, 487-90. See also, Tr. 366 (testimony of Mr. Moatz as to PTO's lack of receipt of responses to the RFIs sent to Mr. Bode).

Moreover, while Mr. Bode asserted at the hearing that he did not receive "some of the documents" relating to the RFIs and that his receipt of some of the other documents was delayed, he did not deny eventually receiving the two RFIs at some point. Tr. 619-20. Moreover, he asserted that he responded to both of the RFIs, separately, probably on the same day they were received by him, but could not recall exactly when he mailed OED his responses. Further, he claimed that he had sent copies of his responses to the RFIs to OED not once, but several times, including in response to a conversation with a person from the PTO, although he did not recall specifically if that person was Mr. Anderson.<sup>33</sup> Tr. 661-668.

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<sup>32</sup>(...continued)  
address at the time of delivery, a notice is supposed to be left directing the addressee to pick up the mail. Tr. 532. However, he acknowledged that a number of certified mail items sent to Mr. Bode were not apparently processed in this manner. Tr. 540-41. Mr. Moatz acknowledged at the hearing being "familiar with misdirected mail" from the Patent Office, although he did not know how often that occurred. Tr. 409. He had no explanation for why Mr. Bode may have received a notice of abandonment in a case in which he was not the registered attorney. Tr. 459.

<sup>33</sup> At the hearing, Mr. Bode stated that he made "*in globo*" responses and objections to the RFIs, meaning he responded or objected to everything similar at once, rather than responding separately to the various requests. Tr. 660, 666, 669. In particular, he stated that he objected to some of the requests in the RFIs; those, for example, requesting copies of client communications, on the basis of attorney-client privilege, believing that the ethics rules of the bar prohibited such  
(continued...)

After consideration of the evidence, I find that Complainant has sustained his burden of proof with regard to Respondent not responding to the RFIs sent as part of his investigation into Respondent's alleged violations of Disciplinary Rules. Despite Mr. Bode's claim that he responded to the RFIs and forwarded such responses to the PTO not once, but several times, I credit the consistent testimony of Mr. Anderson and Mr. Moatz, supported by the documentary evidence of record, that the PTO never received any responses to the RFIs from Respondent. In support of this finding I note that Respondent, without explanation therefor, never produced any copies of his alleged responses to the RFIs at the hearing or during the prehearing exchange process, despite being requested to do so.<sup>34</sup> Moreover, he did not produce any evidence supporting his testimony that he had sent such responses to the PTO at any point, such as certificates of mailing or faxing receipts.<sup>35</sup> This, despite the fact that, during his testimony, Mr. Bode asserted that he creates and maintains copies of his outgoing correspondence, including copies of everything he has filed in the patent office or received from the patent office. Tr. 672-674.

Therefore, I find that in regard Counts 4 and 5, Respondent violated Disciplinary Rules 37 C.F.R. § 10.23(b)(5) (engaging in conduct prejudicial to the administration of justice), § 10.23(b)(6) (engaging in conduct adversely affecting his fitness to practice) and § 10.23(c)(16) (wilfully refused to reveal or report knowledge or evidence to OED).

#### C. Improperly Claiming Priority on Patent Application

Count 6 asserts Respondent violated 37 C.F.R. § 10.23(b)(6)(actions adversely reflecting on fitness to practice) in connection with his filing of a patent application on behalf of [REDACTED]

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<sup>33</sup>(...continued)

disclosures unless authorized by the client. Tr. 669-71. Mr. Bode stated he never sought authorization from his clients which would have allowed him to release the records. Tr. 671.

<sup>34</sup> Subsection 3(B) of the Order Scheduling Prehearing Procedures and Hearing, issued in this matter on July 29, 2002, specifically asked Respondent to produce copies of any and all documents supporting the denials contained in his Answer of the factual allegations made in paragraphs 28, 31, 35, 38, 47, 50, 54, 57 of the Complaint regarding his failure to respond to the RFI and the notices sent in regard thereto. In his original and amended Prehearing Exchange, Respondent asserted that the documents supporting his denials "are in the prosecution history of each matter at issue," and failed to produce any copies of his alleged responses to the RFIs at any point during this litigation.

<sup>35</sup> In the RFIs, the PTO specifically provided a methodology for Respondent to obtain written confirmation of the PTO's receipt of his responses thereto, by utilizing a returned stamped postcard; however, there is no evidence in the record that Respondent ever attempted to or did utilize this methodology at any point. C's Ex. 344.

██████████ by improperly claiming priority to nine previously filed United States patents and seven previously filed ██████████ patents applications. Respondent admitted in his Answer that he had filed the application and claimed priority therein. See, Amended Complaint paragraphs 67 and 68 and Respondent's Answer thereto ¶ 67-68. Thus, the question is whether the priority was improperly claimed, and if so, does claiming priority improperly rise to a level of violation of the Disciplinary Rules.<sup>36</sup>

The record reflects that on August 20, 1999, Mr. Bode filed patent application no. ██████████ for a ██████████ on behalf of ██████████ (application ██████████. C's Exs. 67-115; Ex. 714. In that application, Mr. Bode claimed that it was a "continuation-in-part application of previous applications by the same inventor." C's Exs. 72-75, 714; Tr. 387, 390. In support of this claim, Mr. Bode submitted with the application a "Declaration in Copending Application," signed by ██████████ indicating that the applicant was claiming "priority" under 35 U.S.C. § 119 predicated upon nine previously filed U.S. patent applications which were based upon seven previously filed ██████████ patent applications identified in a "Schedule A" attached. C's Exs. 108-111, 714.

Application ██████████ was subsequently reviewed by a patent examiner. In ██████████ 2001, the examiner issued an Office Action Summary and narrative report on his evaluation of the application in which he found, *inter alia*, that none of the nine prior U.S. applications listed on Respondent's Schedule A were "copending" at the time application ██████████ was filed and that all of the seven ██████████ applications listed were filed more than one year before application ██████████ was filed. Therefore, the examiner concluded that the application did not meet the statutory requirements for claiming the benefit of an earlier filing date under 35 U.S.C. §§ 119 or 120 and indicated that the applicant was required to cancel the references to the earlier filed applications unless corrective action is taken to make the earlier applications copending. C's Exs. 118, 714; Tr. 391-92. The record indicates that Mr. Bode did not reply to or otherwise appeal the examiner's findings within the time allotted and that application ██████████ went abandoned on ██████████ 21, 2001 as a result thereof. C's Exs. 131-32, 714.

At the hearing, Mr. Moatz explained that under patent law a second, presumably related, patent application filed while a first application is still pending (*i.e.*, copending) is entitled to get the benefit of the filing date of the first application. This "benefit of priority" in time for a subsequently filed application avoids the risk of having intervening references used against the prosecution of the later application or in obtaining any ensuing patent. Tr. 386-387, 391-92, 441-43. Mr. Moatz stated that Respondent claimed the benefit of priority in connection with application ██████████ although he was not entitled to do so because of a lack of "co-pendency." *Id.*

Mr. Bode's testimony in response to this alleged violation was extremely limited. He

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<sup>36</sup> In the Second Amended Complaint, the Complainant also alleged under Count 6 a violation of 37 C.F.R. § 10.77(c)(neglecting a matter entrusted), but does not pursue such a claim in his Brief. Complainant's Brief at 49-51.



stated merely that --

"Mr. Moatz also talked about the benefit of priority in filing a patent application. I disagree with what he said, I believe that priority is proper in that case, improperly claimed. So, I don't agree with what he said. I believe he gave a legal opinion and I disagree with him as far as that's concerned." Tr. 619.

Respondent did not elaborate further as to what he meant regarding the assertion that "priority is proper," although "improperly claimed."

The statutes at issue and the relevant case law appear to support Complainant's assertion that Respondent could only claim priority on the [REDACTED] application if the prior related U.S. applications were still pending, i.e., had not yet been abandoned or granted, or if the foreign applications had been filed less than one year before the subsequent U.S. application was filed.

Specifically, 35 U.S.C. §120 provides in pertinent part -

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, *if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. . . .* (italics added).

Further, 35 U.S.C. § 119(a), entitled "Benefit of earlier filing date; right of priority" provides in relevant part that --

An application for patent for an invention filed in this country by any person who has . . . previously regularly filed an application for a patent for the same invention in a foreign country . . . shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, *if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed*; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing. (Emphasis added).

See also, *In re Costello*, 717 F.2d 1346 (Fed. Cir. 1983) (co-pendency and reference to prior application in subsequent application are statutory requirements for claiming the benefit of

the earlier application's filing date), *Rajchman v. Herbert*, 312 F.2d 926 (C.C.P.A. 1963)(to meet requirements of section 119 patentee must claim priority before patent was granted); *Struthers Patent Corp. v. Nestle Co., Inc.*, 558 F.Supp. 747, 852 (D.N.J. 1981)(for a U.S. application to obtain the benefit of a foreign application date, it must be filed within 12 months of the foreign application).

Without an explanation at hearing and lacking a post-hearing brief, it is impossible to discern from the record exactly what Mr. Bode meant when he said that in regard to application [REDACTED] that priority was proper, but improperly claimed. Respondent has proffered no evidence which would support a finding that the PTO examiner's factual findings were erroneous, i.e., that one or more of the U.S. patents listed on Schedule A were, in fact, pending at the time he filed the application [REDACTED]. In fact, as to three of the nine U.S. applications identified therein, Mr. Bode himself indicated that patents had issued thereon. Further, he indicated on Schedule A that all of the foreign applications were filed at least 12 months prior to the filing of the [REDACTED] application.

Respondent's failure to explain to the patent examiner in connection with application [REDACTED] or to this tribunal his justification for claiming priority suggests that, at best, he was unaware of or confused as to the regulatory criteria for on claiming priority in 35 U.S.C. §§ 119 and 120 or at worst that he intentionally disregarded such criteria in the hope of obtaining a benefit to his client unwarranted by the facts and regulations.

Although Mr. Bode has neither proffered a good explanation for claiming priority in application [REDACTED] nor expressed remorse for having done so at least improperly, either of which would be more appropriate responses than the response he gave at the hearing, I am hard pressed to see this error in filing, with no history of prior or subsequent similar errors, as rising to the level of a violation 37 C.F.R. § 10.23(b)(6) i.e., evidencing an action adversely reflecting on fitness to practice. Mr. Bode did apparently truthfully disclose in application [REDACTED] the status and filing dates of the prior applications based upon which he was claiming priority. At most, this would be a small technical violation of little significance since it appears that the error was discovered by the patent examiner and the application went abandoned thereafter. Therefore, I decline to find a violation under Count 6.

#### D. Improperly Providing Legal Services

The Complaint charges Respondent in 8 separate counts (nos. 3, 8-10, and 17-20) with improperly providing legal services to three of his patent application clients - [REDACTED], [REDACTED], and [REDACTED]. These assertions are discussed in detail below.

1. [REDACTED]

In addition to the allegation of misuse of a certificate of mailing, Count 3 also alleges that Respondent violated Disciplinary Rules 37 C.F.R. § 10.23(c)(8)(failing to inform a client of correspondence), § 10.77(c)(neglecting a matter entrusted to him), and §10.84(a)(2)(failing to

carry out a contract of employment) by his failure to inform his client [REDACTED] regarding correspondence he received from the PTO concerning [REDACTED]'s patent application (no. [REDACTED]).

Specifically, Complainant alleges and the record shows that on December 28, 1998, Mr. Bode filed a patent application (no. [REDACTED] 7) for a [REDACTED] assembly on behalf of [REDACTED] C's Exs. 4-36. Almost a year later, on December 9, 1999, the PTO issued an Office Action in response, requiring the submission of additional documentation within three months, i.e. by March 9, 2000. C's Exs. 51-56. On April 10, 2000, a month after the deadline expired, the PTO received a response to the December 9<sup>th</sup> Office Action with a certificate of mailing from Mr. Bode dated March 2, 2000. C's Exs. 37-47. Nevertheless, the PTO accepted and acted upon the filing and, on April 19, 2000, it sent to Mr. Bode a Notice of Allowability and Notice of Allowance and Issue Fee Due. The April 19<sup>th</sup> Notices advised Respondent that the application is allowed for the issuance of a patent and that to proceed with issuance, an issue fee of \$605 and new formal drawings must be submitted three months from the mailing date of the Notice, i.e. by July 19, 2000. C's Exs. 48-50. The Notice warned that if the issue fee was not paid within the time allotted "THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED." C's Ex. 48 (emphasis in original). The PTO did not receive the issue fee within the allotted time and, as a result, on August 28, 2000, the PTO mailed to Mr. Bode a Notice of Abandonment in regard to [REDACTED]'s application.<sup>37</sup> C's Exs. 58, 62. Complainant alleges that Mr. Bode never informed his client, [REDACTED], about the issue fee due, never paid such fee, and never informed his client of the Notice of Abandonment or that the application could be revived.<sup>38</sup>

Mr. Bradley Hanssen testified at the hearing regarding the circumstances surrounding the filing of his patent application. He stated that he and two partners started up the [REDACTED] Company with the expectation they would secure patents and trademarks on products that they could then market in response to a new Federal law mandating the use of [REDACTED] products [REDACTED] construction. Tr. 36, 40, 73-77. In connection therewith, in May of 1998, he hired Mr. Bode "to walk our patent process [sic] through the patent office from beginning to end to get us a patent and trademark for the [REDACTED]," he

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<sup>37</sup> It appears that the PTO provides a methodology for attorneys to have the PTO automatically charge a "Deposit Account" they maintain for certain fees, including issue fees. However, in regard to this application Mr. Bode did not check the box on the form filed with the original application allowing the PTO to withdraw the issue fee from his account. C's Ex. 28. The record reflects, however, that Mr. Bode used his deposit account for such purposes in regard to other accounts. C's Ex. 202 (Fray application).

<sup>38</sup> Mr. Moatz testified at the hearing that it is the practice of the PTO to mail communications regarding applications only to the attorney of record and not to the applicant, and to do so only by regular, not certified, mail. Tr. 625-26, 444. Thus, a patent attorney bares the burden of keeping himself and his client informed of the status of pending applications.

had invented. Tr. 25-26, 34. [REDACTED] testified that he advised Mr. Bode that they were in a hurry to get the patent because "[i]t was a hot item and we wanted to get it on the market as quick as possible." Tr. 36. Pursuant to that employment relationship, Mr. Bode drafted and filed patent application no. 09/221,377 and was paid for such services. Tr. 38, 41-43, 46; C's Exs. 390-393, 408-409, 411-412. [REDACTED] claimed that, although he had advised Mr. Bode that he "wanted to be kept abreast of all activities" concerning his patent and to receive copies of all correspondence received in regard thereto, in April of 2000, shortly after he had approved the submission of an amended patent application, Mr. Bode ceased communicating with him and that Respondent has made no effort to communicate with him since that point in time. Tr. 34-37. At the hearing, [REDACTED] testified quite unequivocally that Mr. Bode never provided him with copies of the Notice of Allowance and Issue fee due (C's Ex. 48), the Notice of Allowability (C's Ex. 50), or the Notice of Abandonment (C's Ex. 58), nor did he discuss the significance of those documents with him.<sup>39</sup> Tr. 47-53. He asserted that he first learned of the abandonment when he was contacted by counsel for the Complainant in September 2002. Tr. 79.

In response to this testimony, Mr. Bode admitted filing the patent application on behalf of [REDACTED], receiving the initial Office Action in response, contacting [REDACTED] in response thereto, and being authorized by him to amend the application to get certain claims allowed, which he did (C's Exs. 37). Tr. 583-585. Further, Mr. Bode testified that he considered the PTO Office action rejecting and objecting certain claims "not an uncommon situation," and, "a good sign [ ] [t]hat tells you that there are allowable claims and there are just some informalities or technicalities which need to be corrected, and a patent will issue." Tr. 584. However, Mr. Bode emphatically asserted that upon receipt of the April 19, 2000 Notice of Allowability and Notice of Allowance and Issue Fee Due, he *did* contact [REDACTED], advise him of the PTO's issuance of the allowance, and told him that there would be further expenses to pursue his patent application, including \$280 for formal drawings, an issue fee of \$605, and copy fees of \$30. Tr. 65-68, 586-89. Moreover, Mr. Bode stated that he advised [REDACTED] that he needed "a thirty day advance warning" of the filing deadline of July 19, 2000, so he could have the drawings and papers prepared in time. Tr. 589. According to Mr. Bode, [REDACTED] responded to this news [REDACTED]

[REDACTED] Tr. 589. Nevertheless, Mr. Bode said he went ahead and had the drawings done, at his own expense of \$280, "relying on the fact that he indicated he'd [REDACTED] work it out somehow." Tr. 589. Mr. Bode claimed that he made several subsequent calls to [REDACTED] in regard to the application and spoke on several occasions with [REDACTED]'s wife, who acts as his secretary/partner/shareholder in the family business. Tr. 591-92, 621-22 ; *see also*, Tr. 65-66

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<sup>39</sup> [REDACTED] also testified that he hired and paid Mr. Bode to file a trademark application on his behalf. Tr. 54-56; C's Exs. 410-412. He asserted that Mr. Bode also failed to keep him informed regarding that application, that he never advised Mr. Bode that he wanted to abandon the application, and that he was unaware that it too had gone abandoned until he was contacted in connection with this disciplinary proceeding by Complainant's counsel in September 2002. In the interim, unaware of the trademark's abandoned status, he had had brochures and paperwork printed bearing the trademark. Tr. 58-60, 78-79.

(wherein cross-examining [REDACTED] Mr. Bode indicated that he advised [REDACTED] in May of 2000, both in writing and via a telephone conversation with [REDACTED]'s wife/secretary that his "patent was elapsed" and additional fees were due). Mr. Bode testified, however, that [REDACTED] "never followed up," "did not come up with the funds to pursue the case," and "the applications went abandoned because he didn't want to pursue them."<sup>40</sup> Tr. 589-590. Mr. Bode said he had only billed [REDACTED] for work he had done and had not billed him for the final drawings he did. Tr. 589, 615. Mr. Bode claimed that in his experience, this outcome in a patent proceeding, where a client decides not to expend any additional funds to pursue the patent application to the end because in the interim they have discovered that there is no market for it, is quite common.<sup>41</sup> Tr. 591.

Consistent with Mr. Bode's assertions, [REDACTED]'s testimony at the hearing did suggest that his efforts to reach Mr. Bode while the application was pending and his interest in the status of the patent application were nominal. Specifically, he testified that after speaking to Mr. Bode in April 2000, he waited a year or so to hear from him because Mr. Bode had advised him that the patent process was slow and he was aware that it took the PTO a year from when the application had first been filed to respond to it. Tr. 77-78. However, after a year of no contact with Mr. Bode, [REDACTED] said he became concerned about the applications and so, in June or July of 2001 (at another point in his testimony he indicated it was in August of 2002) he attempted to contact Mr. Bode at his Pensacola office by telephone and found the number was not in operation. Tr. 79, 82. Although aware that Mr. Bode maintained other offices, [REDACTED] said he made no further attempts to reach Mr. Bode until he was contacted by the PTO about this case in September 2002 because he was "very busy" and it wasn't that important. Tr. 83-84. Thereafter, he had tried repeatedly to reach Mr. Bode at his Pensacola office, "11 times within the last year," and only reached an answering machine or received a message that the number was no longer in service. Tr. 29, 35-36.

However, in direct contradiction to Mr. Bode's assertions, [REDACTED] was quite unambiguous in his testimony at the hearing that he never told Mr. Bode that he wanted to abandon the patent application (tr. 60) and never told Mr. Bode that he was going to think about

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<sup>40</sup> Mr. Bode testified that [REDACTED]'s trademark application was initially rejected, that there were various steps that could be taken at that point, but that "[REDACTED] didn't want to pursue that either. So in both cases he did not come up with the funds to pursue the case. And I warned him that it would become abandoned and that's what happened. So he didn't want to pursue it." Tr. 590.

<sup>41</sup> At the hearing, Mr. Moatz said while he did not have exact statistics, his understanding was that about two-thirds of patent applications mature into patents, although he was not sure exactly what type of applications that was based upon (i.e. original, continuation or division applications) and that sometimes an original application is abandoned for a continued application. Applications where the patent claims are rejected by the examiner are also considered abandoned. Tr. 417-422, 450.

whether or not to pursue the patent application. Tr. 68. Moreover, he stated unequivocally that he never received any phone call or correspondence from Mr. Bode suggesting that he was not going to take further steps in processing the application. Tr. 81. Furthermore, he stated that when he discovered the application had gone abandoned in September 2002, in prompt response thereto, in October or November 2002, he filed on his own to have the application revived on the basis that Mr. Bode had not informed him of the need to pay the issuance fee, but his efforts were unsuccessful, and he had recently hired new patent counsel to pursue revival on an alternative basis. Tr. 80, 85-91.

Upon consideration of the sharply conflicting testimony of the witnesses and taking into account their demeanor as I observed it and the other evidence of record, I credit the testimony of [REDACTED] and find that Mr. Bode did not adequately advise him regarding the status of his patent application once the Notice of Allowability was issued.

In reaching this conclusion, I note that [REDACTED] testified that Mr. Bode ceased communicating with him regarding the patent application after April 2000 and, in fact, all the documents submitted into the record support this assertion, in that the record contains a variety of correspondence from Mr. Bode to [REDACTED], dated May of 1998 through December of 1998, but nothing thereafter. C's Exs. 390-412. This is the case even though Mr. Bode suggested at the hearing that he had advised [REDACTED], in writing, in "May 2000" that his "patent was elapsed" and that the issue fee was due, and testified that he creates and maintains files for each of his clients, and that in those files he generally maintains copies of correspondence and notes of communications.<sup>42</sup> Tr. 65, 673-74.

Furthermore, I note that in what was probably very early April 2000, [REDACTED] met with Mr. Bode and approved him preparing and filing a response to the PTO's Office action to proceed with the application. Within just a couple of weeks thereafter, in mid-April, the PTO issued its notices regarding the issue fee due. C's Ex. 48; Tr. 49. Mr. Bode suggests that within the interim of those very few short weeks, after expending approximately \$3,780, [REDACTED] changed his mind about proceeding with the application and became unwilling to expend the relatively nominal additional sums (\$900) to actually obtain the patent. Tr. 68; C's Exs. 391-93. Such an assertion, without a clear rationale for such a dramatic change of heart, is not consistent with common experience. Moreover, it is belied by the fact that Mr. Bode testified that after receiving the notice regarding the allowability in mid-April, based upon the conversations he had with [REDACTED] at the time, at his own expense, he went ahead and had the formal drawings needed prepared to respond to the notice. Further, if such a dramatic change of heart did occur, any reasonably prudent attorney would have documented it with a confirmatory letter to his client or, at least, a note to the file, but there is no evidence in this case that Mr. Bode did anything of the sort.

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<sup>42</sup> It is unclear what Mr. Bode meant by the term "elapsed." At that point in the application process, despite the late filing of a response to the office action, the patent application was proceeding forward and the next deadline to be met was that of July 19, 2000.

Furthermore, I do not find the fact that [REDACTED] admittedly failed to actively pursue contact with Mr. Bode regarding the application after April 2000 as evidence of his intent not to proceed. First, I credit [REDACTED]'s explanation that based upon the prior year period it took the Agency to respond to the initial filings, he had no expectation that a response would be received from the Agency so soon after the April filing. Second, as the client, it was not [REDACTED]'s responsibility to stay in touch with Mr. Bode regarding the status of the application. Rather, that burden fell upon his attorney to stay in touch with him. I find [REDACTED]'s prompt action in response to being advised of the abandonment of the patent as clear evidence that at all times relevant hereto, [REDACTED] did, in fact, wish to undertake whatever efforts were necessary to obtain the patent for which he had applied.

Therefore, in regard to [REDACTED]'s patent application, I find Respondent violated Disciplinary Rules 37 C.F.R. § 10.23(c)(8) (failure to inform a client of correspondence), §10.77(c)(neglecting a matter entrusted to him), and § 10.84(a)(2)(failing to carry out a contract of employment) by his failure to inform his client of correspondence received from the PTO concerning application no. 09/221,377.

2. [REDACTED]

Counts 8-10 as well Counts 17-20 of the Second Amended Complaint allege that Respondent violated the same three Disciplinary Rules (37 C.F.R. § 10.23(c)(8)(failure to inform a client of correspondence), §10.77(c)(neglecting a matter entrusted to him), and § 10.84(a)(2) (failing to carry out a contract of employment)) by his failure to inform his clients, [REDACTED] and/or the company he was associated with, [REDACTED], of correspondence received from the PTO concerning their patent and trademark applications.

The evidence of record shows that, in [REDACTED] of 1999, [REDACTED] of 2000, and [REDACTED] of 2000, respectively, Mr. Bode filed three patent applications (nos. [REDACTED] (count 9); [REDACTED] (count 10) & [REDACTED] (count 8)) on behalf of [REDACTED] as inventor/assignor and [REDACTED] as assignee, for an improved retractable cleat device. C's Exs. 446-530, 531-590, 266-340, 713: Tr. 210-11. In each case, the PTO responded to the application by issuing a notice requiring additional submissions on the part of the applicant within three months. C's Exs. 521-24, 579-83, 333-34. Those notices were not responded to within the time deadline and, as a result, the patent applications went abandoned in [REDACTED] 2000, [REDACTED] 2001, and [REDACTED] 2001, respectively. C's Exs. 525, 585, 338-338-1.

Furthermore, the record reveals that in June of 1999, on behalf of [REDACTED], Mr. Bode filed four trademark applications (nos. [REDACTED] 35 (count 17), [REDACTED] 5 (count 18), [REDACTED] (count 19) & [REDACTED] (count 20)). C's Exs. 591-616, 617-651, 652-681, 682-712. In each case, the PTO issued a Notice of Allowance in response to the application setting a six month deadline for submitting either a statement of use or a request for an extension of time to submit such a statement. C's Exs. 616, 644, 674, 704. Neither the statements of use nor requests for an extension were filed within the time allotted and each application was subsequently deemed

abandoned in either September 2000 or August 2001. C's Exs. 592-93, 618, 653, 679, 683, 710; Tr. 402-405.

[REDACTED] and [REDACTED] both testified at the hearing concerning the circumstances surrounding these patent and trademark applications. Tr. 93, 199. Specifically, they testified that in late 1998, they, along with another gentleman [REDACTED], formed the company, [REDACTED]. Tr. 93-94, 100, 173-78, 200-01, 207, 278. At the time of formation, [REDACTED] was the company's CEO and President, and [REDACTED] was its Vice President. Tr. 94, 100, 109, 135, 147-48, 199, 200-01. They created [REDACTED] with the intent of engaging in the business of manufacturing, marketing and selling an [REDACTED], which [REDACTED] had invented, used on [REDACTED]. Tr. 95-96, 175-76, 200, 209-210. In connection therewith, first in late 1998/early 1999, and then subsequently, [REDACTED] hired Mr. Bode to file patent applications for the device and improvements they made thereon.<sup>43</sup> Tr. 96-101, 136-37, 139-40, 201-02, 210-211, 223-25, 244. In addition, at [REDACTED] request, Mr. Bode contemporaneously prepared and filed with the initial application an assignment of the application from [REDACTED] as inventor, to the company, [REDACTED], in exchange for 51% of company stock.<sup>44</sup> Tr. 102, 136; C's Exs. 427-29, 177-179. Subsequently, [REDACTED] also retained Mr. Bode to apply for registration of four trademarks used by the company. Tr. 202, 251-53, 259-60, 263, 267-68. Both [REDACTED] and [REDACTED] testified that Mr. Bode had billed them for services and fees related to the patent and trademark applications, and that the company, [REDACTED] had paid all those bills, totaling approximately \$6-8,000 (C's Exs. 416-19, 422-24), including paying in advance the issue fee of \$605 for the first patent application (no. [REDACTED] he filed on their behalf. Tr. 98-100, 127-28, 166-68, 171-72, 211-212, 215-16, 218-220, 233-234, 247, 255-56; 260-61, 263-64, 268-69, 314-16.

Further, [REDACTED] testified that he explicitly advised Mr. Bode that he wanted to be "kept up to speed on what response he got as far as the patent application." Tr. 104-05. [REDACTED] testified, that while he may not have explicitly told Mr. Bode to keep him informed of the status of the applications, he expected the attorney he hired to do so nevertheless. Tr. 203, 208, 215-16, 221, 235, 237, 248, 256-57, 258-59, 262, 266, 271-72. Consistent with this, Messrs. [REDACTED] both testified that, in fact, initially after they hired him, Mr. Bode did communicate with [REDACTED]

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<sup>43</sup> The original application at issue here, application no. [REDACTED], was for an [REDACTED] in that [REDACTED] had previously obtained at least one patent on a [REDACTED] U.S. Patent No. [REDACTED]. C's Exs. 270, 450; Tr. 95-96. As to the other applications at issue here, application no. [REDACTED] was a continuation-in-part application of application no. [REDACTED] and application no. [REDACTED] was a divisional application of application no. [REDACTED]. See also, Tr. 223-24.

<sup>44</sup> The document memorializing the assignment, however, does not reflect the stock as the consideration for the assignment. See, C's Exs. 573-75. It appears that [REDACTED] as inventor refused to sign the continuation-in-part application (No. [REDACTED], where he was identified as a "co-inventor," but did sign the divisional application ([REDACTED]. C's Ex. 534-536, 713



them, by telephone and mail, regarding the status of their applications. Tr. 105-07, 112, C's Exs. 415-422, 425-431. However, both Messrs. [REDACTED] stated that over time Mr. Bode ceased actively communicating with them.

Specifically, [REDACTED] testified that his last contact with Mr. Bode was a telephone call in [REDACTED] of 1999 during which Mr. Bode advised him that he was no longer authorized to discuss [REDACTED] matters with him, told him was no longer Mr. Bode's client, and advised him that if he had any questions regarding the applications, he should speak to [REDACTED]. Tr. 112-113, 131. 151-52. [REDACTED] testified that the last written communication he received from Mr. Bode regarding the [REDACTED] applications was a letter dated [REDACTED] 1, 2000 regarding the filing that day of one of the patent applications. Tr. 203-04; C's Ex. 443. The last written communication he sent to Mr. Bode was a fax dated [REDACTED] 28, 2000 regarding altering the material out of which the product for which the application was pending would be manufactured, to which Mr. Bode never responded. Tr. 205-06; C's Exs. 444-45. [REDACTED] suggested at hearing that he may have had a telephone conversation with Mr. Bode in 2001 regarding the applications during which Mr. Bode represented he would check into the status of the patent applications, and recalled that prior to [REDACTED] 2002, he had "attempted to contact him [Mr. Bode] regarding patents, and we played a little phone tag, but I never did get to talk to him." Tr. 207-08, 277-78.

Moreover, both Messrs. [REDACTED] testified that Mr. Bode never discussed with them the issuance of, nor provided them with copies of, the Office Action Summaries (C's Exs. 333-37, 579-584), Notice of Allowability (C's Exs. 521-24) and Notices of Allowance and Issue Fee Due (C's Ex. 524), Notice of Allowances (C's Exs. 616, 664, 674, 704) or Notices of Abandonment (C's Exs. 338-338-1, 525, 585,) issued by the PTO in regard to the patent and trademark applications. Tr. 121, 123-26, 131-32, 213-216, 221, 234-37, 247-50, 256, 258, 261-62, 265-66, 269-71. Additionally, they asserted that Mr. Bode never made them aware of the need to respond to those Notices by a date certain, nor the effect of failing to do so. Tr. 215, 221, 267. Finally, they both strongly denied ever telling Mr. Bode at any point to not forward information he received from the patent office concerning the applications to them, to not to discuss the documents he received from the PTO with them, or to abandon the applications. Tr. 123, 169-70, 208-09, 271. As to the trademark applications, [REDACTED] vehemently denied having any discussion with Mr. Bode regarding the need to use the trademarks to keep the applications alive and that specimens of that use along with the affidavit and fee had to be filed. Tr. 303, 312-13. In fact, he strongly denied having any understanding that while the application was pending, [REDACTED] had to do anything in order to proceed to issuance. Tr. 332.

[REDACTED] further testified at the hearing that he first learned that the patent applications had become abandoned for failing to pay the issue fees when he was contacted in connection with this litigation against Mr. Bode by Mr. Polk, Complainant's counsel, in or about September 2002. Tr. 129-30, 158-59. In response, he immediately contacted [REDACTED] and discovered that he too was unaware the patent applications had gone abandoned. Tr. 157-162. [REDACTED] also promptly contacted an attorney in the patent office to obtain information regarding reviving the patents. Tr. 129-30, 163-64. Within a week of receiving notice of the abandonments, [REDACTED] engaged another attorney to file the requisite papers and fees to revive the patent applications. Tr. 129-30,

██████████ said that after he was notified by ██████████ that their patent applications had gone abandoned, he "was pretty hot."<sup>45</sup> Tr. 228. He recalled reacting to the news by immediately attempting, on August 16, 2002, to contact Mr. Bode by telephone and, failing to reach him, left messages for Mr. Bode at both his New Orleans and Pensacola offices. However, ██████████ said Mr. Bode never returned these calls. Tr. 207-08, 227-28, C's Exs. 433-34. He also tried to reach Mr. Bode by telephone at his Lakeland office, but discovered the phone had been disconnected. Tr. 228. ██████████ said he then also contacted the PTO directly and was advised that the applications were deemed abandoned in ██████████ 2000 for failure to pay the issue fee due. Tr. 229-31. Furthermore, ██████████ confirmed ██████████ testimony that, in an effort to avoid losing the patents on the products, together they immediately contacted other counsel and instituted an effort to revive the patent application filing the requisite papers and paying the necessary fee by Federal Express. Tr. 130, 133, 165-66. ██████████ also testified at the hearing that he first discovered trademark applications had gone abandoned the day prior to hearing, when so notified by Complainant's counsel. Tr. 271.

At the hearing, Mr. Bode did not deny filing the patent applications at issue here nor most of the subsequent history of those applications as reflected in the record. Tr. 606-07. The one exception he took to the history was the assertion that he had failed to pay of the issue fee in regard to the original patent application (no. ██████████). During his testimony, Mr. Bode acknowledged that he had received from ██████████ in advance, the issue fee in connection with the original patent application. C's Exs. 442, 524. However, contrary to the Complainant's assertion, Respondent claimed that he *did* forward the issue fee to the PTO, in a timely manner, although he acknowledged that the PTO file did not reflect that the fee had ever been received. Tr. 646-47. Moreover, he claimed that he had documentation evidencing payment of the issue fee, although he did not offer such evidence at hearing, asserting that he did not have to and because the PTO "would say it was backdated and falsified anyway, just like you've done with everything else I've done." Tr. 648-49. Furthermore, while Mr. Bode indicated that he received one notice of abandonment with regard to one of ██████████'s later patent applications, he claimed he never received the ██████████ 10, 2000 Notice of Abandonment from the PTO in regard to the original application (no. ██████████) and thus, was unaware that the application had gone abandoned due to failure to pay the issue fee until after this action was filed. Tr. 647, 649-51.

Furthermore, in response to Counts 8-10 regarding the three patent applications, Mr. Bode acknowledged that at some point he ceased providing information on the status of the applications to ██████████ but claimed he "always considered ██████████ [rather than ██████████] to be the

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<sup>45</sup> ██████████ attributed his level of anger at discovering that the applications had gone abandoned to the fact that he had to answer to other persons invested in the company on status of patents, that he "absolutely trusted him [Respondent] implicitly," and that, unaware that Respondent had let the applications go abandoned, he had thought so well of him he had sent other business to him. Tr. 275-76, 317-19, 324-326.

client." Tr. 596. Specifically, Mr. Bode explained that [REDACTED] and [REDACTED] had retained him in their capacities as corporate officers of [REDACTED] Tr. 594. He stated that prior to filing the original patent application for [REDACTED], [REDACTED] assigned all his individual interest in the device and related applications to the company. Further, he stated that "during my course of dealings with [REDACTED], it became apparent that [REDACTED] was not happy with the way some of the other interested parties were handling [REDACTED]. And there was some tension between him and [REDACTED] and some other shareholders." Tr. 594; see also, Tr. 149-50, 278-80. Mr. Bode said it was his "preference to deal with one unified voice of the client." Tr. 626. As a result, he "tried to determine the direction [REDACTED] was going to take. And since [REDACTED] was the president, as he stated I instructed him or I asked him whether he wanted me to deal only with him. And that was my preference, and he said it was fine. So I instructed [REDACTED] that I was no longer able to discuss [REDACTED] matters with him. And in that interim he had been fired as an officer in the corporation . . . because there was too much conflict, and he was now only a shareholder . . . I told [REDACTED] I couldn't deal with him anymore, that he actually was never my client. And since he was merely a shareholder he had no authority to act on [REDACTED]'s behalf, that he would have to deal through [REDACTED]" Tr. 595-96; see also, Tr. 626-28, and Tr. 147-48, (wherein [REDACTED] indicates he ceased being an officer of the company in early 2001) and 281-82.

At the hearing, Mr. Bode also acknowledged that his contacts with [REDACTED] diminished with time, but suggested that they did so because of [REDACTED]'s dwindling interest in the applications. Mr. Bode explained that fairly early on in the process a dispute arose between [REDACTED] and a [REDACTED] whom Mr. Bode had determined was a co-inventor of the invention covered by the second application, but who would not agree to sign the application. Tr. 609-10; see also tr. 279-80. He said this dispute over ownership "created . . . quite some complexities for [REDACTED]." In addition, [REDACTED] never produced a product, or a product it could successfully market, and as time went on "funds were becoming tight." As a result, [REDACTED]'s "interest started to wane," as evidenced to him by the fact that he was in contact with [REDACTED] in regard to a number of other matters and that [REDACTED] "never brought up any use by [REDACTED] or what he wanted to do with these other matters or whether he even wanted to spend any other money on it."<sup>46</sup> Tr. 611-12.

Mr. Bode also acknowledged filing the trademark applications for [REDACTED]. Tr. 597. However, he explained that the applications were filed on an "intent to use" basis because

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<sup>46</sup> On cross-examination, [REDACTED] did acknowledge receiving copies of correspondence from and possibly having a conversation with Mr. Bode sometime after [REDACTED] 23, 2002 regarding two trademark applications and/or a patent application Mr. Bode had filed on behalf of [REDACTED], of which [REDACTED] is president. [REDACTED] could not recall such conversation in detail and did not recall raising other matters during that conversation with Mr. Bode, such as the [REDACTED] applications. Further, [REDACTED] said he was unaware if the company otherwise responded to Mr. Bode's correspondence and/or to deadlines established by the PTO on the applications mentioned therein, because those matters were being handled by someone else in the company. Tr. 318-332.

██████ had no product at the time of the filing. Tr. 598-599. When the time came in the application process for filing a statement of use or requesting any extension of time to do so, Mr. Bode said he advised ██████ of the requirements and his options and the significance thereof, in two conversations, "[b]ut ██████ wasn't in a position to keep the application alive," because at that point "they were having problems with production models and some of the lots that they had made, they didn't have any money, they didn't have any employees. And I was . . . basically not given any instructions what to do with this. There was never any intended use related to me and these applications were abandoned." Tr. 605, 603, *see also* Tr. 312. Mr. Bode testified that he advised ██████ of the abandonments. Tr. 605-06. Moreover, he stated that the abandonment of the trademark applications did not cause ██████ to lose any rights in the interim because the rights are based upon use and not formal registration. Tr. 604-05.

Once again faced with sharply conflicting testimony, after observing the demeanor of the witnesses, as well as the other documentary evidence admitted into the record, I am convinced that Mr. Bode did not adequately inform his client ██████ of correspondence he had received on its behalf from the PTO, did neglect matters entrusted to him, and failed to adequately and appropriately carry out his contract of employment.

First, as to Mr. Bode's obligations to ██████ in regard to the patent applications, the record shows that despite the Assignment signed by ██████ in ██████ 1999 (C's Exs. 573-575), from the time he was retained through at least ██████ 31, 1999, Mr. Bode did treat ██████ as his client in that he corresponded directly with him individually concerning seeking his approval of the original and continuation-in-part applications, and billed ██████ individually for his services in regard thereto. *See*, C's Exs. 415-431. The testimony of ██████ and ██████ confirms that there was some type of falling out over the identification of ██████ as a co-inventor with ██████ on the continuation-in-part application (no. ██████ Tr. 149-50; C's Ex. 531-575). However, the falling out appears to be as much between ██████ and Mr. Bode, as between ██████ and ██████, in that ██████ said he too did not agree with Mr. Bode's decision to identify ██████ as a co-inventor on the continuation-in-part application, although he apparently capitulated to Mr. Bode's determination whereas ██████ would not. Tr. 279-80, 609-10. Furthermore, while ██████ admits at some point acquiescing to Mr. Bode's request to deal directly with him on the applications because he viewed Respondent as "the boss" (tr. 281-82), and ██████ admits that Mr. Bode advised him of this fact, Mr. Bode stated that nevertheless, ██████ continued to contact him about the patents and acknowledges that ██████ at some subsequent point gave Mr. Bode permission to send ██████ copies of documents relating to the applications. Tr. 596, 628. As a result, Mr. Bode said he continued to send to ██████ copies of various documents which he sent to ██████ on behalf of ██████, at least, according to ██████ through ██████ of 1999, which was prior to the filing of the continuation-in-part application. *Id.* At that point, however, it appears that Mr. Bode ceased communicating with ██████ without further explanation or justification. ██████ testified that despite the assignment of his interest in the application and device to ██████ it was always his understanding that he was authorized to continue to act on behalf of the corporation and that no one in the corporation ever told him otherwise. Tr. 180-81. All this belies the suggestion by Mr. Bode that he ceased all communications with ██████ at the direction of the corporation.

Further, as to Mr. Bode's allegation that he had no obligation to continue to stay in contact with [REDACTED] because [REDACTED] ceased being a corporate officer, the testimony at the hearing showed that event occurred in 2001. Tr. 135, 148. This was at least a year after Mr. Bode ceased communicating with [REDACTED] and thus could not be the basis for the cessation in communications.

Further, even if Mr. Bode could justify terminating his communications at some point with [REDACTED] he still had an obligation to maintain communications with, provide correspondence to, and seek instructions from someone on behalf of [REDACTED]. Mr. Bode alleges he had such contacts with [REDACTED] which [REDACTED] vehemently denies. The record supports [REDACTED]'s assertions in that the documents of record reflect that the last written communication between [REDACTED] and Mr. Bode occurred on June 28, 2000. The record is devoid of any evidence that Mr. Bode ever sent [REDACTED] copies of any of the Notices of Allowability, Allowance, Issue Fee Due or Abandonment. There is no evidence in the record to support Mr. Bode's assertion that he had any substantive discussions with [REDACTED] regarding proceeding or abandoning the applications and no evidence that [REDACTED] consented to or acquiesced in the abandonment of the seven applications. Moreover, such a conclusion is contradicted by the testimony of [REDACTED], that upon being advised of the abandonments he contacted [REDACTED] who indicated that he had not instructed Respondent to abandon the applications, was not aware of the abandonments, and said he had not heard from Mr. Bode in a year. Tr. 157-59, 161-163, 169. It is also contradicted by [REDACTED]'s testimony that upon being told of the abandonments, he became "pretty hot" and "livid," and as a result, he immediately attempted to contact Mr. Bode and the PTO, and initiated efforts to have the applications revived. Tr. 227-29, 317. The fact that Mr. Bode could not have, to any significant degree, substantively discussed with [REDACTED] the issue of filing statements of use regarding the trademark applications is made clear by the fact that even at the hearing, [REDACTED] credibly testified that he did not understand that the meaning of filing on an "intent-to-use" basis. Tr. 306, 311. Finally, Mr. Bode's assertions in this regard are even contradicted by his own acknowledgment that, upon hearing of the abandonments, [REDACTED] fired him. Tr. 644-45, 647.

In addition, Mr. Bode's claim that the abandonments occurred because [REDACTED]'s interest in the product and applications began to wane is contrary to all the testimony from [REDACTED] about his on-going efforts to promote the product. [REDACTED] testified at the hearing about how after the first \$50,000 of product domestically manufactured in 1999 was found to be too expensive, in [REDACTED] or [REDACTED] 2000, [REDACTED] had the product re-manufactured overseas for less and sold 10,000 of these units nationwide, with the trademark name. Tr. 283-84, 286, 297-98. [REDACTED] said at the time of the sale he represented to the buyer that the patent was pending. Tr. 293. He stated that he and other investors underwrote the cost of manufacturing the product "at the tune of \$100,000" through bank loans secured by anticipated patents and trademarks, loans which would be coming due shortly. Tr. 272-73. In addition, [REDACTED] stated that the product with the [REDACTED] trade name was on "Websites all over the country" and was advertised on the [REDACTED] on the [REDACTED]. Tr. 274, 305. Prior to that, he said, [REDACTED] was using the trademarks on its letterhead. Tr. 305. [REDACTED] also stated that last year (2002) he was negotiating with another company, [REDACTED], to sell the product at as much as

25,000 units a month and that company requested proof of patent in regard to the contract. Tr. 272. While [REDACTED] acknowledged at the hearing that he had not called Mr. Bode to tell him they were selling the product, he presumed Mr. Bode knew that was the intention of having it manufactured. Tr. 285. In fact, the second patent application filed for [REDACTED] ([REDACTED] in filing without the signatures of either of the co-inventors, was on the basis that "the assignee has or will in the immediate future offer for sale a device made in accordance with the invention disclosed in the application. C's Ex. 535. All this activity, geared towards selling the product for which the applications had been filed, supports [REDACTED]'s and [REDACTED] claims that they had every intention of proceeding with the applications through issuance and belies Mr. Bode's claim that [REDACTED]'s interest in the product had waned to the point where he agreed to abandon the applications.<sup>47</sup>

As to Mr. Bode's assertion that the abandonment of the original [REDACTED] patent application (no. [REDACTED]) was unintentional, that he did or attempted to pay the issue fee on the initial patent application (as requested by the Notice of fee Due dated [REDACTED] 14, 2000) and advised his client regarding the same, I note there is some support for this in the record. Specifically, the record contains Mr. Bode's invoice for services dated [REDACTED] 30, 2000 in which he charged [REDACTED] \$200 for the "Preparation and filing of: Issue Fee Transmittal and other formal documents; payment of Issue Fee and advance order copy fee in the above-referenced design patent application."<sup>48</sup> C's Exs. 440-42. That Invoice also shows the issue fee of \$605 in regard to application [REDACTED] (referred to by Mr. Bode as "U.3") as a disbursement. Tr. 442. However, even accepting that Mr. Bode attempted to pay the issue fee he received from [REDACTED] to the PTO in a timely manner, the evidence does not show that he zealously represented his client in this matter or kept his client sufficiently informed. During the hearing, Mr. Bode testified that he was unaware that the application went abandoned as a result of the fee not being received until after this action was filed two years later, in [REDACTED] 2002. Tr. 647. Mr. Bode explained that he did not receive the [REDACTED] 10, 2000 notice of abandonment from the PTO claiming that "[t]here's many documents that I don't receive from the Patent Office." Tr. 650. Accepting this is true, having not received copies of the patent from the PTO in a timely manner, Mr. Bode had an obligation to follow up. It is clear from his testimony that, for over two years after he thought the fee had been paid, he did not do so.

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<sup>47</sup> Mr. Bode admitted at the hearing that under the regulations an applicant for a trademark can request and purchase up to a 24 month extension of filing of a statement of use. Tr. 636. Thus, instead of abandoning the applications, [REDACTED] could have maintained them as pending until [REDACTED] 13, 2003. Tr. 637. According to [REDACTED] by that time [REDACTED] would have been able to submit a statement as to use in that it was selling its product with the trademark starting in 2000, within months of the first trademarks becoming abandoned.

<sup>48</sup> It is unclear why the Invoice refers to payment of an issue fee on a "design" patent application, since it references application no. [REDACTED] which was a utility patent application (see, C's Exs. 416, 418, 420, 530) as were the other patent applications filed by Mr. Bode for [REDACTED] C's Exs. 266, 590.

Thus, I find that in regard to Respondent's dealings with [REDACTED], [REDACTED], and [REDACTED] Mr. Bode violated 37 C.F.R. §§ 10.23(c)(8), 10.77(c), and 10.84(a)(2).

#### F. Summary

Upon consideration of the evidenced proffered in this case, Respondent is found to have committed the violations alleged in Counts 1-5, 8-10, and 17-20.

#### IV. SANCTION

The remaining issue in this case is the type of sanction to be imposed for the violations found. The Complainant is requesting suspension or exclusion.<sup>49</sup> See, Amended Complaint; Complainant's Brief at 51-59. Respondent has not offered an alternative sanction he would deem appropriate if found liable. See, Respondent's Answer to Amended Complaint; Tr. 583-674.

"We must keep in mind that the real and vital issue to be determined in disbarment proceedings is whether or not the accused, from the whole of the evidence as submitted, is a fit and proper person to be permitted to continue in the practice of law." *In re Walker*, 254 N.W. 2d 452 (S.D. 1977) citing *In re Van Rushed*, 160 N.W. 1006 (S.D. 1917). "We start from the premise that protection of the public and bar, not punishment, is the primary purpose of attorney discipline and that we must accordingly consider relevant mitigating and aggravating circumstances." *Coombs v. State Bar of California*, 779 P.2d 298, 306 (Cal. 1989).

As to factors for determining a sanction, the Rules governing this proceeding provide at 37 C.F.R. § 10.154(b) that, "In determining any penalty, the following should normally be considered: (1) The public interest; (2) The seriousness of the violation of the Disciplinary Rule; (3) The deterrent effects deemed necessary; (4) The integrity of the legal profession; and (5) Any extenuating circumstances."

In support of exclusion, Complainant argues in his Brief that Mr. Bode's conduct is both egregious and cumulative. Complainant's Brief at 51. The Complainant asserts that the public

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<sup>49</sup> The Amended Complaint also contained a prayer that Respondent be required to pay all or a portion of the costs and expenses, not to exceed \$1,500 of the disciplinary proceeding leading to the suspension. However, the Complainant's Brief did not contain a similar request. Moreover, there appears to be no authority for an administrative law judge to impose such a requirement in an initial decision. See 37 C.F.R. § 10.154. Rather, 37 C.F.R. § 10.160(c)(2), provides that as a condition of *reinstatement*, after a practitioner has been duly suspended or excluded, the Director may require the individual to pay all or a portion of the costs and expenses not to exceed \$1,500, of the disciplinary proceeding which led to the suspension or exclusion. Therefore, this relief is not addressed further herein.

interest has been violated by Respondent's abuse of the trust placed in him by his clients and his misappropriation of client funds; that the violations are serious because they involve falsification of "official government documents," ignoring the authority of the OED, and causing the clients financial harm. Complainant states that Mr. Bode has shown no remorse for his conduct and made misrepresentations to the OED and that in the interest of maintaining the integrity of the legal profession, exclusion is appropriate, noting Respondent has offered no mitigating factors warranting a reduction in the sanction. *Id.* at 51-59.

After consideration of the whole of the evidence as submitted, I cannot find that Mr. Bode is a fit and proper person to be permitted to continue in the practice of law at this time.

First, in terms of the public interest, I am particularly troubled by the fact that Mr. Bode submitted to the PTO a number of certificates of mailing which were misdated. The PTO is Federal government entity which bears the formidable responsibility of processing all the thousands of patent and trademark applications it receives in a fair and efficient manner for the benefit not only of the applicants individually but the general public as well. The granting of a patent creates a potentially extraordinarily valuable property right for one or more inventors and deprives everyone else of the ability to obtain the same right on the invention. Tr. 433-35, 445-46. In order to achieve its mission and maintain the integrity of the Office, the PTO relies heavily upon the honor of the select bar of attorneys and practitioners allowed to appear before it, in whom it places its trust to deal with it in a forthright manner.<sup>50</sup> By misdating the certificates of mailing, and attempting to rig the system for the benefit of his clients over those of others, Mr. Bode violated that trust and undermined the integrity of the national patent and trademark system.

Further, without a doubt, all of the violations upon which Mr. Bode is found liable herein are serious. However, aside from the misdating of the certificates mentioned above, the most serious appears to me to be Respondent's apparent on-going pattern and practice of failing to communicate with his clients about the work he had been hired by them to perform and his failing

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<sup>50</sup> Mr. Moatz testified that to be admitted to practice before the PTO as a patent attorney requires not only a law degree, but also an undergraduate science degree, good moral character, and passing of a registration examination on procedures, rules and policies. Only approximately 2% of the attorneys in the United States are registered to practice before the PTO. Tr. 410-414. The employees at the PTO work closely with that select bar to process applications. Examiners are supposed to exclusively communicate regarding applications with the attorneys or agent, rather than the client/applicant, and all correspondence regarding applications in process is sent by the agency only to the attorney of record, not the applicant, and then only by regular mail. Tr. 423-256, 444. PTO examiners are expected to advise applicants who contact them directly that they are not going to give them any information. Tr. 541-52. Moreover, the PTO relies upon the truthful representations of those select attorneys in the negotiation which routinely occurs between the applicant's attorney and PTO's examiners in the patent process in order to efficiently process cases. Tr. 415, 422-24, 438-39.



to perform the work he was hired to do.<sup>51</sup> It is clear from the testimony of [REDACTED] and [REDACTED] that those individuals, and perhaps many, if not most, of Mr. Bode's other clients are unfamiliar with patent and trademark law and because of this, and this area of law's unique complexity and procedures, have no real ability to supervise and evaluate the quality of his on-going work. As a result, they must place their trust in him to look out for their interests and to attempt in good faith to satisfy their expectations as to outcomes. For example, [REDACTED] testified that this was his first experience with the patent application process and he did not know anything about what it involved. Tr. 50, 80. He thought he hired Mr. Bode to handle these applications "from beginning to end." Tr. 26. Based upon Mr. Bode's references and his knowledge in the industry of patent research and patent applications, as represented to him by Mr. Bode orally and in writing (C's Exs. 398-407), [REDACTED] stated that he expected that the matters would be brought to a close with the issuance of a patent by the United States Patent Office. Tr. 34. However, looking back, [REDACTED] stated that he feels that Mr. Bode did not live up to his expectations because he failed to adequately communicate with him. Tr. 34-36.<sup>52</sup> [REDACTED] expressed a similar sentiment - that he had no prior experience in patent and trademark matters, was counting on Bode's guidance and expertise, considered him "the boss" regarding handling the patent and followed his advice, and was disappointed. Tr. 203, 282, 312, 313-314.

As to deterrent effects deemed necessary, at the hearing Mr. Bode testified that "Mr. Moatz investigated me at least one on [sic] time before for the same reasons" including hiatuses between dates of documents mailed and received. Tr. 620, 650, 671. That investigation involved the issuance of a letter on April 26, 1988 and an interview conducted by Mr. Moatz of Mr. Bode in his offices in New Orleans. Tr. 651. Mr. Bode stated that "back then [Mr. Moatz] had no basis for bringing the charges, it was dismissed." Nevertheless, when asked what changes he made to his office practices as a result of this issue being raised with him at that time, Mr. Bode said, none. Tr. 671-72. This incident of warning gone unheeded, combined with Mr. Bode's clear lack of contrition, does not suggest he is someone for whom a nominal penalty will deter further

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<sup>51</sup> As to Complainant's assertion that Respondent misappropriated client funds, i.e., filing fees received in advance but not actually transferred to the PTO, I do not see this as a separate violation or as an intentional usurping of client funds by Mr. Bode, but rather part and parcel of Respondent's general neglect of client matters. Unfortunately, Mr. Bode failed to mitigate this issue by offering to reimburse his clients for the misappropriated funds during the course of this proceeding.

<sup>52</sup> There was conflicting testimony at the hearing about whether [REDACTED] and [REDACTED] patents and trademarks would have been of value had they not gone abandoned. Tr. 36-37, 40, 72-73, 165-66, 452, 433-35. Success of an invention commercially is not an element of the application process (tr. 452) and whether an application which never ripened into a patent or trademark would have been at some point invaluable or worthless has no real relevance here. As an attorney, it was Mr. Bode's job to zealously pursue his clients interest in obtaining patents and trademarks and to honestly communicate with his clients the status of the work he was doing for them. In terms of a disciplinary action, the magnitude of a violation of the breach of these duties is not measured by the potential worth of the patent or trademark.

violations.

As to the integrity of the legal profession, there is an thread of dishonesty that runs through this whole case. The record reflects that Mr. Bode did not honestly date his certificates of mailing, did not honestly disclose his actions to the OED in his responses to the RFIs or honestly reveal his unwillingness to answer the RFIs, did not honestly reveal the state of his clients' patent applications to them, and he did not honestly deal with this Tribunal.<sup>53</sup> Respondent has demonstrated no remorse for his actions. He never expressed any regret that his clients [REDACTED] and [REDACTED] feel that his work was unsatisfactory. He never expressed any regret that the OED had to go to all this effort including sending him letter after letter after letter, just to have him focus his attention on the seriousness of his actions.

In terms of extenuating circumstances and/or mitigating factors, Respondent testified that he has successfully handled hundreds of cases and this action involves only a "two disgruntled clients . . . that couldn't be successful in their business" and did not want to pursue their applications. Tr. 671-72. While that characterization of the case may not be completely correct, I agree with Mr. Bode that he is an experienced practitioner in the field of patent and trademark law. He also appears to be a bright and capable man. There is no question but that he successfully practiced his profession for many years hitherto, apparently without significant incident. At all times relevant hereto, he has been a solo practitioner having a "small practice with few clients." Tr. 672. He maintains a number of offices in varied locations to and from which he must travel. Why then, did there apparently come a point in time, sometime in mid-2000, when Respondent ceased actively pursuing the work for which he had been hired to do and risk, at the very least, alienating his clientele and reducing the potential legal fees he would earn? I find it difficult to believe it was simply conscious neglect. After hearing all the evidence, I believe there are external circumstances which could explain this matter better. However, Respondent has offered no such explanation and therefore, there is none for me to consider in determining the appropriate penalty to be meted out in this case.

In determining the appropriate penalty to be imposed in this case, I have reviewed similar cases where backdating of certificates of mailing was the primary violation charged, including *In re Klein*, 1987 Commr. Pat. LEXIS 23, 6 U.S.P.Q.2D (BNA) 1547 (Oct. 19, 1987), *aff'd* 696

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<sup>53</sup> This Tribunal experienced either loss or extensive delay in receipt of filings purportedly sent to it by Respondent or to Respondent to a degree never previously experienced in any of the hundreds of cases previously adjudicated. See, footnotes 3, 5-10 above; Tr. 368-73. It was as a result of this unique circumstance that this Tribunal imposed upon Respondent the unusual obligation to simultaneously serve copies of filings on the undersigned by facsimile as well as by mail, a request to which Respondent strenuously objected on the basis of inconvenience and as to which he did not always comply. In addition, there is the matter of Mr. Bode's repeated but completely unsubstantiated representations to this Tribunal, such as his assertion that he answered the RFIs and that he had evidence that he paid the issue fee in the original [REDACTED] application to the PTO.

*F.Supp.* 695, \* *USPQ2d* 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412 (Fed. Cir. 1989) and *Small v. Weiffenbach*, 1986 Commr. Pat. LEXIS 29 (ALJ 1986), *aff'd* 1989 Commr. Pat. LEXIS 3, 10 U.S.P.Q.2D (BNA) 1898 (Apr. 13, 1989).<sup>54</sup> In both of those cases, the Administrative Law Judge recommended exclusion as a sanction. However, on appeal, in each case the penalty was significantly reduced by the Commissioner of Patents. In *Klein*, although the Commissioner found there were no mitigating or extenuating circumstances, that the Respondent had not cooperated during the course of the proceeding, that he had misleadingly used evidence at the hearing, and that he had made mis-statements of facts in his brief, the Commissioner nevertheless reduced the penalty to what in effect amounted to a two year suspension from practice, followed by five years of probation during which the practitioner was prohibited from using a certificate of mailing. *Klein*, 1987 Commr. Pat. LEXIS 23\*15, 33-34. In *Small*, the Commissioner imposed a higher penalty of a 5 year suspension because the Respondent had involved his secretary in the falsification of mailing dates, was not candid with the PTO when asked about backdating, neglected legal matters entrusted to him, and lacked contrition and remorse.

Were it not for those appellate decisions, like the Administrative Law Judge who heard those cases, I would be inclined to find the appropriate sanction in this case to be exclusion. However, in light of those decisions, a lesser penalty more in line with those imposed in those cases will be considered. In this case, while Respondent denied the charges, he cannot to said to have made any actual affirmative erroneous statements to the OED about backdating in the RIFs since he did not answer them (although he claimed he did), nor did he misuse evidence at hearing (since he offered none), nor did he make any misstatements in his post-hearing brief (since he filed none). No secretary was blamed for the misdating; Respondent took responsibility for all filings. Tr. 657-58. However, like *Small*, he has expressed no contrition or remorse and, as was the case in both *Klein* and *Small*, he neglected matters entrusted to him. All in all, I think the appropriate sanction in this case to be imposed is somewhere between those imposed in *Klein* and *Small*.

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<sup>54</sup> In addition, I reviewed information regarding the *Dula* case cited in the *Small* decision. That case also involved an attorney accused by the Agency of misdating certificates of mailing. The attorney vigorously denied the charge and raised in defense issues regarding problems establishing an independent patent practice, problems he and others had experienced with mail delivery, and actions he had taken to correct those problems. The case was settled with the attorney consenting to essentially a two year suspension, followed by a five year probationary period during which he could not file documents using a certificate of mailing. See, *In re Dula*, 27 BNA's Patent, Copyright & Trademark Journal, No. 658, p. 133 (Dec. 8, 1983).

## **ORDER**

After careful and deliberate consideration of the above facts and conclusions as well as the factors identified in 37 C.F.R. § 10.154(b), it is concluded that, in regard to each count for which Respondent is found liable, a seven (7) year suspension, with execution of the last four (4) years suspended and Respondent placed on probation during that period, is appropriate,


**THEREFORE, IT IS HEREBY ORDERED** that Respondent Bode, PTO Registration No.30,028, is hereby **suspended for a period of seven (7) years from practice before the Patent and Trademark Office**; execution of the last 4 years is suspended and Respondent is being placed on probation for those (4) years. The sanctions for each count are to run concurrently. The terms of probation are:

(i) Respondent shall comply with all Disciplinary Rules applicable to patent attorneys practicing before the PTO; and

(ii) No document in any patent or trademark application can be filed in the Patent and Trademark Office by or on behalf of Respondent which (a) uses a certificate of mailing under 37 C.F.R. § 1.8, and (b) which indicates on the document that the document was prepared by, worked on, or signed by or on behalf of, Respondent.

The Respondent's attention is directed to 37 C.F.R. § 10.158 regarding responsibilities in the case of suspension or exclusion, and 37 C.F.R. § 10.160 concerning petitions for reinstatement.

The facts and circumstances of this proceeding shall be fully published in the Patent and Trademark Office's official publication.

  
Susan L. Biron  
Chief Administrative Law Judge

Date: August 21, 2003  
Washington, D.C.

**Pursuant to 37 C.F.R. § 10.155, any appeal by the Respondent from this Initial Decision, issued pursuant to 35 U.S.C. § 32 and 37 C.F.R. § 10.154, must be filed in duplicate with the Director, Office of Enrollment and Discipline, U.S. Patent and Trademark Office, P.O. Box 16116, Arlington, Va. 22215, within 30 days of the date of this Decision. Such appeal must include exceptions to the Administrative Law Judge's Decision. Failure to file such an appeal in accordance with § 10.155, above, will be deemed to be both an acceptance by the Respondent of the Initial Decision and a waiver by the Respondent of the right to further administrative and judicial review.**

CERTIFICATE OF SERVICE

I certify that the foregoing **Initial Decision**, dated August 21, 2003, was sent this day in the following manner to the addressees listed below.

  
Maria Whiting-Beale  
Legal Staff Assistant

Dated: August 21, 2003

Copy by Regular Mail to:

C. Edward Polk, Jr., Esquire  
Sidney O. Johnson, Jr., Esquire  
Associate Solicitors  
U.S. Patent & Trademark Office  
P.O. Box 16116  
Arlington, VA 22215

Copy by Certified Mail Return Receipt to:

George A. Bode, Esquire  
2314 Broadway  
New Orleans, LA 70125

# APPENDIX A



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

JJGJr.:10-00

Paper 13

ANTHONY D. CIPOLLONE  
ONE ESSEX ST.  
HACKENSACK, NJ 07601

**COPY MAILED**

**JUN 01 2001**

In re Patent No. 5,185,542  
Issue Date: 9 February, 1993  
Application No. 07/750,941  
Filed: 28 August, 1991  
Attorney Docket No. 90081

**OFFICE OF PETITIONS  
A/C PATENTS  
ON PETITION**

This is a decision on the renewed petition filed 6 February, 2001, under 37 C.F.R. §1.378,<sup>1</sup> subsection (b), to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The original petition was filed 29 September, 2000, and dismissed on 6 December, 2000 (the December 2000 Decision), under 37 C.F.R. §1.378, subsection (b), for failure to make a satisfactory showing that the delay was unavoidable.

At that time Petitioner was informed that this would be the only opportunity for reconsideration.<sup>2</sup>

Moreover, Petitioner also was informed that he was to provide any and all supporting documentation with his renewed petition, if filed.<sup>3</sup>

This petition followed. The supporting documentation filed with the renewed petition is described, infra.

**I. JURISDICTION**

The patent issued on 9 February, 1993. The grace period for paying the first maintenance fee expired at midnight on 9 February, 1997. Therefore, the original

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<sup>1</sup> The regulations at 37 C.F.R. §1.378 provide in pertinent part:

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in the payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by §1.20(l) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The surcharge set forth in §1.20(l)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in §1.362(e) and must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The surcharge set forth in §1.20(l)(1); and

(3) A statement that the delay in payment of the maintenance fee was unintentional. (Emphasis added.)

<sup>2</sup> December 2000 Decision, at page 1

<sup>3</sup> December 2000 Decision, at page 3.



petition, filed 29 September, 2000, was not timely filed within twenty-four months after the six-month grace period provided in 37 C.F.R. §1.362(e). Thus, Petitioner's only avenue for relief is under 37 C.F.R. §1.378(b).

The Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable," 35 U.S.C. 41(c)(1), and a petition can be filed under 37 C.F.R. §1.378(b).

## II. STATUTES, REGULATIONS, AND ANALYSIS

Under the applicable provisions of 35 U.S.C. §41(b) and (c):

the Commissioner shall charge fees for maintaining in force all patents filed on or after 12 December, 1980, at the 3-year-6-month, 7-year-6-month, and 11-year-6-month intervals; and

unless payment of the applicable maintenance fee is received in the PTO on or before the date the fee is due or within a grace period of six months thereafter when the grace-period surcharge is paid with maintenance fee, the patent will expire as of the end of the grace period; except that

the Commissioner may accept the payment of any maintenance fee required by the statute if the payment is made:

--within 24 months after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unintentional;<sup>4</sup> or

--at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, i.e., "unavoidable" delay.<sup>5</sup>

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.<sup>6</sup>

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."

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<sup>4</sup> The burden is less onerous to show unintentional delay under the provisions of 37 C.F.R. §1.378(c), the application of that portion of the regulation is limited to those cases in which the 24-month time limitation is satisfied. The payment was not tendered herein within that period.

<sup>5</sup> Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>6</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullah, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>7</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

Finally, a petition to revive an application or patent as unavoidably abandoned or expired cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>8</sup>

The regulations at 37 C.F.R. §1.378(b)(3) require a showing that:

- "the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely," and
- the showing must "enumerate the steps taken to ensure timely payment of the maintenance fee" as well as the reasons why payment was not timely made.

This showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application, and documents regarding the alleged cause of the delay and copies of any documents referred to in petitioner's statement as to the cause of the unavoidable delay are required.

All the causes which contributed to the failure to timely pay the maintenance fee must be presented and supported with appropriate evidence.<sup>9</sup>

Further, petitioner should identify the party(ies) responsible for making the payment: A showing must be made (with supporting documents) outlining the efforts made to ensure timely payment of the maintenance fee--including scheduling and calendaring information, appointment of an individual with the authority and responsibility to pay the fee, and detailing of the causes for a failure in that process.

Petitioner must "provide any *direct evidence* proving exactly"<sup>10</sup> what records and systems were in place to satisfy the showing required under 37 C.F.R. §1.378(b).

### III. BACKGROUND

#### Persons/Offices

- Anthony D. Cipollone: Petitioner/Counsel;
- Unidentified Secretary;
- Unidentified Physician (the photocopy of the billing indicates that the physician may have been a Valavan Subramanian, MD);

#### Payment Windows

After the issue of the patent on 9 February, 1993, the windows for payment of the first maintenance fee opened and closed as follows:

the first window opened on 9 February, 1996, and closed at midnight on 9

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<sup>8</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>9</sup> The showing must also enumerate the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. The showing can be verified by using the attached petition form which includes a declaration according to 37 C.F.R. §1.68. Statements from all persons who contributed to the delay are also required.

<sup>10</sup> See also: Krehn v. Commissioner, 15 USPQ2d 1823 (E.D. Va. 1990) (Emphasis supplied).

August, 1996, for payment without surcharge;

- the second opened on 10 August, 1996, and closed at midnight on 9 February, 1997, for payment with surcharge under 37 C.F.R. §1.20(h);
- the third opened on 10 February, 1997, and closed at midnight on 9 February, 1999, for payment as unintentionally delayed under 37 C.F.R. §1.20(i)(2); and
- the fourth also opened on 10 February, 1997, for payment as unavoidably delayed under 37 C.F.R. §1.20(i)(1).

As noted above, payment of the first maintenance fee was not tendered until the filing of the original petition on 29 September, 2000.

Showing

Attached to the renewed petition are a statement<sup>11</sup> and three (3) one- (1-) page documents:

Exhibit "A" purports to be a page from Petitioner's office calendar for Friday, 7 February, 1997, containing four (4) hand-written notations. Three (3) of the items appear to be unrelated and/or indecipherable, and one states:

"Maintenance Fee Pat. No. 5,185,582" (sic);

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<sup>11</sup> The undated statement is as follows:

RENEWAL PETITION UNDER 37 C.F.R. [§] 1.378

I am making this request; since, I believe reasonable care was taken to ensure that the Maintenance Fee would be timely paid.

Attached hereto, (as Exhibits "A" and "B") are (2) two systems which I use to ensure my Maintenance Fees are paid. There is, my diary Sheet for [7 February, 1997,] and my Computer List of Actions to be Taken. In both these cases the system was not followed.

In August of 1994, I relocated my Office from Saddle Brook, New Jersey[,] to Englewood Cliffs, New Jersey. Further I have since had another address change of address (sic) to One Essex Street, Hackensack, New Jersey[,] in June 1997. during that period of time, when the office relocated my file was misplaced and my secretary, who had been entrusted with the follow-up of this matter, suddenly left in 1996.

I have spent the last several months trying to locate my file which was buried in an old warehouse in a closed file section.

When I received your notice I searched my diary and computer and finally located the attached, Exhibits "A" and "B."

As I further told you I have been seriously ill during the past several years so even the action to cure the late Maintenance Fee which would have been available fell by the wayside (see Exhibit "C.")

I strongly feel that the foregoing explanation satisfies the threshold requirement for Unavoidable Delay.

If the Office of Petitions have request for any other documentation, I will gladly supply what I have in my File.

I respectfully request that my Petition be Granted.

Respectfully submitted,

/s/ Anthony D. Cipollone

(Emphasis, the original.)

Exhibit "B" purports to be a computer printout listing four (4) items stretching across a time span commencing on 7 February, 1997, and continuing through an unspecified date in the year 2010: three (3) of the items appear to be unrelated, and the fourth states:

"[07/02/1997] PAT # 5,185,582 (sic) EDWARD LAZORCHAK  
MAINTENANCE FEE DUE"

EXHIBIT "C" purports to be a billing to Petitioner/Counsel from a physician with reference to billing for professional services commencing with a consultation on 18 November, 1998, and reflecting a "CORONARY ARTERIAL GFT" on 24 November, 1998.

For completeness of the record, the reasons for unavoidable delay in payment of fee as specified by Petitioner in the original petition are set forth in footnote below.<sup>12</sup> (No documents were supplied in support of the original petition.)

#### IV. ANALYSIS

##### Factual Analysis

Because the Office is under no duty to provide Notice, it is of no moment that Petitioner did not receive from the Office a Notice regarding the Maintenance Fee Due and/or Notice of Expiration. However, while Petitioner states that:

at least one Office mailing regarding the instant matter was directed to Petitioner's old Saddle Brook address, and

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<sup>12</sup> Petitioner's statement in support of his original petition, filed 29 September, 2000, is as follows:

##### REASONS FOR THE UNAVOIDABLE DELAY IN PAYMENT OF FEE

On [18 August, 2000, I wrote a letter to the Patent Office requesting information on [Patent No. 5,185,542] regarding the Maintenance Fee.

I was informed on [24 August, 2000,] that the Patent had expired [9 February, 1997,] and that the Maintenance Fee Notice had been sent to 299 Market Street Saddle Brook, New Jersey 07662.

I have not been at the Saddle Brook office since 1994.

Further, I have had two address changes which have been forwarded to the Patent Office since 1994, one at 333 Sylvan Avenue, P.O. Box 13031, Englewood Cliffs, New Jersey 07633, and one at One Essex Street, Hackensack New Jersey 07601.

During 1998, I was seriously ill and had several medical heart procedures due to congestive heart failure and a coronary bypass in November 1998.

During that period of time I was seriously delinquent in following upon my schedule. The Maintenance Fee due fell by the way side.

As soon as I was able, and when I realized that I may have missed a payment, I contacted the Patent Office with the results as aforesaid.

The foregoing is an extraordinary situation which would require a waiver sua sponte by the Commissioner in the interests of justice.

Respectfully submitted,

/s/Anthony D. Cipollone.

- not only has Petitioner moved twice since having that Saddle Brook address, but also Petitioner has notified the Office of his changes of address,<sup>13</sup>

an examination of Office record in this matter indicates that Petitioner's address remains the Saddlebrook, New Jersey, address.<sup>14</sup>

Further examination of the record demonstrates that:

Petitioner placed his file for the instant patent in storage at some undetermined time after issue in 1993; thereafter the file was misplaced or otherwise "buried in an old warehouse."

The record is absolutely silent as to any evidence addressing Petitioner's attempt to maintain the instant patent in the time period during which the first window opened on 9 February, 1996, and closed at midnight on 9 August, 1996, for payment without surcharge.

Therefore, as to an inquiry of whether Petitioner had in place a method to ensure timely payment of the maintenance fees for this patent in the period from 9 February through 9 August, 1996--the period within which the first payment window opened, the fee became due, and the first window closed--the answer is: No.

while Petitioner appears to have calendared (in a paper diary and in a computer docket) for attention a patent numbered 5,185,582, there is no showing whatsoever that Petitioner:

--ever calendared the correct number of the patent (5,185,542) or its original application number, or

--ever attempted to act on the incorrectly numbered item listed in his paper Diary and his computer database.

In other words, having calendared the wrong patent, Petitioner took no action even as to that.

In addition, Petitioner states that his secretary, "who had been entrusted with the follow-up of this matter, suddenly left in 1996."

It is, however, Petitioner--not the unidentified secretary--who is registered before the Office and undertook representation of the inventor. While Petitioner may have entrusted the secretary with follow-up in this matter during the pendency of her employment:

--by Petitioner's own description of events the unidentified

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<sup>13</sup> See Fn. 11

<sup>14</sup> The Office has available for use by practitioners and *pro se* applicants a customer-number system--which allows one to update address and other contact information in all of a customer's files simultaneously. However, the Office is not free to initiate a customer number if one is not requested. As a result, Petitioner was responsible for updating that information on an item-by-item basis. Unfortunately, Petitioner has made no showing that--in the instant matter--he provided to the Office a Notice of either address change during the six- (6-) year interval by submitting a copy of: (a) the Notice(s), and (b) the post card stamped by the Office acknowledging receipt of the Notice(s). In any case, such a showing in and of itself would not satisfy Petitioner's burden of proof herein.

secretary ended her employment with Petitioner well before the patent expired, and

--it is Petitioner who had oversight of the secretary and responsibility for the maintenance fee in this matter.<sup>15</sup>

Clearly, then, while Petitioner calendared something for action two (2) days before the expiration of the instant patent, Petitioner has failed to evidence that:

--it was the instant patent that Petitioner calendared for action, or

--he in fact acted on the erroneous calendar listing, or

--he diligently oversaw the efforts of another with regard to acting to pay the maintenance fee for the patent; or

--he diligently reviewed events and/or their anniversaries after his unidentified employee left his employ.

Therefore, as to an inquiry of whether Petitioner had in place a method for seeing that the fees for this patent were timely paid from 10 August, 1996, through 9 February, 1997, the period within which the second payment window opened, the fees and surcharge became due, and the second window closed, the answer is: No.

Petitioner's documentation supports his statement that he underwent heart surgery in late November of 1998.

However, that event accounts for only a relatively brief part of the twenty-four months following expiration of the patent: Petitioner fails to address either the interval from 10 February, 1997, until his diagnosis on or about 18 November, 1998, or the two- (2-) plus month interval following surgery through 9 February, 1999. Notwithstanding Petitioner's illness, his professional responsibilities require that some provision be made to attend to client matters.

Therefore, as to an inquiry of whether or not Petitioner had in place a method for seeing that the fees for this patent were paid between 10 February, 1997, and midnight 9 February, 1999, the answer is: No.

Similarly, as to an inquiry of whether or not Petitioner had in place a method for seeing that the fees for this patent were timely paid between payment of the maintenance-fee-as-unavoidably-delayed before or after 9 February, 1999, the answer is: No.

In fact, the fourth window never could have opened for Petitioner because the record is void of any documentary evidence that the Petitioner had in

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<sup>15</sup> It is logical that Petitioner either replaced the secretary who left his employ in 1996 and/or undertook himself the duties the departed secretary previously provided. In any case, with the replacement secretary or alone Petitioner--if a prudent individual operating in the fashion foreseen in Pratt--would have reviewed for handling and handled items arising after the departure of the earlier secretary. However, Petitioner has made no such showing of such prudent action herein.

place any method for seeing that the fees for the instant patent were paid timely.

### Legal Analysis

Generally, a late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.<sup>16</sup> Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>17</sup> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>18</sup>

And a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>19</sup>

The regulations at 37 C.F.R. §1.378(b)(3) require a showing that "the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely." Moreover, the showing must:<sup>20</sup>

- enumerate the steps taken to ensure timely payment of the maintenance fee as well as the reasons why payment was not timely made;
- present, with appropriate evidence, all the causes that contributed to the failure to timely pay the maintenance fee; and
- specify the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Even if a breach of duty by Petitioner as Counsel is the cause of the failure to maintain the patent and/or demonstrate unavoidable delay, those actions or inactions are imputed to the patent owner, who selected his counsel.<sup>21</sup>

Rather, in the absence of a showing that the attorney/agent has acted to deceive the

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<sup>16</sup> Ray v. Lehman, 55 F3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>17</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Hendrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>18</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>19</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>20</sup> This showing may include, but is not limited to, docket records, tickler reports, and file jacket entries for this application.

<sup>21</sup> Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962).

client,<sup>22</sup> the neglect of a party's attorney is imputed to and binds the party by the consequences.<sup>23</sup>

At bottom, the question is one of diligence.<sup>24</sup> And the record does not demonstrate Petitioner's diligence as to the patent's maintenance.

#### Direct Evidence

Perhaps as stark as the absence of diligence or attention to the process of maintenance in this matter is the absence of documentation provided by Petitioner in support of--or claimed to be available for--the petition in this record. The expiration/abandonment of this patent took place by operation of law, *inter alia*, for failure to pay timely the maintenance fee. Petitioner, for whatever reasons, has "failed to provide any *direct evidence* proving exactly"<sup>25</sup> a factual basis supporting the showing of unavoidable delay required for relief to be granted. Petitioner was made aware of this requirement. (The March 2000 Dismissal, p. 3.)

Absent such direct evidence, the petition cannot be granted.

#### IV. CONCLUSION


Therefore, the petition for reconsideration is granted to the extent that this review has been made and rendered.

In all further respects, the petition must be and hereby is **DENIED**.

This decision may be viewed as final agency action. See M.P.E.P. 1002.02(b). The provisions of 37 C.F.R. §1.137(d) do not apply to this decision.

The application file is being forwarded to Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Attorney John J. Gillon, Jr. at (703) 305-9199.



Manuel A. Antonakas  
Director  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>22</sup> When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

<sup>23</sup> See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

<sup>24</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997). See also: Ray v. Lehman, *supra*.

See also: Krahn v. Commissioner, 15 USPQ2d 1823 (E.D. Va. 1990) (Emphasis supplied).



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*1990 Commr. Pat. LEXIS 18, \*; 17 U.S.P.Q.2D (BNA) 1455*

In re Application of Robert Lonardo

Serial No. 399,365

Filed: September 21, 1973

For: THERAPEUTIC LEG AND FOOT DEVICE

Commissioner of Patents and Trademarks

*1990 Commr. Pat. LEXIS 18; 17 U.S.P.Q.2D (BNA) 1455*

August 6, 1990, Decided

**CORE TERMS:** abandoned, patent, revive, abandonment, diligent, diligence, neglect, drawings, unavoidable delay, state of health, consolidated, invention, issuance, revived, precarious, telephone conversation, pretrial conference, medical attention, follow-up, two-month, illness, gross-negligence, application process, heart problem, filing date, declaration, chargeable, purported, renewed, excused

**COUNSEL: [\*1]**

Zarley, McKee, Thomte, Voorhees & Sease  
2400 Ruan Center  
Des Moines, Iowa 50309

**OPINIONBY: DENNY**

**OPINION:**  
ON PETITION

The above-identified application ('365 application), naming Robert Lonardo as inventor, became abandoned on March 8, 1974, for failure to file formal drawings within a two-month period specified in an office communication dated January 7, 1974. On November 21, 1988, Lonardo filed a petition to revive the '365 application under 37 CFR § 1.137(a), which was denied on April 18, 1989. On May 4, 1989, Lonardo filed a further petition to revive the '365 application and a petition under 37 CFR § 1.183 to waive applicable rules, both of which were denied on August 4, 1989.

Lonardo then filed suit against the Commissioner in the United States District Court, Middle District of Florida (Civil Action No. 89-1329-CIV-T-13C), seeking a court order directing the Commissioner to revive the abandoned '365 application. On May 4, 1990, the district court granted the Commissioner's unopposed motion for stay and remand, and permitted the Patent and Trademark Office (PTO) three months to consider recently discovered additional evidence which might lead to granting of relief by the Commissioner. On **[\*2]** June 1, 1990, Lonardo filed a renewed petition to revive the abandoned '365 application.

Lonardo's renewed petition to revive is GRANTED.

To revive an abandoned patent application under 37 CFR § 1.137(a), the petitioner must establish that his application became abandoned due to "unavoidable delay." Proper considerations include the extent of diligence exhibited by the petitioner himself and by his attorney, in connection with the

delay for which the application became abandoned and also with their respective efforts to revive the abandoned application. The diligence of the attorney is relevant because one is ordinarily bound by the acts of his attorney. See Link v. Wabash R.R., 370 U.S. 626, 633-34, reh'g denied, 371 U.S. 873 (1962); Smith v. Mossinghoff, 671 F.2d 533, 5 USPQ2d 1130 (D.C. Cir. 1982); Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Ex parte Stuckgold, 1903 Dec. Comm'r Pat. 307, 308 (Comm'r Pat. 1903).

In this decision, the diligence of Lonardo is first considered, followed by that of his attorney, Max Schwartz ("Schwartz"). If Schwartz had not been diligent, whether his lack of diligence is excused by sickness or incapacity, [\*3] or otherwise not chargeable to Lonardo, is then considered.

Lonardo was diligent

Mrs. Lonardo persistently acted as Lonardo's agent for communicating with Schwartz, in connection with Lonardo's invention. Accordingly, Mrs. Lonardo's acts on behalf of Lonardo, and her knowledge of information obtained from Max Schwartz, are imputed to Lonardo.

Nothing in the record indicates that Lonardo was aware of the Examiner's communication dated January 7, 1974, which set a two-month period for submission of formal drawings. Though Schwartz received the office communication, he did not notify Lonardo of the outstanding requirement, nor did he submit formal drawings within the stated two-month period. Unless Lonardo should have known that Schwartz could not be trusted with prosecution of the '365 application, Lonardo could not be reasonably expected to take actions which would have avoided the abandonment which occurred. The facts do not show that Lonardo should have known that Schwartz was professionally incompetent or otherwise unreliable. Consequently, it cannot be reasonably said that Lonardo contributed to the abandonment of the '365 application through his own lack of diligence. [\*4]

The record also indicates that Lonardo was not less than diligent from the time of abandonment of the '365 application on March 8, 1974, to the time of filing of the substitute application on June 6, 1975, in not knowing that the '365 application had become abandoned. Lonardo suffered a heart attack in April of 1974, for which he needed the remainder of that year to recuperate. Through his wife, Lonardo attempted to contact Schwartz on numerous occasions in early 1975. Though Mrs. Lonardo had difficulty contacting Schwartz, she did manage to reach him by telephone on at least two occasions, once on March 24, 1975, and another time on April 1, 1975.

In the telephone conversation of March 24, 1975, Schwartz said he had been ill, apologized for neglecting his work, and stated that he would send a letter to Washington (presumably the PTO) to explain that he had been ill. In a note of even date with that telephone conversation, Mrs. Lonardo sent Schwartz a request for a copy of the letter Schwartz intended to send to Washington. In the telephone conversation of April 1, 1975, Schwartz assured Mrs. Lonardo that everything was fine and a patent would be issued momentarily. The second [\*5] conversation was followed by another note from Mrs. Lonardo to Schwartz which urged Schwartz to call as soon as he had news about the patent to be issued. Those facts indicate that Lonardo was concerned about progress of the '365 application, made multiple inquiries to Schwartz, and was assured by Schwartz that all was well and there was no need to worry. Lonardo was not less than diligent.

Lonardo never followed up on his request of March 24, 1975, asking Schwartz to send a copy of the letter to Washington. That inaction may appear to reflect lack of diligence. However, an unfulfilled request for the copy reflects more, not less, diligence than not having made the request at all. Also, Schwartz's further assurance of April 1, 1975, obviated any pressing need for the copy. Lonardo already knew the intended content of the letter, i.e., that Schwartz would explain that he had been ill; Lonardo's main concern was whether the application would progress toward issuance. Schwartz's representations to Mrs. Lonardo on April 1, 1975, that all was well and the patent would issue momentarily gave Lonardo the assurance he needed. In that circumstance, a physical copy of the letter [\*6] no longer has meaningful significance. Accordingly, Lonardo cannot be faulted for not further pursuing a copy of the letter Schwartz purported to be sending to Washington.

In May 1975, instead of receiving a copy of Schwartz's alleged letter to Washington, Lonardo received from Schwartz a substitute application. Lonardo considered the various applications,

whether a continuation-in-part (the '365 application was itself a continuation-in-part application of an earlier application) or a substitute, to be one single application process for obtaining a patent on his invention. To Lonardo, the substitute application was simply one other submission which was necessary to secure the issuance of a patent for his invention. From that perspective, the substitute application does not give notice to Lonardo that something had gone wrong in the application process.

Lonardo's not confronting Schwartz on why Schwartz sent a substitute application to be executed rather than a copy of the purported letter to Washington should not work toward Lonardo's detriment. The substitute application reflects further efforts expended by Schwartz to secure a patent for Lonardo's invention; Lonardo had insufficient [\*7] basis to doubt its propriety. It cannot be reasonably said that Lonardo should have preferred to receive a copy of the purported letter to Washington, rather than the substitute application; while the former is intended as an explanation of Schwartz's illness, the latter represents a work product which brought Lonardo closer toward obtaining a patent. From Lonardo's perspective, the '365 application was being taken care of and was advancing toward issuance; whether he received a copy of Schwartz's letter to Washington, and even whether Schwartz had sent such a letter, are relatively inconsequential in that circumstance. Thus, Lonardo exhibited ample diligence toward securing issuance of a patent for his invention by promptly executing the substitute application on May 16, 1975.

Lonardo first learned of the abandoned status of the '365 application on September 20, 1988, from opposing counsel in a patent infringement action involving the patent which issued from the substitute application. For the period from the execution of the substitute application on May 16, 1975, to September 20, 1988, the record shows no reason for Lonardo to question the status of the '365 application. [\*8] From Lonardo's perspective, there was a single patent application process which resulted in the issuance of the patent; whatever applications were involved in that process have merged into the resulting patent. It cannot be said that Lonardo was not diligent in the period from May 16, 1975, to September 20, 1988, in connection with not knowing that the '365 application had been abandoned.

Lonardo filed the first petition to revive the '365 application on November 21, 1988. Though two months have passed from the time when he first learned that the '365 application had gone abandoned, that does not constitute excessive delay in light of the need to gather facts relating to events of more than 14 years ago. Lonardo was not less than diligent in seeking to revive the '365 application, once the abandoned status of the application was made known to him on September 20, 1988.

Also, based on this record, Lonardo had no reason not to retain Schwartz as his attorney or to rely on Schwartz throughout the prosecution of the '365 application. Though we find Schwartz to be unable to perform his responsibilities after April 1973, as discussed below, Lonardo did not know that and we cannot [\*9] say that Lonardo should have known.

For the foregoing reasons, Lonardo's own conduct cannot be regarded as less than diligent and thus precluding him from establishing unavoidable delay under 37 CFR § 1.137(a).

Schwartz was not diligent

Schwartz received the office communication dated January 7, 1974, which set a two-month period for submission of formal drawings. Though Schwartz's status letter of April 15, 1974, referred to a prior request from Schwartz for the Examiner to order the transfer of formal drawings from an abandoned parent application, it did not indicate when the request was made nor whether the Examiner had agreed to take such action. Indeed, the last paragraph of the letter suggested that no agreement had been reached with the Examiner, in stating: "please advise whether an action will be forthcoming in accordance with the above [pending request for the Examiner to order the transfer of formal drawings from the parent application]." Because formal drawings were not filed by March 7, 1974, the '365 application became abandoned. On this record, Schwartz had not been diligent, and his lack of diligence caused the abandonment of the '365 application.

Though [\*10] a patent office communication dated May 2, 1984, was sent to Schwartz, which

noted that the '365 application had become abandoned, Schwartz's file for the '365 application does not contain that official communication. Nevertheless, sometime between April 15, 1974, and May 1975, Schwartz became aware of the abandoned status of the '365 application; that fact is inferred from his preparing a "substitute application" for Lonardo's execution in May 1975. Upon learning that the '365 application had become abandoned, Schwartz should have taken steps to revive the application; he should have known that the substitute application would not be entitled to the benefit of the '365 application's filing date. For the entire period from when he first learned of the abandoned status of the '365 application to his death in December 31, 1980, Schwartz made no attempt to revive the '365 application; he was less than diligent in that regard.

Not charging Schwartz's failure to revive the application to Lonardo

It is an established principle that the neglect or exercise of judgment of an attorney is chargeable to his client, and thus the client would have to suffer the consequences of his attorney's [\*11] conduct. The rationale, as articulated in Link v. Wabash R.R., 370 U.S. 626, 633-34 (1962), is that because the client voluntarily chose his own representative, he cannot seek to avoid the consequences or acts of this freely selected agent. The Court stated, id. at 634 n.10, that if the attorney's conduct falls substantially below what is reasonable under the circumstances, the client's remedy is a malpractice suit against the attorney.

In Link, the district court notified counsel for each side of the scheduling of a pretrial conference on October 12, 1960, at 1 p.m. On the morning of the scheduled date, plaintiff's counsel telephoned the courthouse for the judge, and was informed that the judge was on the bench. Plaintiff's counsel then left this message for the judge:

"that he [counsel] was busy preparing papers to file with the [Indiana] Supreme Court," that "he wasn't actually engaged in argument and that he couldn't be here by 1:00 o'clock, but he would be here either Thursday afternoon [October 13] or any time Friday [October 14] if it [the pretrial conference] could be reset."

Id. at 628. After plaintiff's counsel failed to attend the pretrial conference, [\*12] the district court, upon review of the history of the case, dismissed the action for counsel's failure to appear for pretrial conference and for failure to prosecute. The Court of Appeals affirmed the district court. The Supreme Court in Link recognized that the review in that case involved the propriety of the district court's dismissal of the action under Federal Rules of Civil Procedure 41(b), 370 U.S. at 630, and not any refusal by the district court to grant plaintiff's request for relief from judgment under Rule 60(b). In particular, the Court stated: "petitioner never sought to avail himself of the escape hatch provided by Rule 60(b)," id. at 632, and expressly left open the question whether the district court would have abused its discretion had it rejected a motion under Rule 60(b). Id. at 635.

In the context of relief from judgment under Rule 60(b), some courts have not broadly applied Link's rule that an attorney's conduct is chargeable to his client, when the conduct is deemed to involve gross-negligence rather than ordinary neglect, e.g., Boughner v. Secretary of Health, Education and Welfare, 572 F.2d 976, 978 (3rd Cir. 1978); L.P. Steuart, [\*13] Inc., v. Matthews, 329 F.2d 234, 235 (D.C. Cir. 1964), cert. denied, 379 U.S. 824 (1964), or simply when a default judgment is due to counsel's neglect. Jackson v. Beech, 636 F.2d 831, 837 (D.C. Cir. 1980); see also Carter v. Albert Einstein Medical Center, 804 F.2d 805 (3rd Cir. 1986) (vacating default judgment upon review of denial of relief under Rule 60(b), without classifying counsel's negligence as either ordinary or gross). Lonardo has not identified any decision of the Commissioner which distinguished gross-negligence from ordinary neglect when deciding whether to charge the conduct of an applicant's attorney to the applicant. But whether such a distinction is proper need not be decided here, because we cannot charge Schwartz's conduct to Lonardo for a different reason, i.e., attorney's intentional deception of his client.

When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. See Jackson v. Washington Monthly Co., 569 [\*14] F.2d 119, 122 n.18 (D.C. Cir. 1977):

The gross-neglect rule of L.P. Steuart has been criticized as discordant with Link. 7 J. Moore, Federal Practice P60.27[2], at 369-370 n.47 (2d ed. 1975); see United States v. Ciriaco, 535 F.2d 736, 740-741 (2d Cir. 1976). But even if that were so, an attorney's deception of a blameless client would survive as a basis for relief under Rule 60(b)(6). See 7 J. Moore, supra, P60.-27[2], at 368 n.44. When a client does not knowingly and freely acquiesce in his attorney's neglectful conduct, but instead is misled into believing that the attorney is industrious, dismissal is not only a harsh step but one for which the circumstances provide little support for an agency theory as a rationale. Cf. Thane Lumber Co. v. J. L. Metz Furniture Co., 12 F.2d 701, 703 (8th Cir. 1926); Chamberlain v. Amalgamated Sugar Co., 42 Idaho 604, 247 P. 12, 14 (1926).

United States v. Ciriaco, 563 F.2d 26 (2d Cir. 1977), involved a situation in which the district court's denial of relief under Rule 60(b)(6) was reversed on the basis that the attorney's failure leading to dismissal of the action was demonstrated to be due to mental illness. [\*15] That decision has been broadly interpreted by at least one district court as representing the view that any counsel's conduct of more than ordinary neglect or gross-negligence should not be charged to his client in the context of a request for relief under Federal Rules of Civil Procedure Rule 60(b)(6). As stated in DeBonavena v. Conforte, 88 F.R.D. 710, 712-13 (D. Nev. 1981):

This Court views the legal propositions set forth in the Ciriaco cases as not necessarily limiting relief to those cases where there is mental illness. It seems that the philosophical basis of Ciriaco is somewhat broader. The essential question in the view of this Court is whether counsel's inaction was due to something more than negligence or neglect.

Sometime between April 15, 1974 and May of 1975, Schwartz must have learned that the '365 application had gone abandoned, because he prepared an identical substitute application and sent it to Lonardo in May 1975, to be executed, and filed the substitute application on June 6, 1975. The only reasonable inference which can be drawn from that circumstance is that Schwartz was aware the '365 application had become abandoned. Furthermore, at no time [\*16] did he inform Lonardo of the abandoned status of the '365 application, despite Mrs. Lonardo's inquiries about the status of the application. On this record, it is reasonable to conclude that Schwartz knowingly concealed the abandonment of the '365 application from Lonardo, and covered up the abandonment by filing and prosecuting the substitute application as though it were the '365 application. His efforts in concealment were so successful that no one discovered the abandonment of the '365 application until more than fourteen years later in an infringement suit involving the patent which issued from the substitute application.

For the foregoing reasons, Schwartz's non-diligence in failing to have the abandoned application revived cannot be charged to revived cannot be charged to Lonardo.

Initial abandonment was due to Schwartz's illness

This case involves factual circumstance which existed in early 1974, in the two months immediately preceding March 8, 1974, in which Schwartz should have filed a response in the '365 application. Sixteen years have passed since 1974, and much evidence which could have been available at that time are not available today. Nevertheless, the [\*17] record can support a finding that Schwartz's ability to perform his responsibilities as a patent attorney was impaired during the period in question. Though the record might also support a contrary finding, that contrary finding is less plausible. Rather, Schwartz's health was so precarious after April 1973 that his failure to file a response in the '365 application between January 7, 1974, and March 7, 1974, was due at least in part to illness. Consequently, his lack of diligence in failing to respond to the office action is excused within the meaning of unavoidable delay under 35 U.S.C. § 133.

In 1973, Dr. Ezra Sharp had been Schwartz's treating physician for many years. According to Dr. Sharp's testimony, Schwartz considered himself well-versed in medicine, and rarely sought professional medical advice because he often made his own diagnosis and treated himself. Dr. Sharp testified that when Schwartz had his first heart problem, Schwartz even refused to go to the hospital and had to be treated at home as a result of which Dr. Sharp was deprived of opportunities to administer follow-up treatment.

Based on Dr. Sharp's testimony, we find that Schwartz was not an ordinary person [\*18] insofar as the need to obtain professional medical assistance is concerned. For instance, he apparently was not likely to accept medical assistance until he had exhausted all means he thought were appropriate to treat himself. Consequently, whenever Schwartz would seek professional assistance, he was likely to have needed that professional medical attention at a much earlier time. Similarly, since he was not treated or seen by a physician, he might well have been seriously ill and needed to be hospitalized. Schwartz's regard (or lack thereof) for professional medical care was not ordinary.

Dr. Sharp testified that he saw Schwartz as a patient on April 9, 1973, at which time an EKG revealed evidence of a Myocardial Infarct which had resulted from a heart problem from 20 years ago. Thus, we know that Schwartz's heart condition had a tendency to grow progressively worse. Also, Schwartz's state of health in April 1973 must have been extremely bad, because if not, he was unlikely to have sought professional medical attention. More importantly, because April 1973 was the last time Dr. Sharp saw Schwartz, Schwartz did not receive any professional follow-up treatment from Dr. Sharp; [\*19] and there is no evidence of record that Schwartz received professional follow-up medical attention from any other physician. Presumably, after April 1973 and until his death in 1980, Schwartz was acting as his own doctor, attempting cures by whatever means he considered appropriate. Based in part on the following six factors, Schwartz's state of health from April 1973 to when he died in 1980 at approximately 81 years of age was extremely precarious:

- (1) Schwartz's serious health condition in April 1973;
- (2) Schwartz's heart problem which worsened over time;
- (3) Lack of professional follow-up treatment after Dr. Sharp last saw Schwartz in April 1973;
- (4) Schwartz' general reluctance to seek professional medical attention;
- (5) Schwartz's tendency to make his own diagnosis and to treat himself;
- (6) Schwartz's advanced age.

In addition, Schwartz's precarious state of health undermined his abilities to fulfill responsibilities as a patent attorney. Other evidence directed to Schwartz's state of health of record before the PTO is not to the contrary. Schwartz himself told Mrs. Lonardo in the March 24, 1974, telephone conversation that he had been ill and he had neglect his work. [\*20] Mrs. Lonardo heard in 1974 from another attorney in Rhode Island, Elliot Salter, that Schwartz had been ill "for sometime." Leonard Michaelson, also an attorney in Rhode Island, testified that Schwartz had had a heart attack ten years or so before his death.

Based on the findings above, one would anticipate that if Schwartz continued his patent practice following April 1973, he would begin to fail in his professional duties, and that such failures will become more numerous as time went on. Indeed, the facts discussed below are in accordance with that anticipation. In particular, with regard to nine filed applications including the '365 application, Schwartz failed in his responsibilities once in 1974, once in 1976, once in 1977, once in 1978, thrice in 1979, and twice in 1980.

The prosecution history of seven other applications prosecuted by Schwartz from the period of June 1976 to December 1980, are relevant. Those applications, in chronological order of the filing date, are:

Serial No.	Filing Date	Patent No.
1. * * * *	* * * *	(not issued)
2. 696,486	06/15/76	4,378,948
3. 852,082	11/16/77	4,356,793
4. * * * *	* * * *	(not issued)
5. D-949,812	10/10/78	D.269,300
6. D-949,813	10/10/78	D.268,619

[\*21]

Each of the above-identified seven applications became abandoned sometime during prosecution as a result of Schwartz's failure either to respond at all or to respond timely to an office action. Applications 1 and 4 above are not specifically identified because they have not issued as United States patents and thus have confidential status under 35 U.S.C. § 122. Schwartz refiled applications 3, 5, and 6 in December 1980, even though there were intervening sales in at least application 3.

Application 1 became abandoned because Schwartz did not respond to an office action dated October 21, 1977, for which a response was due on December 21, 1977. Application 2 became abandoned because Schwartz did not respond to an office action dated September 22, 1976, for which a response was due on December 22, 1976. Application 3 became abandoned because Schwartz did not respond to an office action dated September 26, 1978, for which a response was due on December 26, 1978. Application 4 became abandoned because Schwartz did not respond to an office action dated March 27, 1980, for which a response was due on June 27, 1980. Application 5 became abandoned because Schwartz did not respond to [\*22] an office action dated July 25, 1979, for which a response was due on August 25, 1979. Application 6 became abandoned because Schwartz did not respond to an office action dated June 4, 1979, for which a response was due on July 5, 1979. Application 7 became abandoned because Schwartz filed a response on January 28, 1980, to an office action dated October 25, 1979, for which a response was due on January 25, 1980.

An eighth application prosecuted by Schwartz, serial number 912,385, filed on June 5, 1978, also became abandoned as a result of Schwartz's failing to respond to an office action dated October 25, 1978, for which a response was due on January 25, 1979. Schwartz succeeded in reviving the abandoned application under Rule 137 on the basis of a mistake in docketing the office action for response; his petition to revive the application was granted on November 28, 1979. That application is now issued as United States Patent No. 4,211,190.

After Schwartz's death, petitions were filed in each of the above-listed seven applications to have them revived. The respective petitions were followed by a consolidated petition for revival of all seven applications. In all applications [\*23] except for applications 2 and 5, the initial petitions had already been denied when the consolidated petition was filed. Subsequent to the filing of the consolidated petition in each application, the petitions were granted and each application was revived. In each decision granting respective petitions, the PTO attributed Schwartz's failure to respond timely to his "inability to perform his responsibilities."

The seven applications were revived mainly on the basis of the consolidated petition, which included (1) a declaration of Dr. Ezra A. Sharp; and (2) a declaration of Herbert Barlow, a patent attorney who took over several of Schwartz's on-going patent matters after Schwartz's death. Incidentally, it is noted that the consolidated petition misstated the filing date of application 1 as January 21, 1978, of application 2 as December 22, 1976, and of application 7 as January 25, 1980.

In addition to Dr. Sharp's testimony already discussed above, Dr. Sharp stated:

In recent years I have had no doctor-patient relationship with Max Schwartz that would enable me to provide a professional opinion as to his mental deterioration in recent years. However, his senility would not be [\*24] inconsistent with my prior observations of him during those occasions when I was called upon to treat his heart problems.

Mr. Barlow stated that his law firm assumed the prosecution of a number of patent applications which were formerly handled by Schwartz. His testimony recounted three instances in which Schwartz had not filed completed United States patent applications which should have been filed, and nine instances in which Schwartz caused erroneously instructed foreign associates to drop the prosecution of corresponding foreign applications. Mr. Barlow stated that the foreign applications were filed "in the fall and early spring of 1978-79." He also stated that one of the three unfilled

United States patent applications included a signed declaration dated September of 1979; no dates for the other two unfilled United States applications were noted.

As evidenced above, Schwartz's course of professional failures subsequent to April 1973 was progressively worse. The failures began in early 1974 and became more frequent in the following years. Because Schwartz's state of health became precarious as early as April 1973, there is no reason to isolate the year 1974 and treat it differently [**\*25**] from the later years. Accordingly, the initial abandonment of the '365 application was due at least in part to Schwartz's illness and thus excused within the meaning of unavoidable delay under 35 U.S.C. § 133. See e.g. *In re Mattullath*, 1912 Dec. Comm'r Pat. 490, 493 (App. D.C. 1912); *Ex parte Sellers*, 1905 Dec. Comm'r Pat. 336 (Comm'r Pat. 1905); *McDuffee v. Hestonville*, 181 F. 503, 510-11 (E.D. Pa. 1910).

#### Conclusion

For the foregoing reasons and on this rather unusual set of facts, Lonardo has demonstrated unavoidable delay within the meaning of 35 U.S.C. § 133, and the renewed petition under 37 CFR § 1.137(a) to revive the '365 application from abandonment is granted.

James E. Denny  
Deputy Assistant Commissioner for Patents

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**Contacts:**

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**RE U.21-CIP:**

If no filing date, then cannot go abandoned.

Therefore, only can complete the application.

1. Could challenge the finding of incomplete application, such as by contesting the need for drawings, or only claiming an invention for which a drawing is not needed (based on originally filed specification).

2. Or could supply drawings and accept a later filing date.

3. Could file de novo. This would mean dealing with own publications and patents as prior art.

If #2, need to determine whether can claim priority to application(s) being revived.

Petition could be via 1.181. Due to 1.181(f), would file Terminal Disclaimer (waiving (f)).

Petition could be via 1.183, but when waive the rule the PTO may compel other things, like filing a TD.

BEFORE THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENTS AND TRADEMARK OFFICE

HARRY I. MOATZ,	)	
	)	
Director, Office of	)	
Enrollment and Discipline,	)	
	)	
v.	)	Proceeding No. D02-14
	)	
GEORGE A. BODE,	)	
	)	
Respondent.	)	
_____	)	

FINAL DECISION UNDER 37 C.F.R. § 10.156

The Hon. Susan Biro (“ALJ”) issued an Initial Decision (“ID”) finding that Respondent backdated three certificates of mailing; failed to communicate with clients, resulting in eight patent and trademark applications going abandoned; and failed to respond to Requirements for Information (RFIs) issued by the Office of Enrollment and Discipline (OED). Specifically, the ID found that by backdating certificates of mailing Respondent violated the following rules: USPTO Disciplinary Rule (“Rule”) 10.23(b), by engaging in conduct involving misrepresentation; Rule 10.23(b)(6), by engaging in conduct that adversely reflects upon his fitness to practice; and Rule 10.23(c)(9), by knowingly misusing certificates of mailing. The ID found that through various failings involving his representation of several clients, Respondent violated the following rules: Rule 10.23(c)(8), by failing to inform clients of correspondence; Rule 10.77(c), by neglecting legal matters entrusted to him; and Rule 10.84(a)(2), by failing to carry out contracts for employment. Finally, the ID found that by failing to respond to RFIs, Respondent violated the following rules: Rule 10.23(b)(5), by engaging in conduct prejudicial to the administration of justice, Rule 10.23(b)(6), by engaging in conduct

adversely affecting his fitness to practice, and Rule 10.23(c)(16), by willfully refusing to reveal or report knowledge or evidence to OED. The ID recommended that Respondent be suspended from practice before the United States Patent and Trademark Office (“USPTO”) for seven years, with the final four years of the suspension to be stayed.

Respondent appealed the ID’s findings. The OED Director responded to the appeal and cross-appealed, arguing that Respondent’s conduct required his exclusion from practice before the USPTO. Respondent failed to respond to the OED Director’s cross appeal.

For the reasons discussed herein, all findings set forth in the ID are adopted, as is the recommended penalty.

#### Direct Appeal

Respondent’s appeal contains three substantive paragraphs. The first objects to the ID’s findings of facts and conclusions of law because “the [ALJ] ignored the testimony of the Respondent and the obvious contradictory and biased testimony of the witnesses against Respondent.” The second paragraph objects to the recommended sanction on precisely the same grounds. The third paragraph asserts the ALJ unfairly favored the Government and ignored the bias of its witnesses because the ALJ “ignored the testimony that the Director has long been investigating and harassing the Respondent and seeking to impair the Respondent’s ability to practice before the Office.”

The hearing in this matter elicited conflicting testimony concerning a number of facts material to the resolution of the charges against Respondent. The well-reasoned ID resolved these conflicts through explicit analysis of various indicia of reliability, including the demeanor of testifying witnesses. In many instances, the ALJ found

Respondent's testimony less credible than that of the witnesses against him. The ALJ's credibility determinations, based upon first hand observation of the witnesses' demeanor, and supported by careful analysis of the surrounding circumstances, are entitled to deference. Haebe v. Dep't of Justice, 288 F.3d 1288, 1300 (Fed. Cir. 2002); Bradley v. Secretary of Health and Human Svcs., 991 F.2d 1570, 1575 (Fed. Cir. 1993).

Respondent's brief, entirely devoid of any specific allegation of error, provides no basis to question them.

Similarly, Respondent does not refer to specific testimony that would establish that the OED Director's investigation was unduly prolonged or harassing, and no such testimony is apparent in the record. The OED Director, of course, did investigate Respondent, and, as Complainant in this matter, did seek to exclude him from practice before the Office. These facts, however, establish that the OED Director did his job, not that there is any error in the ID.

#### Cross Appeal

The ALJ indicated that if she had been writing on a clean slate she would have been "inclined to find the appropriate sanction in this case to be exclusion." However, after considering two previous Commissioner's Decisions addressing conduct similar to that involved here, the ID recommended a seven-year suspension with the final four years stayed. Specifically, the ID examined In re Klein, 6 USPQ 2d 1547 (1988), in which a practitioner found to have backdated certificates of mailing, neglected client matters, and provided misleading answers to OED RFIs was suspended for seven years, of which five were stayed, and Small v. Wiffenbach, 10 USPQ 2d 1898 (1989), in which a practitioner found to have engaged in similar conduct was suspended for five years.

The OED Director's Cross Appeal does not challenge the ID's conformance of the recommended penalty to those previously imposed by the USPTO in similar cases, but argues that the ID's comparison of the instant facts to those of the previous decisions was flawed. The ID noted that the Small decision had explained imposition of a longer effective suspension than that imposed in Klein because the practitioner in Small had involved his secretary in his backdating of mailing certificates and blamed her for them, had not been candid with the USPTO when asked about the backdating, had neglected entrusted legal matters, and had not shown contrition or remorse. The ID found that the Respondent here had not affirmatively made incorrect statements to OED about the backdating and had not attempted to place blame for it on anyone else. It therefore concluded that Respondent's conduct was not as serious as the conduct in Small, and imposed a shorter initially effective suspension.

The OED Director argues that the ID erred in finding that Respondent's conduct was less serious than that in Small. The OED Director asserts that, even though Respondent did not make false responses to the RFIs, the ID should have weighted his failure to respond more heavily in assessing the penalty. The ID was not unreasonable in treating Respondent's failure to respond to the RFIs as being less serious than making deliberate misstatements to OED.

The OED Director also alleges that Respondent lied to an OED investigator when he told the investigator that he would fax his response the RFIs and then did not do so. The ID actually found that, in a telephone conversation with the investigator, Respondent said that he did not have the response in front of him, but would ask his secretary to forward him a copy, which he would then forward to OED. ID at 19. The ID found that

OED never received the response. It is entirely possible that Respondent told the investigator that he would forward the response when he in fact had no intention of doing so. It is also possible, however, that, at the time he made the statement, Respondent intended to fax his response to OED, but that for some reason he ultimately failed to do so. The ID did not treat this episode as involving a misrepresentation to OED, and the record does not provide grounds to disturb this treatment.

The OED Director also asserts there is a strong likelihood that Respondent backdated filings in this case. While the ID refers to apparent discrepancies involving the dates on the certificates of service for several documents Respondent filed in this case, the ID does not conclude that the documents were in fact backdated. Further, the issue was not charged or litigated, and the record has not been developed as to the circumstances surrounding the filings. This is unlike the situation in Small, where misrepresentation to OED was charged and proven, and where a portion of the penalty was imposed directly on the basis of that violation. The ID did not err in distinguishing Small on this basis.

Finally, the OED Director argues that the ID found that Respondent misappropriated client funds and should have imposed more stringent discipline on the basis of this finding. The ID found that Respondent collected and held funds from one client to cover a \$605 USPTO issue fee; did not remit the fee to the USPTO, thus permitting the application to go abandoned; and failed to return the fee to the client. The ID noted, however, that it did not treat the misappropriation as a separate charge and that the ALJ did not see it as a deliberate usurpation of client funds. ID at 38, note 51.

Instead, the ID treated it as “part and parcel of Respondent’s general neglect of client matters.” Id.

If Respondent had been charged with misappropriation of client funds and these charges had been sustained, a more severe penalty might well have been warranted. Given the posture of the case, however, the ID appropriately treated Respondent’s failure to return the issue fee as part of his pattern of neglect. Viewed in this light, the apparent misappropriation does not fundamentally change the nature of the neglect. The ID expressly declined to find that Respondent had intentionally converted the funds. The amount at issue, although significant, is only of a fraction of the damage caused by Respondent’s neglect.<sup>1</sup> Thus, Respondent’s failure to return the issue fee does not itself warrant a more severe penalty under the neglect charges.

#### ORDER

Upon consideration of the entire record, and pursuant to 37 C.F.R. § 10.130(a), it is

ORDERED that thirty (30) days from the date this order is entered, George A. Bode, whose USPTO Registration Number is 30,028, shall be suspended from practice before the USPTO for seven years, with the final four years of the suspension stayed, and that Respondent Bode be placed on probation for the those four years. The terms of the probation are:

- (i) Respondent shall comply with all Disciplinary Rules applicable to patent attorneys practicing before the USPTO; and

---

<sup>1</sup> The ID found that the value of the abandoned patents and trademarks, had they been issued, was irrelevant. However, the \$605 issue fee is only a fraction of the total legal and USPTO fees paid but rendered futile as a result of Respondent’s neglect.

- (ii) No document in any patent or trademark application can be filed in the United States Patent and Trademark Office by or on behalf of Respondent which (a) uses a certificate of mailing under 37 C.F.R. § 1.8 and (b) indicates that the document was prepared by, worked on, or signed by or on behalf of, Respondent.

The Respondent's attention is directed to 37 C.F.R. § 10.158 regarding responsibilities in the case of suspension or exclusion, and 37 C.F.R. § 10.160 concerning petitions for reinstatement.

It is further ORDERED that this Final Decision in this proceeding be published.

#### RECONSIDERATION AND APPEAL RIGHTS

Any request for reconsideration of this decision must be filed within twenty (20) days from the date of entry of this decision. 37 C.F.R. § 10.156(c). Any request for reconsideration mailed to the PTO must be addressed to:

James A. Toupin  
General Counsel  
United States Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

A copy of the request must also be served on the attorney for the Director of Enrollment and Discipline:

Sydney Johnson  
Associate Solicitor  
U.S. Patent and Trademark Office  
Post Office Box 16116  
Arlington, Virginia 22215



Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and Respondent desires further review, Respondent is notified that he is entitled to seek judicial review on the record in the U.S. District Court for the District of Columbia under 35 U.S.C. § 32 and LCvR 83.7 of the U.S. District Court for the District of Columbia within thirty (30) days of the date of entry of this decision.

IT IS SO ORDERED.

On behalf of the Under Secretary of Commerce for  
Intellectual Property and Director of the United  
States Patent and Trademark Office

\_\_\_\_\_  
Date

\_\_\_\_\_  
James Toupin  
General Counsel  
United States Patent and Trademark Office

cc:

Director  
Office of Enrollment and Discipline  
Mailstop OED  
USPTO  
P.O. Box 1450  
Alexandria, VA 22313-1450

George A. Bode  
2314 Broadway  
New Orleans, Louisiana 70125

Sydney Johnson, Esq.  
Associate Solicitor  
United States Patent and Trademark Office  
Office of the Solicitor  
P.O. Box 16116  
Arlington, VA 22215

# APPENDIX B

APPENDIX ITEM B-0

<b>Application Serial No.</b>	<b>Filing Date</b>	<b>Docket No. (Or Patent No.)</b>	<b>Internal Coding</b>
08/556,657	11-13-1995	M-95-3195	U.1
08/647,066	05-09-1996	Now 5,655,441	U.2
08/681,628	07-29-1996	M-95-3195-U.	U.3
08/681,627	07-29-1996	Now 5,720,218	U.4
08/681,658	07-29-1996	M-95-3195-U.	U.5
08/681,626	07-29-1996	Now 5,802,964	U.6
08/681,625	07-29-1996	M-95-3195-U.	U.7
08/681,624	07-29-1996	M-95-3195-U.	U.8
08/681,623	07-29-1996	M-95-3195-U.	U.9
08/681,622	07-29-1996	M-95-3195-U.	U.10
08/759,724	12-06-1996	M-95-3195-U.	U.11
08/759,723	12-06-1996	M-95-3195-U.	U.12
08/759,722	12-06-1996	Now 5,720,219	U.13
08/759,727	12-06-1996	M-95-3195-U.	U.14
08/763,679	12-11-1996	M-95-3195-U.1	U.15
08/884,529	06-27-1997	M-95-3195-U.	U.16
09/028,187	02-23-1998	M-95-3195-U.	U.17
09/377,936	08-20-1999	M-95-3195-U.	U.18
09/377,937	08-20-1999	M-95-3195-U.	U.19
09/641,790	08-18-2000	M-95-3195-U.20-CIP	U.20-CIP
09/835,919	04-16-2001	M-95-3195-U.21-CIP	U.21-CIP

Subject: U.S. Serial No. 09/641,790 (Our Ref: U.20-CIP)  
Date: Wed, 17 Jul 2002 10:25:21 -0400  
From: "George Bode" <Gbode@ccmattorneys.com>  
To: <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I have just received notice from the U.S. Patent office that the above-referenced U.S. patent application has allowable claims - Claims 7 - 17 and 21- 46.

The other claims (Claims 1 - 6 and 18 - 20) have been rejected, so I will study the matter and get back to you.

I will be in Europe during the period July 18 - 30, 2002, so I cannot meet with you during your "Quick Visit" to Lakeland for July 23 - 26, 2002. However, I will leave a copy of the U.S. Patent Office action in this matter action with John Lancaster so that he can pass it on to you when you meet on July 23, 2002.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 802-8442  
Fax: (863) 802-9160

Secondary:

Tele: (863) 647-5337  
Fax: (863) 647-5012

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B-1a

**Subject: Re: [Fwd: [Fwd: Urgent USPTO Patent Issues]]**

**Date: Tue, 05 Nov 2002 06:05:06 -0500**

**From: "George Bode" <Gbode@ccmattorneys.com>**

**To: <carlosmendes@intercitrus.com.br>**

Sr. Mendes:

I am completing the necessary petitions and will have copies of all documents to you ASAP.

I will be in Pensacola and New Orleans this week but this will not slow matters.

Vty,

G.A. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 802-8442

Fax: (863) 802-9160

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B-1b

**Subject: Re: Any News???**

**Date:** Tue, 26 Nov 2002 03:59:30 -0500

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I am working on the InterCitrus intellectual property portfolios.

Vty,

GAB

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 802-8442

Fax: (863) 802-9160

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B-2

**Subject: Fw: InterCitrus Patent Matters**

**Date:** Fri, 7 Mar 2003 10:13:23 -0300

**From:** "Carlos Mendes" <carlosmendes@intercitrus.com.br>

**To:** carlosmendes@intercitrus.com.br

----- Forwarded message -----

Sr. Mendes:

I am in New Orleans until March 11, 2003. I will contact you with details by then.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288  
Fax: (863) 680-2651

Secondary:

Tele: (863) 647-5337  
Fax: (863) 647-5012

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>>> Carlos Mendes <carlosmendes@intercitrus.com.br> 02/25/03 07:23AM >>>  
George,

I trust all is well with you. I have not heard from you in a while, nor have I received any materials related to your most recent filings of corrective actions. Also, where are we with respect to the European patent, PCT, and other international patent matters? Will you please update us on the status of these matters. Thanks, and I look forward to hearing from you soon.

Best regards,  
Carlos

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<http://www.techscorp.com.br>  
-----

B-3



**Subject: News and/or Materials**

**Date:** Tue, 01 Apr 2003 14:46:27 -0500

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

Acknowledge. I assume that you are back in Brasil. I will have a reply shortly.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288

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**Subject: InterCitrus Patent Matters**

**Date:** Sun, 18 Jan 2004 04:34:41 -0500

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I am preparing a package to send to you at work at our Araraquara, Brazil plant.

I have ordered file history of Tropicana Evans, et al. '189 "Juice Extractor" U.S. P

I have made another status inquiry of U.20 and the other pending patents.

I will be ready for your Board meeting next Tuesday morning at 10:00 am in the São P  
Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288  
Fax: (863) 680-2651

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B-6

**Subject: Re: Bode Hearing**

**Date: Mon, 23 Sep 2002 18:15:22 -0300**

**From: Carlos Mendes <carlosmendes@intercitrus.com.br>**

**Organization: InterCitrus S.A**

**To: Edward.Polk@USPTO.GOV**

**BCC: "G. A. Bode" <gbode@ccmattorneys.com>, Ron Clark <rclark@ccmattorneys.com>**

Mr. Polk,

As it turns out, this is my first day back in Brazil after having spent the last couple of weeks in Florida. At this time, I have no plans to be in the US in October. On the contrary, my agenda for October is all taken up with business in Brazil. I should next be in the US in sometime in December.

Best regards,  
Carlos Mendes

Edward.Polk@USPTO.GOV wrote:

> Mr. Mendes,  
>  
> I am writing this to let you know that the Judge has set the hearing in the  
> Bode case for October 8-11. The location has not been set; but will be in  
> either Washington DC or Pensacola, Florida. You mentioned that you spend  
> periods of time in Florida. Will you be in Florida anytime between the 8th  
> and 11th of October?  
>  
> Also, one of the inventors involved in the case is interested in bringing a  
> class action against Mr. Bode and asked me to pass his number along to any  
> other inventor that might be interested. His name is Halford S. Harris and  
> he can be contacted at (850) 479-8279.  
>  
> C. Edward Polk, Jr.  
> Associate Solicitor  
> United States Patent & Trademark Office  
> Office of the Solicitor  
> Tel: (703)305-8666 Email: edward.polk@uspto.gov

**Subject: [Fwd: Urgent USPTO Matters]**

**Date:** Fri, 30 Aug 2002 10:25:17 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

George,

Please confirm that you have received this message and are working the pending issues. Thank you.

Best regards,  
Carlos Mendes

---

**Subject: Urgent USPTO Matters**

**Date:** Tue, 27 Aug 2002 19:15:16 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**CC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

Dear George,

I received another call from the USPTO regarding some of our applications submitted in the last few years. After some questioning, I was informed that "several of our applications have gone abandoned because of no follow-up actions". I further asked what specific applications and was informed that "at least" the following have "definitely been abandoned":

- 1) US Pat App. 08/759,723
- 2) US Pat App. 08/759,727
- 3) US Pat App. 08/763,679
- 4) US Pat App. 08/884,529
- 5) US Pat App. 09/028,187

From my end, I am still trying to investigate the specifics of these applications, and they all appear to be applications that we definitely want to maintain alive and pursue to patent publication. Some (from my records) show that they had **allowable material**, and were on their way to being issued. Please do a **most thorough and complete investigation** on these, and all of our other pending applications, with maximum urgency. I am very concerned, as is my Board, who needs to be reassured that all matters are under control and/or can be quickly and completely rectified so that our intellectual property rights are fully protected under US law. Please give this matter you utmost priority. I look forward to hearing from

**Subject: Re: [Fwd: Urgent USPTO Matters]**

**Date:** Mon, 02 Sep 2002 14:25:46 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

**BCC:** Fernando Horta Jr <fhortajr@terraroja.agr.br>,  
Adriano Horta <adriano@terraroja.agr.br>

George,

First of all, wish a very rapid and full recovery! I would like to call you tomorrow (Brazil time) if you are up to it. We can bring each other up to speed on the most recent information regarding the patent issue. Let me know if this will work for you.

Best regards,  
Carlos Mendes

George Bode wrote:

> Senhor Mendes:

>

> I was hospitalized and have been recuperating the last week. I hope to be back at

>

> I will be in Lakeland all week. Please let me know when you want to speak.

>

> Vty,

>

> George BODE

>

> George A. BODE, Esq.

> BODE & ASSOCIATES, P.C.

> 500 South Florida Avenue

> 8th Floor

> Lakeland, Florida 33801

>

> Primary:

>

> Tele: (863) 802-8442

> Fax: (863) 802-9160

>

> Secondary:

>

> Tele: (863) 647-5337

> Fax: (863) 647-5012

>

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B-11



# InterCitrus

Agroindustrial e Comercial S.A.

Araraquara , S.P., Brazil  
October 2, 2002

**Mr. George A. Bode**  
Bode & Associates  
500 South Florida Avenue - 8th Floor  
Lakeland, Florida 33801 - USA

Dear George,

It was good to meet with you last month to sort out the issues regarding some of our patent applications. I have reported to my Board of Directors our findings and have assured them that you will be giving this matter your highest priority. Resolving these issues with our patent applications in the USPTO, and other foreign agencies, is of the utmost importance as you well know. I trust you are well on your way to putting in order each and everyone of our patent applications.

I have made an intensive study of our records and files and have identified some critical problems, or issues, in regards to some of our patent applications. Some of these problem applications are the same ones we identified and discussed earlier in our meeting of last September 17. To give you a better understanding of the results of my study, I list below what we believe are the most problematic processes:

<i>Bode Control Number</i>	<i>InterCitrus Control Number</i>	<i>USPTO Application Number</i>	<i>Problem Areas</i>	<i>Corrective Actions</i>
<b>U.10</b>	11, 12 & 13	US. Pat.App. <b>08/681,622</b>	No action from USPTO - why?	Find out status and revive if necessary
<b>U.11</b>	14	US. Pat.App. <b>08/759,724</b>	No action from USPTO - why?	Find out status and revive if necessary
<b>U.12</b>	15	US. Pat.App. <b>08/759,723</b>	Allowable Material	File ASAP "Petition to Revive"
<b>U.14</b>	17	US. Pat.App. <b>08/759,727</b>	Allowable Material	File ASAP "Petition to Revive"
<b>U.15</b>	18	US. Pat.App. <b>08/763,679</b>	Allowable Material	File ASAP "Petition to Revive"
<b>U.16</b>	20	US. Pat.App. <b>08/884,529</b>	No action from USPTO - why?	Find out status and revive if necessary
<b>U.17</b>	21	US. Pat.App. <b>09/028,187</b>	I have no record of this document	Find out status and revive if necessary
<b>U.18</b>	22	US. Pat.App. <b>09/377,936</b>	No action from USPTO - why?	Find out status and revive if necessary

B-12

# InterCitrus

Agroindustrial e Comercial S.A.

<i>Bode Control Number</i>	<i>InterCitrus Control Number</i>	<i>USPTO Ap- plication Number</i>	<i>Problem Areas</i>	<i>Corrective Actions</i>
<b>U.19</b>	23	US. Pat.App. <b>09/377,937</b>	No action from USPTO - why?	Find out status and revive if nec- essary
<b>U.20</b>	24	US. Pat.App. <b>09/641,790</b>	Allowable Mate- rial	File Necessary modifications as requested by examiner by <u>Oc- tober 3, 2002</u>
<b>U.20- PCT</b>	Int'l Patent Table 2	US. Pat. App. PCT/ <b>US00/22847</b>	No action from USPTO - why?	Find out status and revive if nec- essary
<b>U.21</b>	25	US. Pat.App. <b>09/835,919</b>	No action from USPTO - why?	Find out status and revive if nec- essary

I have also included herewith a copy of the complete master list of our patent filings (file Pat-USAL, revision L, of September 30, 2002). This list will be again updated once we have the remaining missing information. It is our intention that this list be maintained absolutely up to date and, reflect and ,control each and every one of InterCitrus' patent applications, and subsequent issued patents, throughout the world. We request your help in assuring that all of the information in this master list will always match perfectly with your records, and vice versa.

Please take, with maximum urgency, the most thorough and complete corrective actions necessary to remedy the problems with our pending applications. I am very concerned, as is my Board, who needs to be reassured that all matters are under control and/or can be quickly and completely rectified so that our intellectual property rights are fully protected under US, and other applicable international law. Please give this matter you utmost priority. I look forward to hearing from you soon, on your progress toward the resolutions of these issues.

Very truly yours,

Carlos Mendes  
Managing Director  
InterCitrus SA

Cc: F.P.L. Horta  
Ronald Clark, Esq.

Attachment: File Pat-USAL

CMN02K02-GBode

**Subject: Re: Urgent USPTO Patent Issues**

**Date:** Mon, 07 Oct 2002 11:56:04 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, Ron Clark <rclark@ccmattorneys.com>, Adriano Horta <adriano@terraroja.agr.br>

**BCC:** CMN <carlosmendes@intercitrus.com.br>

George,

Can you please confirm receipt of the letter below. And, have you acted on (especially important item U.20-CIP), on the subject patent matters? Please let me know asap.

Best regards,  
Carlos

Carlos Mendes wrote:

George,

I trust you are well. I have concluded (sufficiently for now) a study on our patent application issues. I have attached a relevant letter and our master control list to this e-mail. Both documents are in Microsoft Word format, I trust will be able to open them. Nevertheless, I am also sending you hard copies of these documents via airmail.

Most urgent, I believe, is the filing of the needed corrections to your item **U.20-CIP** (Us Pat. App. **09/641,790**) with "Allowable Material" in order for this application issue as a patent. If I remember correctly, this needs to be done by tomorrow, October 3. Please confirm as soon as possible that you have taken the needed measures to assure issuance of this patent. We will talk soon. Please stay in touch.

Best regards,  
Carlos Mendes



le: [Fwd: InterCitrus Patents]

**Subject: Re: [Fwd: InterCitrus Patents]**

**Date:** Fri, 18 Oct 2002 22:17:57 -0400

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

Acknowledged.

Vty,

G. A. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 802-8442

Fax: (863) 802-9160

Secondary:

Tele: (863) 647-5337

Fax: (863) 647-5012

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B-14

19/08/04 14:10

**Subject: [Fwd: Urgent USPTO Patent Issues]**

**Date:** Tue, 29 Oct 2002 16:44:48 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**CC:** Ron Clark <rclark@ccmattorneys.com>, Adriano Horta <adriano@terraroja.agr.br>

**BCC:** CMN <carlosmendes@intercitrus.com.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

George,

I have not yet heard anything, nor have I received anything in the mail from you, regarding our urgent patent matters. Please let me know where we stand on these processes. We must move more quickly and decisively to resolve the pending problems. All components of our patent and trademark portfolio must be put in order.

Sincerely,  
Carlos Mendes

---

**Subject: Re: Urgent USPTO Patent Issues**

**Date:** Mon, 07 Oct 2002 11:56:04 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, Ron Clark <rclark@ccmattorneys.com>,  
Adriano Horta <adriano@terraroja.agr.br>

George,

Can you please confirm receipt of the letter below. And, have you acted on (especially important item U.20-CIP), on the subject patent matters? Please let me know asap.

Best regards,  
Carlos

Carlos Mendes wrote:

B-15

George,

I trust you are well. I have concluded (sufficiently for now) a study on our patent application issues. I have attached a relevant letter and our master control list to this e-mail. Both documents are in Microsoft Word format, I trust will be able to open them. Nevertheless, I am also sending you hard copies of these documents via airmail.

Most urgent, I believe, is the filing of the needed corrections to your item U.20-CIP (Us Pat. App. 09/641,790) with "Allowable Material" in order for this application issue as a patent. If I remember correctly, this needs to be done by tomorrow, October 3. Please confirm as soon as possible that you

have taken the needed measures to assure issuance of this patent. We will talk soon. Please stay in touch.

Best regards,  
Carlos Mendes

**Subject: [Fwd: [Fwd: Urgent USPTO Patent Issues]]**

**Date:** Mon, 04 Nov 2002 12:06:43 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, Ron Clark <rclark@ccmattorneys.com>

**BCC:** CMN <carlosmendes@intercitrus.com.br>

Gentlemen,

Good morning to all. I have still not received any materials. Can you please let me know the status of these matters asap.

Best regards,  
Carlos Mendes

---

**Subject: [Fwd: Urgent USPTO Patent Issues]**

**Date:** Tue, 29 Oct 2002 16:44:48 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**CC:** Ron Clark <rclark@ccmattorneys.com>; Adriano Horta <adriano@terraroja.agr.br>

George,

I have not yet heard anything, nor have I received anything in the mail from you, regarding our urgent patent matters. Please let me know where we stand on these processes. We must move more quickly and decisively to resolve the pending problems. All components of our patent and trademark portfolio must be put in order.

Sincerely,  
Carlos Mendes

---

**Subject: Re: Urgent USPTO Patent Issues**

**Date:** Mon, 07 Oct 2002 11:56:04 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, Ron Clark <rclark@ccmattorneys.com>, Adriano Horta <adriano@terraroja.agr.br>

George,

Can you please confirm receipt of the letter below. And, have you acted on (especially important item U.20-CIP), on the subject patent matters? Please let me know asap.

Best regards,  
Carlos

Carlos Mendes wrote:

George,

I trust you are well. I have concluded (sufficiently for now) a study on our patent application issues. I have attached a relevant letter and our master control list to this e-mail. Both documents are in Microsoft Word format, I trust will be able to open them. Nevertheless, I am also sending you hard copies of these documents via airmail.

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Best regards,  
Carlos Mendes

Any News???

**Subject: Any News???**

**Date:** Fri, 15 Nov 2002 16:09:12 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

George,

Any news???

Carlos



# InterCitrus

Agroindustrial e Comercial S.A.

Araraquara, S.P., Brazil

November 22, 2002

**Mr. George A. Bode**

Bode & Associates

500 South Florida Avenue - 8th Floor

Lakeland, Florida 33801 - USA

**Re: Lack of Service**

Dear George,

I do not understand why we have not yet heard from you with regards to our urgent patent matters. Since last August, having been alerted by Mr. Edward Polk, of the USPTO, to serious problems in several of our pending patent processes, we have tried to impress upon you our urgent need to resolve these issues. At the very least, we have an urgent need to initiate and file documents with the USPTO that can result in the needed corrective actions pursuant to the complete resolution of these patent issues. Over the last 6 weeks you have repeatedly promised to send us documents and copies of these corrective actions. Still, we have not yet received a single document, nor have we received any information that substantiates the fact that corrective actions are in place, and will be pursued to completion.

Over the last few months, for reasons unknown to us, we have seen a dramatic decline in the quality of your services, with regards to our national and international patent and trademark work. Our need for prompt and high quality service in these matters has never been greater. We must, and will have, the highest caliber of work in this area. Since 1995, and throughout last year, you rendered excellent services in these matters. We are quite frankly puzzled and frustrated with the lack of quality service of the last months.

We would like to know if you are still interested in handling our intellectual property work, and if so, what immediate corrective actions will you take to rectify this unsustainable situation. If you are not interested in continuing our relationship, please let us know so that we can pursue the transfer of this work to other specialized legal counsel.

Very truly yours,

**Carlos Mendes**

Managing Director

**Cc: F.P.L. Horta, Chairman, InterCitrus SA**

**Ronald Clark, Esq.**

**B-18**

**CMN02L22-GBode**

Avenida Engenheiro Camilo Dinucci, 5717 - CEP14.808-100 Araraquara São Paulo Brazil

Telephone: 55-16-222-2933 Fax: 55-16-222-1751

**Subject: Re: Next Visit: December 11th**

**Date:** Tue, 10 Dec 2002 14:46:26 -0500

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I just returned.

Tomorrow - Wednesday, December 11, 2002, @ 10:30 AM @ my office. Please confirm!

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 802-8442  
Fax: (863) 802-9160

Secondary:

Tele: (863) 647-5337  
Fax: (863) 647-5012

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**Subject: Money Sent**

**Date:** Tue, 21 Jan 2003 08:59:46 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**CC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

Good Morning George,

The \$7,300.00 from your last bill was sent to your Hibernia bank account last Friday. Let us know if the money has arrived.

Do you have any further news on our USPTO pending patent applications? Have all the reactivation processes been received and acknowledged by the USPTO? Any new issuing patents? And, have you received the **3 Certified True** copies we need of our patent application U.S. Serial No. **09/835,919**? Have you received the original of the EPO Patent? Please let us know the latest developments in these matters.

I will likely be in Lakeland next week, on Friday, January 31. Perhaps we can meet for a quick update.

Best regards,  
Carlos Mendes

B-20

**Subject: Update**

**Date:** Thu, 23 Jan 2003 11:09:21 -0500

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

Confirm receipt of funds.

I will be prepared to meet with you on or after January 31, 2003, when you are next  
Vty,

G.A. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

**Primary:**

Tele: (863) 686-8288  
Fax: (863) 680-2651

**Secondary:**

Tele: (863) 647-5337  
Fax: (863) 647-5012

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**Subject: Re: Update**

**Date:** Fri, 24 Jan 2003 12:15:55 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

**BCC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>,  
Ron Clark <rclark@ccmattorneys.com>,  
John Lancaster <JLancaster@ccmattorneys.com>

Thank you George, I will see you next Friday at 1400. Have a good week end.

Best regards,  
Carlos

George Bode wrote:

> Sr. Mendes:

>

> Confirm appointment for Friday, January 31, 2003 @ 2:00 PM.

>

> Vty,

>

> G.A. BODE

>

> George A. BODE, Esq.

> BODE & ASSOCIATES, P.C.

> 500 South Florida Avenue

> 8th Floor

> Lakeland, Florida 33801

>

> Primary:

>

> Tele: (863) 686-8288

> Fax: (863) 680-2651

>

> Secondary:

>

> Tele: (863) 647-5337

> Fax: (863) 647-5012

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> error, please notify the sender by e-mail reply. Thank you.

>

> >>> Carlos Mendes <carlosmendes@intercitrus.com.br> 01/23/03 01:13PM >>>

> George,

>

> Can we meet at 2:00 p.m. on Friday, January 31? This would be good for me. Please  
> works for you.

>

> Best regards,

> Carlos  
>  
> George Bode wrote:  
>  
> > Sr. Mendes:  
> >  
> > Confirm receipt of funds.  
> >  
> > I will be prepared to meet with you on or after January 31, 2003, when you are n  
> >  
> > Vty,  
> >  
> > G.A. BODE  
> >  
> > George A. BODE, Esq.  
> > BODE & ASSOCIATES, P.C.  
> > 500 South Florida Avenue  
> > 8th Floor  
> > Lakeland, Florida 33801  
> >  
> > Primary:  
> >  
> > Tele: (863) 686-8288  
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> > error, please notify the sender by e-mail reply. Thank you.

**Subject: [Fwd: InterCitrus Patent Matters]**

**Date:** Thu, 06 Mar 2003 10:32:38 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**CC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

George,

I need to discuss progress on these issues. Please update me via e-mail, on what you have so far. I will be in Lakeland on (Monday and Tuesday) March 17 and 18. Ideally, I would like to meet with you on Monday afternoon. Please confirm.

Regards,  
Carlos Mendes

---

**Subject: InterCitrus Patent Matters**

**Date:** Tue, 25 Feb 2003 09:23:35 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

George,

I trust all is well with you. I have not heard from you in a while, nor have I received any materials related to your most recent filings of corrective actions. Also, where are we with respect to the European patent, PCT, and other international patent matters? Will you please update us on the status of these matters. Thanks, and I look forward to hearing from you soon.

Best regards,  
Carlos

**Subject: Re: [Fwd: Fw: InterCitrus Patent Matters]**

**Date:** Wed, 12 Mar 2003 12:11:37 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

**CC:** "L.F. Marcomini" <marcomini@intercitrus.com.br>,  
Ernani Gemignani <ernani@intercitrus.com.br>

**BCC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

George,

Thanks very much. I will see you at your office, on Tuesday, 10:00 a.m. I Look forward to it.

Best regards,  
Carlos Mendes

George Bode wrote:

> Sr. Mendes:  
>  
> I confirm our appointment - TUESDAY, MARCH 18, 2003, @ 10:00 AM @ my office in Lak  
>  
> Vty,  
>  
> George Bode  
>  
> George A. BODE, Esq.  
> BODE & ASSOCIATES, P.C.  
> 500 South Florida Avenue  
> 8th Floor  
> Lakeland, Florida 33801  
>  
> Primary:  
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> Tele: (863) 686-8288  
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> Tele: (863) 647-5337  
> Fax: (863) 647-5012  
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> error, please notify the sender by e-mail reply. Thank you.  
>  
> >>> Carlos Mendes <carlosmendes@intercitrus.com.br> 03/12/03 06:58AM >>>  
> George,  
>

Re: [Fwd: Fw: InterCitrus Patent Matters]

> My agenda has changed somewhat for early next week. Can we meet at 10:00  
> a.m. on Tuesday, March 18th, at your office? Please confirm asap.  
> Thanks.  
>  
> Best regards,  
> Carlos

**Subject: Re: Meetings Next Week**

**Date:** Fri, 09 May 2003 10:04:03 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

**CC:** Adriano Horta <adriano@terraroxxa.agr.br>,

Fernando Horta Jr <fhortajr@terraroxxa.agr.br>,

Ron Clark <rclark@ccmattorneys.com>,

"Joseph P. Mawhinney" <jmawhinney@ccmattorneys.com>

**BCC:** CMN <carlosmendes@intercitrus.com.br>

George,

Thanks for the confirmation. We can start next Wednesday with breakfast, say at Denny's at 7:30 a.m., if you would like. Let me know.

I have herein attached a diagram (**Patent-diagram-03E08.xls**) that shows the origin and evolution of our patents related to the filter itself, and associated filtering concepts. Please check this, and if ok, we will want to use this as a guide for our analyses. I leave Monday night from São Paulo, and should arrive in Lakeland by noon on Tuesday. Stay in touch.

Best regards,  
Carlos

PS: We will together work out the overall strategy and execution plan with Ron and Joe on Wednesday afternoon.

George Bode wrote:

Sr. Mendes:

Confirm meetings all day Wednesday and Thursday, May 14 and 15, 2003.

I also plan to go with you to Coca-Cola in Apopka, if need be, most likely on Thursday, May 15, 2003.

Vty,

GAB

P.S.: With Clark, Campbell & Mawhinney taking on major efforts for InterCitrus, I would prefer if you work out a separate billing arrangement with them when you are next here.

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

B-25



**Subject: InterCitrus Patent Matters**  
**Date:** Thu, 05 Jun 2003 11:01:10 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>

**Subject:** InterCitrus Patent Matters  
**Date:** Tue, 03 Jun 2003 14:35:20 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>  
**CC:** Ron Clark <rclark@ccmattorneys.com>, Adriano Horta <adriano@terraroja.agr.br>, Fernando Horta Jr <fhortajr@terraroja.agr.br>

George,

Do you have any news on our pending patent matters? Specifically, and of more urgent interest, we need an update on the following:

1. What is the status of the **P4** patent application (U.22)?
2. What are the status of our other patent applications? In particular what is the status of U.20 (US 09/641,790) and U.21 (US 09/835,919), both of which had the allowable material in August of 2002?
3. Do you have a new Bill for us? Have you prepared (including Clark&Mawhinney) and sent anything? Will you be doing so in the near future? (I have just received a bill for \$5,555.50 from Clark&Mawhinney for their work on the Tropicana patent issue.) Please do so, so that we in turn may remit to you a lump sum.

Please give us an update as soon as possible.

Best regards,  
Carlos Mendes

[Fwd: [Fwd: [Fwd: [Fwd: [Fwd: U.22 Patent Application?]]]]]

**Subject:** [Fwd: [Fwd: [Fwd: [Fwd: [Fwd: U.22 Patent Application?]]]]]  
**Date:** Fri, 01 Aug 2003 18:24:10 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

---

**Subject:** [Fwd: [Fwd: [Fwd: [Fwd: U.22 Patent Application?]]]]  
**Date:** Wed, 30 Jul 2003 11:34:52 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

---

**Subject:** [Fwd: [Fwd: [Fwd: U.22 Patent Application?]]]  
**Date:** Tue, 29 Jul 2003 11:37:40 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

---

**Subject:** [Fwd: [Fwd: U.22 Patent Application?]]  
**Date:** Thu, 24 Jul 2003 14:35:35 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** George Bode <Gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

---

**Subject:** [Fwd: U.22 Patent Application?]  
**Date:** Mon, 21 Jul 2003 17:32:07 -0300  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** "G. A. Bode" <gbode@ccmattorneys.com>

George,

Please let us know the status of U.22 (and others).

Thanks,  
Carlos Mendes

B-27

[Fwd: [Fwd: [Fwd: [Fwd: [Fwd: U.22 Patent Application?]]]]]

**Subject: U.22 Patent Application?**

**Date:** Tue, 08 Jul 2003 08:59:45 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>

Good morning George,

Where do we stand with the U.22 patent application? Have you finished the write up? Please send asap.

Thanks,  
Carlos

**Subject: Patent Matters (U.22)**

**Date:** Tue, 26 Aug 2003 15:59:59 -0400

**From:** "George Bode" <Gbode@ccmattorneys.com>

**To:** <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I will be in the office in Lakeland tomorrow and will call you.

A reminder - I am not part of Clark, Campbell, et al. - please do not contact their personnel about Bode & Associates - they have no authority to act on my behalf or access to our files.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288

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**Subject: Final Notice Regarding Lack of Service**

**Date:** Tue, 26 Aug 2003 17:01:22 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <bodeip@bellsouth.net>, George Bode <Gbode@ccmattorneys.com>

**CC:** Ron Clark <rclark@ccmattorneys.com>,

Fernando Horta Jr <fhortajr@terroroxa.agr.br>

**BCC:** Adriano Horta <adriano@terroroxa.agr.br>, CMN <carlosmendes@intercitrus.com.br>

Araraquara, S.P., Brazil

August 26, 2003

**Advance Copy via e-mail**

Mr. George A. Bode, Esq.

Bode & Associates

500 South Florida Avenue - 8th Floor

Lakeland, Florida 33801 - USA

**Re: Final Notice Regarding Lack of Service**

Dear Mr. Bode,

As outlined in our earlier letter of November 22, 2002, we have continued to experience serious problems in several of our pending patent processes. Since then we have tried to impress upon you the urgent need to resolve these issues. Apparently we have failed, as in the last 6 months, in spite of our appeals to you, we have not been able to get quality and timely service from your firm in regards to our intellectual property matters.

As noted to you earlier, in many e-mail and telephone communications, we have been waiting for 3 months for your filling of our patent application for the P4 Fruit Juice Extractor configuration, your item U.22, and yet, no definitive draft has come from you. Over the last 3 weeks you have repeatedly promised to send us this document, and others related to corrective actions being taken. To this date, we have not received the U.22 document, nor have we received any information that substantiates the fact that this document is being worked on and finalized for submittal to the US Patent Office. Nor have we received notice that other corrective actions are in place, and will be pursued to completion.

Therefore, we are hereby giving you notice that Patent Application U.22 must be satisfactorily finalized and filled by September 2 of next week. If not, consider our verbal service contract with you and your firm to be fully rescinded and void. Should the U.22 Application not be submitted to the USPTO by the September 2nd date, InterCitrus will immediately begin transferring of all of its intellectual property work to a new firm, to be appointed by us at an appropriate time.

Very truly yours,

Carlos Mendes

Managing Director



# InterCitrus

Agroindustrial e Comercial S.A.

Araraquara, S.P., Brazil  
August 26, 2003

Mr. George A. Bode, Esq.  
Bode & Associates  
500 South Florida Avenue - 8th Floor  
Lakeland, Florida 33801 - USA

Post-It™ brand fax transmittal memo 7671		# of pages ▶ 1
To	MR. G. A. Bode	
From	C. MENDES	
Co.	BODE & ASSOC.	
Co.	INTERCITRUS	
Dept.	CC: MR. RON CLARK	
Phone #	55-16-222-2933	
Fax #	(863)647-5012	
Fax #	55-16-222-1751	

**Re: Final Notice Regarding Lack of Service**

Dear Mr. Bode,

As outlined in our earlier letter of November 22, 2002, we have continued to experience serious problems in several of our pending patent processes. Since then we have tried to impress upon you the urgent need to resolve these issues. Apparently we have failed, as in the last 6 months, in spite of our appeals to you, we have not been able to get quality and timely service from your firm in regards to our intellectual property matters.

As noted to you earlier, in many e-mail and telephone communications, we have been waiting for 3 months for your filling of our patent application for the P4 Fruit Juice Extractor configuration, your item U.22, and yet, no definitive draft has come from you. Over the last 3 weeks you have repeatedly promised to send us this document, and others related to corrective actions being taken. To this date, we have not received the U.22 document, nor have we received any information that substantiates the fact that this document is being worked on and finalized for submittal to the US Patent Office. Nor have we received notice that other corrective actions are in place, and will be pursued to completion.

Therefore, we are hereby giving you notice that Patent Application U.22 must be satisfactorily finalized and filled by September 2 of next week. If not, consider our verbal service contract with you and your firm to be fully rescinded and void. Should the U.22 Application not be submitted to the USPTO by the September 2nd date, InterCitrus will immediately begin transferring of all of its intellectual property work to a new firm, to be appointed by us at an appropriate time.

Very truly yours,

  
Carlos Mendes  
Managing Director

Cc: F.P.L. Horta, Chairman, InterCitrus SA  
Ronald Clark, Esq.

CMN03H26-GBode

B-30

Avenida Engenheiro Camilo Dinucci, 5717 - CEP14.808-100 Araraquara São Paulo Brazil  
- Telephone: 55-16-222-2933 Fax: 55-16-222-1751

**Subject: Location**

**Date:** Thu, 11 Sep 2003 7:11:41 -0400

**From:** <bodeip@bellsouth.net>

**To:** Carlos Mendes <carlosmendes@intercitrus.com.br>

Sr. Mendes:

I am in Pensacola today (Sept. 11) and New Orleans tomorrow (Sept 12).

Will return to Lakeland for Monday, September 15, 2003.

I can call you today - after 12:00 Noon CENTRAL time. Please provide a telephone nu

G. BODE

\

>

> *From: Carlos Mendes <carlosmendes@intercitrus.com.br>*

> *Date: 2003/09/08 Mon PM 05:04:59 EDT*

> *To: George Bode <bodeip@bellsouth.net>,*

> *George Bode <Gbode@ccmattorneys.com>*

> *Subject: Where are You?*

>

> *George,*

>

> *I hope all is well with you. What happened, what is happening? Where are*

> *you? When, and where can we arrange to talk again?*

>

> *Regards,*

> *Carlos*

>

>

George A. BODE

BODE & ASSOCIATES

2314 Broadway

New Orleans, Louisiana 70125-4128

Telephone: (504) 861-8288

**Subject: Urgent InterCitrus Patent Matters**

**Date:** Mon, 29 Sep 2003 15:02:12 -0300

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

**CC:** Ron Clark <rclark@ccmattorneys.com>,

Fernando Horta Jr <fhortajr@terraroja.agr.br>

**BCC:** Adriano Horta <adriano@terraroja.agr.br>, CMN <carlosmendes@intercitrus.com.br>

Araraquara , S.P., Brazil

September 29, 2003

**Mr. George A. Bode**

Bode & Associates

500 South Florida Avenue - 8th Floor

Lakeland, Florida 33801 - USA

ADVANCE COPY - Via e-mail

Dear Mr. Bode,

To confirm our understanding from our last telephone conversation, I will next be in Lakeland on October 14, 2003. I will be at your office at 3:00 p.m., to initiate our conversations toward resolving our pending patent and trademark matters. My only priority is to leave with an absolutely firm agreement on a plan of action to resolve expeditiously all pending and open issues with regards to these matters. I will take whatever time is necessary during the week of October 14th, to definitively conclude this plan. I understand that you will also be available during this time to close on all issues.

I have reported to my Board of Directors our understanding, and have assured them that you will be giving this matter your highest priority. Resolving the issues with our patent applications in the USPTO, and other foreign agencies, is of the utmost importance as you well know. I trust you are well on your way to putting in order each and everyone of our patent applications.

I have made an intensive study of our records and files and have identified some critical problems, or issues, in regards to some of our patent applications. Some of these problem applications are the same ones we identified and discussed earlier in our meeting of September 17, 2002. To give you a better understanding of the results of my study, I list below what we believe are the most critical and urgent processes to be resolved successfully:

*Bode Control Number (InterCitrus Control) Number USPTO Application Number Problem Areas  
Corrective Actions*

**U.10** (11, 12 & 13) US. Pat.App. 08/681,622 No action from USPTO - why? Find out status and revive if necessary

**U.11** (14) US. Pat.App. 08/759,724 No action from USPTO - why? Find out status and revive if necessary

**U.12** (15) US. Pat.App. 08/759,723 Allowable Material File ASAP "Petition to Revive

**U.14** (17) US. Pat.App. 08/759,727 Allowable Material File ASAP "Petition to Revive"



- U.15 (18)** US. Pat.App. 08/763,679 Allowable Material File ASAP "Petition to Revive  
**U.16 (20)** US. Pat.App. 08/884,529 No action from USPTO - why? Find out status and revive if necessary  
**U.17 (21)** US. Pat.App. 09/028,187 I have no record of this document Find out status and revive if necessary  
**U.18 (22)** US. Pat.App. 09/377,936 No action from USPTO - why? Find out status and revive if necessary  
**U.19 (23)** US. Pat.App. 09/377,937 No action from USPTO - why? Find out status and revive if necessary  
**U.20 (24)** US. Pat.App. 09/641,790 Allowable Material File Necessary modifications as requested by examiner by October 3, 2002 ? Done??  
**U.20- PCT** (Int'l Patent Table 2) US. Pat. App. PCT/ US00/22847 No action from USPTO - why? Find out status and revive if necessary  
**U.21 (26)** US. Pat.App. 09/835,919 No action from USPTO - why? Find out status and revive if necessary  
**U.22 (27)** US. Pat.App. To Be Filed Brasil Pat. App. 03004272 filed on Sept. 06, 2003 To be filed asap with the USPTO based on Brasil Pat. App. 03004272

Also, please do not forget, I will need to take possession of the original of our European Patent number EP 0757 896 B1.

Please take, with maximum urgency, the most thorough and complete corrective actions necessary to remedy the problems with our pending applications. I am very concerned, as is my Board, who needs to be reassured that all matters are under control and/or can be quickly and completely rectified so that our intellectual property rights are fully protected under US, and other applicable international law. Please give this matter you utmost priority. I look forward to meeting with you on October 14 to review your progress toward the resolutions of these issues.

Very truly yours,  
Carlos Mendes  
Managing Director  
InterCitrus SA

Cc: F.P.L. Horta  
Ronald Clark, Esq.

CMN03J29-GBode



# InterCitrus

Agroindustrial e Comercial S.A.

Araraquara , S.P., Brazil  
September 29, 2003

**Mr. George A. Bode**  
Bode & Associates  
500 South Florida Avenue - 8th Floor  
Lakeland, Florida 33801 - USA

Dear Mr. Bode,

To confirm our understanding from our last telephone conversation, I will next be in Lakeland on October 14, 2003. I will be at your office at 3:00 p.m., to initiate our conversations toward resolving our pending patent and trademark matters. My only priority is to leave with an absolutely firm agreement on a plan of action to resolve expeditiously all pending and open issues with regards to these matters. I will take whatever time is necessary during the week of October 14th, to definitively conclude this plan. I understand that you will also be available during this time to close on all issues.

I have reported to my Board of Directors our understanding, and have assured them that you will be giving this matter your highest priority. Resolving the issues with our patent applications in the USPTO, and other foreign agencies, is of the utmost importance as you well know. I trust you are well on your way to putting in order each and everyone of our patent applications.

I have made an intensive study of our records and files and have identified some critical problems, or issues, in regards to some of our patent applications. Some of these problem applications are the same ones we identified and discussed earlier in our meeting of September 17, 2002. To give you a better understanding of the results of my study, I list below what we believe are the most critical and urgent processes to be resolved successfully:

<i>Bode Control Number</i>	<i>InterCitrus Control Number</i>	<i>USPTO Application Number</i>	<i>Problem Areas</i>	<i>Corrective Actions</i>
<b>U.10</b>	11, 12 & 13	US. Pat.App. <b>08/681,622</b>	No action from USPTO - why?	Find out status and revive if necessary
<b>U.11</b>	14	US. Pat.App. <b>08/759,724</b>	No action from USPTO - why?	Find out status and revive if necessary
<b>U.12</b>	15	US. Pat.App. <b>08/759,723</b>	Allowable Material	File ASAP "Petition to Revive"
<b>U.14</b>	17	US. Pat.App. <b>08/759,727</b>	Allowable Material	File ASAP "Petition to Revive"

Avenida Engenheiro Camilo Dinucci, 5717 - CEP14.808-100 Araraquara São Paulo Brazil  
Telephone: 55-16-222-2933 Fax: 55-16-222-1751

B-32b

# InterCitrus

Agroindustrial e Comercial S.A.

<b>U.15</b>	18	US. Pat.App. <b>08/763,679</b>	Allowable Material	<b>File ASAP "Petition to Revive</b>
<b>U.16</b>	20	US. Pat.App. <b>08/884,529</b>	No action from USPTO - why?	<b>Find out status and revive if necessary</b>
<b>U.17</b>	21	US. Pat.App. <b>09/028,187</b>	I have no record of this document	<b>Find out status and revive if necessary</b>
<b>U.18</b>	22	US. Pat.App. <b>09/377,936</b>	No action from USPTO - why?	<b>Find out status and revive if necessary</b>
<b>U.19</b>	23	US. Pat.App. <b>09/377,937</b>	No action from USPTO - why?	<b>Find out status and revive if necessary</b>
<b>U.20</b>	24	US. Pat.App. <b>09/641,790</b>	Allowable Material	<b>File Necessary modifications as requested by examiner by October 3, 2002 ? Done???</b>
<b>U.20- PCT</b>	Int'l Patent Table 2	US. Pat. App. PCT/ <b>US00/22847</b>	No action from USPTO - why?	<b>Find out status and revive if necessary</b>
<b>U.21</b>	26	US. Pat.App. <b>09/835,919</b>	No action from USPTO - why?	<b>Find out status and revive if necessary</b>
<b>U.22</b>	27	US. Pat.App. To Be Filed	<b>Brasil Pat. App. 03004272</b> filed on Sept. 06, 2003	<b>To be filed asap with the USPTO based on Brasil Pat. App. 03004272</b>

Also, please do not forget, I will need to take possession of the original of our European Patent number EP 0757 896 B1.

Please take, with maximum urgency, the most thorough and complete corrective actions necessary to remedy the problems with our pending applications. I am very concerned, as is my Board, who needs to be reassured that all matters are under control and/or can be quickly and completely rectified so that our intellectual property rights are fully protected under US, and other applicable international law. Please give this matter you utmost priority. I look forward to meeting with you on October 14 to review your progress toward the resolutions of these issues.

Very truly yours,

Carlos Mendes  
Managing Director  
InterCitrus SA

Cc: F.P.L. Horta  
Ronald Clark, Esq.

CMN03J29-GBode

Avenida Engenheiro Camilo Dinucci, 5717 - CEP14.808-100 Araraquara São Paulo Brazil  
Telephone: 55-16-222-2933 Fax: 55-16-222-1751

**Subject: Re: InterCitrus Patent Matters**

**Date:** Wed, 26 Nov 2003 15:16:46 -0200

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

George,

This plan would work for me. We can start with a meeting at your Lakeland office on December 16th, say 10:00 a.m., and take it from there. Also, please go ahead and plan for a December 22 or 23 visit with the USPTO in the D.C. area. I will be here in Brazil until December 5th (Friday next week). I will be in California from December 8th through the 13th (when I return to Lakeland late evening). Please keep me updated on your planning and patent work. Talk to you soon.

Best regards,  
Carlos Mendes

George Bode wrote:

Senhor Mendes:

I will be in Lakeland December 15, 2003, and onward.

I plan to go to New Jersey for Christmas visit to my family and perhaps we could meet in Washington, D.C. area before then (December 22 or 23, 2003, looks promising).

We should be able to make more definite plans after our Thanksgiving holiday.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288

Fax: (863) 680-2651

B-33

**Subject: Re: InterCitrus Patent Matters**

**Date:** Mon, 19 Jan 2004 09:31:54 -0200

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>

**CC:** Adriano Horta <adriano@terraroja.agr.br>,  
Fernando Horta Jr <fhortajr@terraroja.agr.br>

Good morning George,

Thank you for the update. Please keep me posted on these matters. I will be in São Paulo tomorrow and Wednesday for my Board meetings, but will be checking on my e-mails. Please keep me posted on these matters, as I will be presenting and discussing these with my Board. Thanks.

Regards,  
Carlos

George Bode wrote:

Sr. Mendes:

I am preparing a package to send to you at work at our Araraquara, Brazil plant.

I have ordered file history of Tropicana Evans, et al. '189 "Juice Extractor" U.S. Patent.

I have made another status inquiry of U.20 and the other pending patents.

I will be ready for your Board meeting next Tuesday morning at 10:00 am in the São Paulo corporate office.

Vty,

G. BODE

George A. BODE, Esq.  
BODE & ASSOCIATES, P.C.  
500 South Florida Avenue  
8th Floor  
Lakeland, Florida 33801

Primary:

Tele: (863) 686-8288

Fax: (863) 680-2651

Secondary:

Tele: (863) 647-5337

Fax: (863) 647-5012

B-34

**Subject: Re: InterCitrus Patent Matters**

**Date:** Tue, 20 Apr 2004 09:55:24 -0700

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** bodeip@earthlink.net

**BCC:** Adriano Horta <adriano@terraroja.agr.br>, CMN <carlosmendes@intercitrus.com.br>,

Fernando Horta Jr <fhortajr@terraroja.agr.br>

George,

I have not heard from you for quite a long while, nor have I received any materials by mail. Please let me know the current status of our most pressing matters. Thanks.

Best regards,

Carlos

GM BODE wrote:

Sr. Mendes:

We keep receiving multiple e-mails - there is only one (1) mail and e-mail address for

BODE & ASSOCIATES, as provided at the end of this correspondence.

Please do NOT send e-mail to bodeip@bellsouth.net or gbode@ccmattorneys.com

Further, please do NOT communicate with us through Clark, Campbell & MNawhinney.

I will contact you about an appointment in Lakeland as soon as my travel e is firm.

Vty,

George A. BODE

BODE & ASSOCIATES, P.C.

2314 Broadway

New Orleans LA 70125-4128

Telephone: (504) 861-8288

FAX: (504) 866-6717

bodeip@earthlink.net

> [Original Message]

> From: Carlos Mendes <carlosmendes@intercitrus.com.br>

> To: George Bode <bodeip@bellsouth.net>; George Bode <bodeip@earthlink.net>

> Date: 2/20/2004 4:04:20 PM

> Subject: Fwd: InterCitrus Patent Matters => Have you sent info package?

>

>

>

B-35

**Subject: Fwd: InterCitrus Patent Matters => Have you sent info package?**

**Date:** Fri, 20 Feb 2004 18:00:25 -0800

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <bodeip@bellsouth.net>, George Bode <bodeip@earthlink.net>

**BCC:** CMN <carlosmendes@intercitrus.com.br>

---

**Subject: [Fwd: [Fwd: InterCitrus Patent Matters => Have you sent info package?]]**

**Date:** Fri, 13 Feb 2004 18:02:22 -0800

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <bodeip@earthlink.net>

---

**Subject: [Fwd: InterCitrus Patent Matters => Have you sent info package?]**

**Date:** Fri, 13 Feb 2004 15:32:25 -0800

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** "G. A. Bode" <gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

George,

Any news on these matters, and the package? Was it sent???  
Please advise.

Regards,  
Carlos

---

**Subject: Re: InterCitrus Patent Matters => Have you sent info package?**

**Date:** Mon, 02 Feb 2004 18:44:21 -0200

**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>

**Organization:** InterCitrus S.A

**To:** George Bode <Gbode@ccmattorneys.com>, George Bode <bodeip@bellsouth.net>

George,

Any news on these matters, and the package? Was it sent??? Please advise.

Regards,  
Carlos

Carlos Mendes wrote:

George,

Confirming, I did not receive a package on Sunday at my parents house. I am now back at work at our Araraquara, Brazil plant.

Have you sent anything? Any new developments? What are your plans re U.20 and the other pending patent and trademark issues? I have a Board meeting next Tuesday morning at 10:00 am in the São Paulo corporate office. Please advise.

Regards,  
Carlos

---

**Subject:** Re: InterCitrus Patent Matters  
**Date:** Thu, 06 Nov 2003 15:15:09 -0200  
**From:** Carlos Mendes <carlosmendes@intercitrus.com.br>  
**Organization:** InterCitrus S.A  
**To:** George Bode <Gbode@ccmattorneys.com>  
**CC:** Fernando Horta Jr <fhortajr@terraroja.agr.br>  
**References:** <sfa90ef4.002@NGWNAMESESERVER>

George,

Good to hear you received the money. We are now 3 hours ahead of Eastern Standard Time, as we have gone to daylight savings time.

I will be in the US (mostly in Florida) from December 8, 2003 to January 9, 2004. We need to get all the pending patent issues under control and resolved. As we agreed to during our last meeting, I would like to visit the USPTO office in DC, if this help in any way to expedite our processes. Count on and with my total focus on these matters, as I am counting on you to pursue the successful resolution of these issues, with especial and total dedication to U.20. Please keep me posted on your progress.

Best regards,  
Carlos Mendes

George Bode wrote:

CMN:

IC funds received by wire transfer at our bank in New Orleans on 03 November 2003. Clark, Campbell & Mawhinney have been paid in full.

I will be prepared to meet with you in December 2003. Please confirm your itinerary and when you want to meet with me in Lakeland, so that I can match my itinerary to your itinerary.

What is the current time difference? The USA is now on STANDARD TIME.

Vty,

G.A. BODE



**Subject: InterCitrus Patent and Trademark Matters**

**Date:** Fri, 21 May 2004 07:10:01 -0400

**From:** "GM BODE" <bodeip@earthlink.net>

**To:** "Carlos Mendes" <carlosmendes@intercitrus.com.br>

Sr. Mendes:

Confirm our appointment for WEDNESDAY, MAY 26, 2004 @ 11:00 A.M. @ my office - 4202 So. Florida Avenue (across South Florida Avenue from Sheraton Four Points Hotel - not far from the home of your parents).

Vty,

G. BODE

— Original Message —

**From:** Carlos Mendes

**To:** bodeip@earthlink.net

**Cc:** Fernando Horta Jr

**Sent:** 5/20/2004 9:52:50 AM

**Subject:** Re: URGENT Need to Meet to Discuss InterCitrus Patent and Trademark Matters

George,

Let's meet on Wednesday, May 26 at 11:00 a.m. at your office. By the way, what is the location and address of your new office? Have you changed telephone numbers? Please update us on these details.

Regards,  
Carlos

"George A. BODE" wrote:

Sr. Mendes: I will be available in Lakeland May 25 & 26, 2004. Vty, G. BODE George A. BODEBODE & ASSOCIATES, P. C. 2314 Broadway New Orleans LA 70125-4128 Telephone: (504) 861-8288 FAX: (504) 866-6717 [bodeip@earthlink.net](mailto:bodeip@earthlink.net)

— Original Message —

**From:** Carlos Mendes

**To:** George Bode

**Cc:** Fernando Horta Jr

**Sent:** 5/18/2004 10:08:25 AM

**Subject:** URGENT Need to Meet to Discuss InterCitrus Patent and Trademark Matters

# APPENDIX C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: Carlos Neto Mendes

Group Art Unit: 3721

Applicant: Carlos Neto Mendes

Serial No.: 09/641,790

Atty. Dkt.: M-95-3195-U.20-CIP (old)  
10646-007-U20 (new)

Filed: 08/18/2000

Title: IMPROVEMENTS IN A MODULAR FRUIT JUICE EXTRACTION  
SYSTEM AND CONFIGURATION FOR A SELF-CLEANING  
FILTER FOR THE EXTRACTION OF FRUIT JUICE

Assistant Commissioner for Patents  
P.O. Box 1450  
Washington, DC 20231-450

DECLARATION OF CARLOS NETO MENDES  
TO ACCOMPANY STATEMENT SENT WITH PETITION TO REVIVE  
UNINTENTIONALLY ABANDONED PATENT APPLICATION

1. I, Carlos Neto Mendes, a citizen of The United States of America (since 1999), hereby declare and state as follows:
2. I have communicated by telephone, e-mail, and mail, and have had in-person meetings with my former patent attorney, Mr. George Bode between 1995 and 2004. For a period of time preceding mid-2002, I was concerned with the slowness of correspondence from the United States Patent and Trademark Office ("Patent Office"). When I expressed my concern to Mr. Bode, Mr. Bode told me that this was because the Patent Office had slowed down due to factors related to post-9/11 security measures. At that time I believed Mr. Bode's explanation for the slowness, and was satisfied with the legal services provided by Mr. Bode.



3. I received an e-mail from Mr. Bode dated July 17, 2002 regarding U.S. patent application number 09/641,790, which indicated that Mr. Bode would leave a copy of the Office action referred to in the e-mail for me to pick up in Lakeland, Florida. However, no Office action copy was in that office for me to pick up.

4. During the period between July and August 2002, prior to hearing from Mr. Polk (see below), based on communications from Mr. Bode, I believed that a patent would soon issue from U.S. patent application serial number 09/641,790.

5. On August 13, 2002 I received a telephone call from Mr. Edward Polk, who identified himself as being with The Office of The Solicitor of the USPTO, indicating that a number of patent applications had gone abandoned, and that Mr. Bode was under investigation by his office. I spoke with Mr. Polk again on August 16, 2002, when he told me that my application 09/377,936 had gone abandoned and was no longer valid. I became concerned about the status of all of my pending applications and my patent protection in the United States. I knew that some applications had properly gone abandoned after a later-filed application had been filed, but the list from Mr. Polk included applications that I believed should have been pending.

6. On August 20, 2002, I telephoned Mr. Bode and communicated to him what Mr. Polk had told me. Mr. Bode first told me that what Mr. Polk stated must be a mistake and he would look into the matter. On August 26, 2002 I again called Mr. Polk, of The Office of The Solicitor, and he once again confirmed that many of my patent applications had gone abandoned, some for lack of action or response from my attorney Mr. Bode. Mr. Polk also stated that "Petitions to Revive" would be needed to be filed in order to revive specific applications that were not supposed to have gone abandoned. On September 3, 2002, I again called Mr. Bode, who said that he was still looking into the matter,

but still believed that the USPTO must have made some mistakes in regards to applications that should not have gone abandoned. On September 17, and again on September 21, 2002 I met with Mr. Bode at his office in Lakeland, Florida. At these meetings Mr. Bode began to agree to the fact that indeed some errors were made, probably inside the USPTO, and that perhaps some applications have unintentionally gone abandoned. Thereafter, when the abandonment of certain applications was confirmed, Mr. Bode then stated that mistakes had in fact been made, and he assured me that he would file for revival of applications that needed to be revived. Thereafter, in telephone conversations and during meetings on December 11 and 19 of 2002, Mr. Bode assured me repeatedly that he had filed the revival documents that needed to be filed, so that he had taken care of the patent applications that we wanted to be pending with corrective actions as needed. In my various meetings with Mr. Bode in late 2002, and throughout the year of 2003, I was constantly assured that all requested office actions, and all documents related to the revival of patents, had been filed in a timely and correct manner. Again in these cases, Mr. Bode argued that the delays we were experiencing were only related to "unusually long processing times experienced by the USPTO due to internal changes and lack of personnel", and we still had to be patient, and that "soon, things would begin to return to normal" and our pending patent applications eventually would issue. At all times Mr. Bode also stated that he could not understand why the Patent Office was so slow in responding.

7. Throughout the year of 2003 I had several meetings and telephone conversations regarding my patent and trademark matters. I met personally with Mr. Bode on January 7, January 31, March 18 and May 14 of 2003. I called Mr. Bode on May 24, 2003, as well as sending him several e-mails in regards to inquiring about the status of my various applications. He always assured me that all papers necessary had been filed, and that he was following up on all applications. I continued to meet with Mr. Bode in 2003, including meetings on October 16 and 20, and on December 17 and 19. As before, Mr. Bode assured

me that all was in order, but that the USPTO was still slow in these matters, so I needed to wait some more. I met with Mr. Bode in January 6 and 10 of 2004, and once again on March 23, 2004. There were no positive developments and yet, Mr. Bode still confirmed to me that all matters were properly taken care of and that it was just a matter of waiting for the appropriate action from the USPTO. On March 24 of 2004 I began to search for new council in order to replace Mr. Bode, this time without any comments to Mr. Bode of possible changes in counsel. Previously, when I had indicated to Mr. Bode that I was going to seek new counsel, Mr. Bode said that he understood the pressure I was under, but he was doing all he could and it was just question of waiting for the USPTO to respond.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or of any patent issuing there from.

Dated: Nov. 30, 2004

By: \_\_\_\_\_



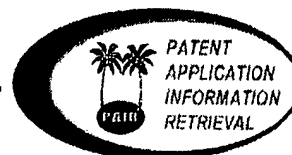
Carlos Neto Mendes

# APPENDIX D

# **APPENDIX D**



Application Serial No.	Internal Docket	Status	Next Actions
08/647,066	U.2	Issued as U.S. 5,655,441	Next maintenance fee due 12 August 2004.
08/681,627	U.4	Issued as U.S. 5,720,218	Next maintenance fee due 24 February 2005.
08/681,626	U.6	Issued as U.S. 5,802,964	Next maintenance fee due 8 September 2005.
08/759,724	U.11	Abandoned for failure to respond to 30 April 1997 Office action. This regards configuration of concave and radially cut hemisphere.	Determine need to and basis for petition for revival.
08/759,722	U.13	Issued as U.S. 5,720,219	Next maintenance fee due 24 February 2005.
Title: "Dispositivo Clasificador de Frutas Cítricas e Congeneres" 09/028,187	No "U" designation given. This is item # 22. U.17	No record of this having been filed.	Determine whether the subject matter was included in a later application.
09/641,790	U.20 (CIP)	Application went abandoned, apparently before filing of U.18 and U.19.  Application went abandoned January 2003 for failure to respond to Office action. 36 claims allowed; two claims rejected based on Mendes EPO published application.	Obtain support for basis of filing, and file Petition to Revive application. This revival is needed to fill a gap in priority asserted by Examiner in U.20(CIP).  Obtain support for basis of filing, and file Petition to Revive application.
09/835,919	U.21-CIP	Application went abandoned in pre-examination due to no Response to Notice of Incomplete Application (based on alleged lack of Abstract and drawings, both of which are in our copy of application as filed).	If USPTO made an error, we can file a Petition to Withdraw Abandonment. Otherwise, we are researching whether a Petition to Revive may revive an incomplete application. If yes, then we would obtain support for basis of filing, and file Petition to Revive application.

**PATENT APPLICATION INFORMATION RETRIEVAL**

Search results as of: 8-8-2004::14:0:8 E.T.

Search results for application number: 09/028,187			
Application Number:	09/028,187	Customer Number:	29391
Filing or 371(c) Date:	02-23-1998	Status:	Abandoned -- Failure to Respond to an Office Action
Application Type:	Utility	Status Date:	10-29-1999
Examiner Name:	GERRITY, STEPHEN FRANCIS	Location:	FILE REPOSITORY (FRANCONIA)
Group Art Unit:	3721	Location Date:	08-05-2004
Confirmation Number:	4315	Earliest Publication No:	-
Attorney Docket Number:	M-95-3195-U.	Earliest Publication Date:	-
Class/ Sub-Class:	100/110	Patent Number:	-
First Named Inventor:	CARLOS NETO MENDES, ARARAQUARA, (BR)	Issue Date of Patent:	-
Title Of Invention:	FILTERING DEVICE FOR A CITRUS JUICE EXTRACTION MACHINE		

## Search Options

Continuity Data
Foreign Priority

**File History**

Date	Contents Description
08-04-2004	Correspondence Address Change
08-04-2004	Change in Power of Attorney (May Include Associate POA)
10-29-1999	Mail Abandonment for Failure to Respond to Office Action
10-29-1999	Abandonment for Failure to Respond to Office Action
03-30-1999	Mail Final Rejection (PTOL - 326)
03-29-1999	Final Rejection
03-16-1999	Date Forwarded to Examiner
02-17-1999	Response after Non-Final Action
02-17-1999	Incoming Letter Pertaining to the Drawings
11-13-1998	Mail Non-Final Rejection
11-09-1998	Non-Final Rejection
07-22-1998	Case Docketed to Examiner in GAU
07-14-1998	Transfer Inquiry
06-02-1998	Application Dispatched from OIPE
06-02-1998	IFW Scan & PACR Auto Security Review
03-02-1998	Initial Exam Team nn

## Joe Fischer

---

**From:** David Maire [dmaire@iplawfl.com]  
**Sent:** Monday, June 28, 2004 1:48 PM  
**To:** Carlos Mendes  
**Cc:** Joe Fischer  
**Subject:** meeting with Bode

Carlos,

Joe and I just returned from Lakeland and our "meeting" with George Bode. I'm not sure that our encounter can really be called a meeting, since it was very brief. I had told George that we would go over the InterCitrus files with him, concentrating on files with near-term actions due. When we arrived at his office, he simply handed us three boxes of files and said that he had to leave immediately for an appointment. When we tried to ask a few questions, he repeatedly said "its in the files." He gave us no docketing report showing actions due, although he did state that "there are no actions due on any of the US applications."

Mr. Bode's actions were very abrupt and non-accommodating. It appears to me that he does not want to cooperate with us.

We will proceed to review the materials that we received to confirm that we have all of the files and to identify any actions due. Joe will soon be sending you Power of Attorney forms to sign so that we can represent you before the US Patent Office, and we will be notifying the foreign agents of our replacement of Mr. Bode.

We will remain in touch...

Dave

DAVID G. MAIRE  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 North Orange Ave., Suite 2500  
Orlando, FL 32801  
telephone: 407-926-7704  
facsimile: 407-926-7720  
e-mail: dmaire@iplawfl.com

D-3

## Grayce Lichtenberger

---

**From:** Grayce Lichtenberger [glichtenberger@iplawfl.com]  
**Sent:** Wednesday, August 04, 2004 4:28 PM  
**To:** efoia@uspto.gov  
**Cc:** Joe Fischer  
**Subject:** FOIA REQUEST

**Importance:** High

THIS REQUEST IS MADE PURSUANT TO THE FREEDOM OF INFORMATION ACT.

Please provide us with copies of all public documents relating to the OED's Final Disciplinary Decision regarding the Respondent, George Bode. We checked on-line for this information, but the list of Respondents has not been updated since April 2004 and, therefore, does not include the information we are looking for.

Please provide the copies/information to the undersigned. As we represent a client who formerly retained the services of Mr. Bode as his attorney, there is some urgency to our request. PLEASE ADVISE BY REPLY E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS.

Thank you for your assistance in this regard.

Grayce A. Lichtenberger  
Assistant to Joseph Fischer  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-4

**From:** Grayce Lichtenberger [glichtenberger@iplawfl.com]  
**Sent:** Wednesday, August 04, 2004 4:28 PM  
**To:** EFOIA  
**Cc:** Joe Fischer  
**Subject:** FOIA REQUEST

OFFICE OF THE  
GENERAL COUNSEL  
2004 AUG -5 AM 7:33  
U.S. PATENT  
AND  
TRADEMARK OFFICE

**Importance:** High

THIS REQUEST IS MADE PURSUANT TO THE FREEDOM OF INFORMATION ACT.

Please provide us with copies of all public documents relating to the OED's Final Disciplinary Decision regarding the Respondent, George Bode. We checked on-line for this information, but the list of Respondents has not been updated since April 2004 and, therefore, does not include the information we are looking for.

Please provide the copies/information to the undersigned. As we represent a client who formerly retained the services of Mr. Bode as his attorney, there is some urgency to our request. PLEASE ADVISE BY REPLY E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS.

Thank you for your assistance in this regard.

Grayce A. Lichtenberger  
Assistant to Joseph Fischer  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-4



RECEIVED

AUG 09 2004

BEUSSE BROWNE WOLTER  
MORA & MAIRE, P.A.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

OFFICE OF THE GENERAL COUNSEL

Dear Sir/Madam:

Your Freedom of Information Act (FOIA) request was received by the Office of the General Counsel on 8/5/04

Your request has been docketed as "FOIA Request No. 04-254." Any further inquiries regarding your request should include that number. A copy of your request is attached for reference.

In the event your original request was incorrectly addressed, please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT CONTROL DESK  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sincerely,

Robert Fawcett  
Paralegal Specialist

D-4

## Grayce Lichtenberger

---

**From:** Grayce Lichtenberger [glichtenberger@iplawfl.com]  
**Sent:** Tuesday, August 10, 2004 2:29 PM  
**To:** efoia@uspto.gov  
**Cc:** Joe Fischer  
**Subject:** FOIA REQUEST NO. 04-254 - REPLY REQUESTED

**Importance:** High

Dear Sir/Madam,

This is regarding FOIA Request No. 04-254, which request was initially received from us by the Office of the General Counsel on August 5, 2004.

PLEASE ADVISE ASAP BY RETURN E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS. The requested copies/information may be useful to us in requesting revival of several patent applications for a client that Mr. Bode used to represent.

Thank you for your assistance in this respect.

Grayce A. Lichtenberger  
Assistant to Joseph Fischer  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-4

## **Grayce Lichtenberger**

---

**From:** EFOIA [EFOIA@USPTO.GOV]  
**Sent:** Wednesday, August 11, 2004 7:02 AM  
**To:** Grayce Lichtenberger  
**Subject:** RE: FOIA REQUEST NO. 04-254 - REPLY REQUESTED

"[A]n initial response shall be made within 20 working days (i.e., excluding Saturdays, Sundays and legal public holidays) of the receipt of a request for a record under this part by the proper FOIA Officer identified in accordance with Sec. 102.5(a). . . ." See 37 C.F.R. Sec. 102.6(b).

-----Original Message-----

**From:** Grayce Lichtenberger [mailto:glichtenberger@iplawfl.com]  
**Sent:** Tuesday, August 10, 2004 2:29 PM  
**To:** EFOIA  
**Cc:** Joe Fischer  
**Subject:** FOIA REQUEST NO. 04-254 - REPLY REQUESTED  
**Importance:** High

Dear Sir/Madam,

This is regarding FOIA Request No. 04-254, which request was initially received from us by the Office of the General Counsel on August 5, 2004.

PLEASE ADVISE ASAP BY RETURN E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS. The requested copies/information may be useful to us in requesting revival of several patent applications for a client that Mr. Bode used to represent.

Thank you for your assistance in this respect.

Grayce A. Lichtenberger  
Assistant to Joseph Fischer  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-4





RECEIVED

SEP 09 2004

BEUSSE BROWNLEE WOLTER  
MORA & MAIRE, P.A.

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP - 2 2004

GENERAL COUNSEL

Ms. Grayce A. Lichtenberger  
Beusse Brownlee Wolter Mora  
& Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, FL 32801

Re: Freedom of Information Act (FOIA) Request No. 04-254

Dear Ms. Lichtenberger:

This is in response to your e-mail dated August 4, 2004, in which you requested, under the provisions of the Freedom of Information Act, 5 U.S.C. § 552, a copy of: "all public documents relating to the OED's Final Disciplinary Decision regarding the Respondent, George Bode."

The U.S. Patent and Trademark Office (USPTO) indexes and makes available for public inspection and copying all files concerning final agency decisions. 5 U.S.C. § 552(a)(2); 37 CFR § 1.10.159(c).

Because these files are indexed and open to public inspection, they are not available under the FOIA. FOIA applies only to documents that are not otherwise publicly available. Schwarz v. United States Patent and Trademark Office, No. 95-5349, 1996 U.S. App. LEXIS 4609 at 2-3 (D.C. Cir. 1996); Comer v. Internal Revenue Service, U.S. Dist. LEXIS 16268 (E.D. Mi., Sept. 30, 1999); Crews v. Internal Revenue, No. 99-8388, slip. op. At 11-12 (C.D. Cal. Apr. 26, 2000).

Practitioner disciplinary proceeding records are available for public inspection at the USPTO Office for Enrollment and Discipline. They may be contacted at (703) 306-4097. The final decisions are posted at [www.uspto.gov](http://www.uspto.gov).

The processing fee for this FOIA request has been waived. See 37 C.F.R. § 102.11(d)(4).

Sincerely,

Robert Fawcett  
Paralegal Specialist

D-5

## Grayce Lichtenberger

---

**From:** Grayce Lichtenberger [glichtenberger@iplawfl.com]  
**Sent:** Thursday, September 30, 2004 3:23 PM  
**To:** efoia@uspto.gov  
**Cc:** David Maire  
**Subject:** FOIA REQUEST - Proceeding No. D02-14

**Importance:** High

THIS REQUEST IS MADE PURSUANT TO THE FREEDOM OF INFORMATION ACT.

Please provide us with copies of all documents relating to the OED's disciplinary decisions regarding the Respondent, George Bode, including, but not limited to, the Initial Decision for Proceeding No. D02-14. We explicitly exclude from this Request a copy of the Final Decision, which is now available on-line, but would like copies of all other documents in the files relating to any disciplinary matter related to Mr. George Bode.

Please provide the copies/information to the undersigned. As we represent a client who formerly retained the services of Mr. Bode as his attorney, there is some urgency to our request. PLEASE ADVISE BY REPLY E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS.

Thank you for your assistance in this regard.

Grayce A. Lichtenberger  
At Request of David G. Maire  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-6

EFOIA

From: Grayce Lichtenberger [glichtenberger@iplawfl.com]  
Sent: Thursday, September 30, 2004 3:23 PM  
To: EFOIA  
Cc: David Maire  
Subject: FOIA REQUEST - Proceeding No. D02-14

OFFICE OF THE  
GENERAL COUNSEL

2004 OCT -1 AM 7:47

Importance: High

U.S. PATENT  
AND  
TRADEMARK OFFICE

THIS REQUEST IS MADE PURSUANT TO THE FREEDOM OF INFORMATION ACT.

Please provide us with copies of all documents relating to the OED's disciplinary decisions regarding the Respondent, George Bode, including, but not limited to, the Initial Decision for Proceeding No. D02-14. We explicitly exclude from this Request a copy of the Final Decision, which is now available on-line, but would like copies of all other documents in the files relating to any disciplinary matter related to Mr. George Bode.

Please provide the copies/information to the undersigned. As we represent a client who formerly retained the services of Mr. Bode as his attorney, there is some urgency to our request. PLEASE ADVISE BY REPLY E-MAIL HOW LONG IT WILL TAKE TO GRANT OUR REQUEST FOR RECORDS..

Thank you for your assistance in this regard.

Grayce A. Lichtenberger  
At Request of David G. Maire  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-6



**UNITED STATES PATENT AND TRADEMARK OFFICE**

OFFICE OF THE GENERAL COUNSEL

Dear Sir/Madam:

Your Freedom of Information Act (FOIA) request was received by the Office of the General Counsel on 10-1-04

Your request has been docketed as "FOIA Request No. 05-061." Any further inquiries regarding your request should include that number. A copy of your request is attached for reference.

In the event your original request was incorrectly addressed, please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT CONTROL DESK  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sincerely,

A handwritten signature in black ink, appearing to read "RF", is written over a horizontal line.

Robert Fawcett  
Paralegal Specialist

D-6



RECEIVED

NOV 01 2004

BEUSSE BROWNLEE WOLTER  
MORA & MAIRE, P.A.

UNITED STATES PATENT AND TRADEMARK OFFICE

GENERAL COUNSEL

OCT 27 2004

Ms. Grayce A. Lichtenberger  
Beusse Brownlee Wolter Mora  
& Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, FL 32801

Re: Freedom of Information Act (FOIA) Request No. 05-001

Dear Ms. Lichtenberger:

The Office of the General Counsel received your letter requesting, under the Freedom of Information Act (5 U.S.C. § 552) a copy of: "all documents relating the OED's disciplinary decisions regarding the Respondent, George Bode, including but not limited to, the Initial Decision for Proceeding No. D02-14."

Preliminary estimates indicate that the approximate processing cost of this FOIA request is **\$662.00**. This estimate includes estimated review time of approximately 16 only. Associated copying charges cannot be estimated until a final determination regarding releasability is made.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search costs required to adequately respond to your request.

As a commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication. See 37 C.F.R. § 102.11(c)(1)(i).

Please note that a search fee is chargeable even when no responsive records are found, or when the records requested are determined to be totally exempt from disclosure. See 37 C.F.R. § 102.11(c)(3)(i)).

Requestors must pay the entire anticipated fee before the Agency begins processing a request when the fee estimate exceeds \$250.00. See 37 C.F.R. § 102.11(i)(2).


D-6

Please remit, within 30 calendar days of the date of this letter, a check made payable to the "Department of Treasury" in the amount of **\$662.00**. The payment must be sent to:

United States Patent and Trademark Office  
Freedom of Information Act Officer  
Office of the General Counsel  
P.O. Box 1450  
Alexandria, VA 22313-1450

If payment in the full amount of the initial estimate is not received by November 26, 2004, this request will be considered withdrawn and closed.

Sincerely,



Robert Fawcett  
Program Analyst

**Grayce Lichtenberger**

---

**From:** Grayce Lichtenberger [glichtenberger@iplawfl.com]  
**Sent:** Wednesday, November 03, 2004 4:06 PM  
**To:** efoia@uspto.gov  
**Cc:** Joe Fischer  
**Subject:** FOIA REQUEST NO. 05-001

**Importance:** High

THIS REQUEST IS MADE PURSUANT TO THE FREEDOM OF INFORMATION ACT.

We are in receipt of your correspondence dated October 27, 2004, and, accordingly, wish to modify our request. Please provide us with a copy of ONLY the Initial Decision for Proceeding No. D02-14. Please let us know the cost for this copy.

Thank you for your assistance in this regard.

Grayce A. Lichtenberger  
At Request of David G. Maire  
Beusse Brownlee Wolter Mora & Maire, P.A.  
390 N. North Orange Avenue  
Suite 2500  
Orlando, Florida 32801  
Telephone: (407) 926-7715  
Fax: (407) 926-7720  
glichtenberger@iplawfl.com

D-6